

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

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

GEN-PROBE INCORPORATED,
Plaintiff,
v.
BECTON, DICKINSON AND COMPANY,
Defendant.

BECTON, DICKINSON AND COMPANY,
Counterclaimant,
v.
GEN-PROBE INCORPORATED,
Counterdefendant.

Civil No. 09cv2319 BEN (NLS)
**ORDER GRANTING IN PART JOINT
MOTION FOR PROTECTIVE ORDER
TO DETERMINE PARTIES’ DISPUTE
REGARDING ISSUE NO. 2 IN THE
PROTECTIVE ORDER**
[Doc. No. 27]

Plaintiff Gen-Probe, Inc. (Gen-Probe) develops and sells nucleic acid tests and corresponding equipment used to detect disease-causing microorganisms and to screen donated human blood. Compl. ¶ 1. By incorporating its patented technology, the TIGRIS® System, Gen-Probe fully automated the process for blood screening. Compl. ¶ 4. Gen-Probe alleges that defendant Becton, Dickinson and Company (BD) and its “BD Viper™ with XTR™ Technology” nucleic acid testing system infringes U.S. Patent Nos. 7,560,256 (‘256 patent), 7,560,255 (‘255 patent), 7,524,652 (‘652 patent), 7,482,143 (‘143 patent), 7,118,892 (‘892 patent) and 5,612,200 (‘200 patent). Compl. ¶¶ 7-12, 16-39. It also alleges that BD’s “BD ProbeTec™” DNA Assays infringe U.S. Patent Nos. 7,294,308 (‘308 patent) and

1 6,893,612 ('612 patent). Compl. ¶¶ 13-14, 40-47. BD asserted counterclaims for declaratory judgment
2 of invalidity against Gen-Probe's eight asserted patents.

3 The court held a Case Management Conference (CMC) on February 26, 2010. Following the
4 CMC the court issued several rulings regarding scheduling and the parameters for discovery. It also
5 ordered counsel to meet and confer regarding a joint proposed protective order to govern the production
6 of documents in this case. Because the parties could not agree to all terms in the protective order, they
7 filed this joint motion asking the court to determine two disputed terms in the protective order.

8 On March 11, 2010, the court issued an order explaining it had sufficient information before it to
9 determine the first issue presented in the joint motion. It determined that first issue regarding the
10 definition of "Highly Confidential" information in an order dated March 15, 2010. Also in the March
11 11 Order, the court set a schedule for further briefing of the second issue regarding Gen-Probe's
12 proposed patent prosecution bar. In the second issue, Gen-Probe asks this court to implement a term to
13 preclude all of BD's outside counsel from reviewing some of its "Highly Confidential" information, if
14 that counsel engages in patent prosecution for any client in the area of "molecular diagnostics."

15 For good cause shown, the court **GRANTS in part** the joint motion to determine the second
16 issue raised in the proposed protective order, denies without prejudice the request to impose a
17 prosecution bar, and imposes a requirement that any as-of-yet undisclosed outside counsel who
18 prosecutes patents or materially assists in the prosecution of patents, before reviewing the opposing
19 party's "Highly Confidential" information, disclose to the other side his or her involvement in patent
20 prosecution.

21 **Issue #2: Whether the Protective Order Should Include a Prosecution Bar on Persons Having**
22 **Access to Information Designated "Highly Confidential."**

23 The parties disagree on whether to implement a patent prosecution bar on persons having access
24 to certain categories of information designated "Highly Confidential."¹ Gen-Probe proposes to insert

25
26 ¹In response to the court's order, Gen-Probe offered to limit the scope of the proposed
27 prosecution bar by allowing prosecution counsel to review subsections (a) and (c) in the definition of
28 "Highly Confidential" information, which includes Gen-Probe's financial information. This would thus
create a third category of information in the protective order, "Highly Confidential - No Prosecution
Counsel." Given the ruling in this Order, Gen-Probe may, but is not required, to revise the definition of
"Highly Confidential" information.

1 the following paragraph in the protective order while BD opposes insertion of this paragraph and
2 imposition of a patent prosecution bar:

3 Subject to the restrictions set forth in Paragraph 8 above, information
4 designated "HIGHLY CONFIDENTIAL" may not be viewed by any
5 person who is actively involved in, or materially assists others who are
6 actively involved in, prosecuting patents in the technology area of
7 molecular diagnostic tests and molecular diagnostic instrument systems
8 (hereinafter the "Technology Area"). To ensure compliance with this
9 provision, the parties shall create an ethical wall between those persons
10 with access to information designated "HIGHLY CONFIDENTIAL"
11 under this Order and those individuals who prosecute or materially assist
12 others who prosecute patents in the Technology Area. In addition, any
13 individual otherwise qualified to view information designated "HIGHLY
14 CONFIDENTIAL" under the terms of Paragraph 8 and this Paragraph
15 shall be barred from prosecuting or materially assisting others involved in
16 prosecuting patents in the Technology Area for a period of two (2) years
17 following the final termination of this action, including any and all
18 appeals.²

12 **1. Relevant Facts.**

13 BD has retained two law firms to represent it in this matter, Foley Hoag LLP (Foley Hoag) in
14 Boston, and Knobbe Martens Olson & Bear LLP (Knobbe Martens) as local counsel. Both firms have a
15 patent prosecution practice. BD intends to use patent prosecutors at both firms to review discovery
16 information. Swinton Decl. 1 ¶ 9. In their meet and confer efforts leading up to the filing of the joint
17 motion, BD's counsel did not disclose to Gen-Probe's counsel how many and which defense counsel
18 would be affected by Gen-Probe's proposed prosecution bar. Swinton Decl. 1 ¶¶ 11, 18. But BD
19 disclosed that people at Knobbe Martens were actively prosecuting patents for a BD subsidiary in the
20 field of nucleic acid tests and instrument systems. Swinton Decl. 1 ¶ 10. Boris Zelkind of Knobbe
21 Martens did not specify which BD subsidiary or how many people at his firm were involved. *Id.*

22 According to the declarations of counsel, Foley Hoag has a prosecution practice that consists of
23 approximately 16 attorneys and non-attorney technical specialists. Fiacco Decl. 1 ¶ 7. Foley Hoag is
24 currently prosecuting hundreds of patent applications for at least eight clients in the field of molecular
25 diagnostics, the area of technology that would be subject to the prosecution bar. Fiacco Decl. 1 ¶ 10.
26 Knobbe Martens specializes in intellectual property law and has over 40 attorneys and non-attorney

27
28 ²In supplemental briefing Gen-Probe proposes to decrease this time frame to within two years
from the disclosure of such technical information or one year after the conclusion of the litigation,
including any appeals, whichever is longer.

1 technical specialists who actively prosecute patent applications. Zelkind Decl. ¶ 5; Anderson Decl. 1 ¶¶
2 4, 10. A large portion of its business stems from patent prosecution services in the biotechnology field,
3 including prosecution in the area of molecular diagnostic tests and instrument systems. Anderson Decl.
4 ¶¶ 5-8. Knobbe Martens has numerous clients whose research may be characterized as molecular
5 diagnostic tests and instruments, and they have represented some of these clients for several years.
6 Anderson Decl. 1 ¶ 8.

7 Foley Hoag does not prosecute any patents for BD. Fiacco Decl. 1 ¶ 5. But its patent litigators
8 rely heavily on the patent prosecutors as active members of litigation teams, and intend to rely on those
9 members to analyze Gen-Probe’s “Highly Confidential” information. Fiacco Decl. 1 ¶ 12. Foley Hoag
10 explains that these team members “actively participate” and “materially assist” in prosecuting patent
11 applications for clients in the field of molecular diagnostics. Fiacco Decl. 1 ¶ 12. Foley Hoag has
12 represented BD in commercial litigation for decades. Fiacco Decl. 1 ¶ 3. BD has made a substantial
13 investment in educating the Foley Hoag and Knobbe Martens teams concerning the subject matter of
14 this litigation. Fiacco Decl. 1 ¶ 13; Anderson Decl. 1 ¶ 11.

15 None of BD’s litigation attorneys of record for this matter, including Donald Ware, Barbara
16 Fiacco and Brian Carroll of Foley Hoag, and Boris Zelkind and Erik Anderson of Knobbe Martens, are
17 involved in BD’s strategic decisions regarding product design or development, pricing, marketing or
18 other competitive decisions. Fiacco Decl. 1 ¶ 5; Fiacco Decl. 2 ¶¶ 4-5; Anderson Decl. 1 ¶ 3; Anderson
19 Decl. 2 ¶ 4; Russell Decl. ¶ 9; Sollins Decl. ¶ 6; Peaslee Decl. ¶ 5; Choi Decl. ¶ 9. While Mr. Zelkind is
20 a member of the patent bar, he no longer prosecutes patents and focuses exclusively on intellectual
21 property litigation.³ Zelkind Decl. ¶ 2; Anderson Decl. 1 ¶¶ 3-4; Swinton Decl. 1 ¶ 18. Mr. Ware, Ms.
22 Fiacco and Mr. Carroll are not members of the patent bar; however they consult with clients regarding
23 issues arising during patent prosecution that affect pending or potential patent litigation, such as
24 disclosure of material to the United States Patent and Trademark Office (Patent Office). Fiacco Decl. 1
25 ¶ 6.

26 Knobbe Martens prosecutes patents for two BD subsidiaries, HandyLab, Inc. and GeneOhm
27

28 ³Likewise, both Mr. Swinton and Mr. Long, counsel to Gen-Probe, are admitted to practice
before the Patent Office but no longer prosecute patents. Swinton Decl. 1 ¶ 18.

1 Technology. Anderson Decl. 2 ¶¶ 8, 10. The court separately addresses the issues involved with the
2 BD subsidiaries later in this Order.

3 **2. Applicable Law.**

4 When deciding whether one side's patent prosecutor should have access to the opposing party's
5 confidential information, courts must balance the "one party's right to broad discovery and the other
6 party's ability to protect its confidential materials from misuse by competitors." *Avocent Redmond*
7 *Corp. v. Rose Electronics*, 242 F.R.D. 574, 577 (W.D.Wash. 2007) (citing *U.S. Steel Corp.*, 730 F.2d
8 1465, 1468 (Fed. Cir. 1984)). The key inquiry is whether the attorney in question is in fact a
9 competitive decision maker. *Id.* (citing *U.S. Steel Corp.*, 730 F.2d at 1470). The court must also
10 balance the risk of inadvertent disclosure of confidential information to competitors against the risk of
11 impairment of litigation. *See, e.g., Interactive Coupon Mktg. Group, Inc. v. H.O.T.! Coupons, LLS*,
12 1999 U.S. Dist. LEXIS 12437, *2 (N.D. Ill. 1999).

13 **A. Majority View.**

14 In the majority view, where a company's patent prosecutor also engages in competitive decision
15 making for that company, the prosecutor must be barred from accessing the opposing party's
16 confidential information. *See, e.g., Motorola, Inc. v Interdigital Technology Corp.*, 1994 U.S. Dist.
17 LEXIS 20714 (D. Del. 1994) (prohibiting outside counsel who already received plaintiff's confidential
18 information from prosecuting patents for defendant for one year after litigation ended); *Infosint S.A. v.*
19 *Lundbeck*, 2007 U.S. Dist. LEXIS 36678 (S.D.N.Y. 2007) (imposing bar where plaintiff's attorney was
20 making decisions regarding competitors and assisting in the prosecution of the patents-in-suit). In some
21 cases, the fact that an attorney engages in patent prosecution is sufficient to find that the attorney is also
22 a competitive decision maker for the party: "Prosecuting patent applications 'involves decisions of
23 scope and emphasis' that implicate competitive decision making, as claims may be drafted to 'read on
24 new products and new directions where [a party] project[s] sales to be most critical.'" *Commissariat A*
25 *L'Energie Atomique v. Dell Computer Corp.*, 2004 U.S. Dist. LEXIS 12782, *8 (D. Del. 2004) (barring
26 plaintiff's attorneys from accessing defendant's highly confidential information because they were
27 prosecuting patents involving the technology at issue) (quoting *Motorola*, 1994 U.S. Dist. LEXIS 20714
28 at *7-*8, *11); *In re Papst Licensing, GmbH, Patent Litig.*, 2000 U.S. Dist. LEXIS 6374 (E.D. La.

1 2000) (defining advice related to patent prosecution as competitive decision making); *Chan v. Intuit,*
2 *Inc.*, 218 F.R.D. 659, 662 (N.D. Cal. 2003) (defining advice on the scope of patent claims as competitive
3 decision making).

4 In other cases, courts have made more specific findings regarding patent prosecution and other
5 factors, including who is the attorney at issue, the attorney's relationship with the party, and the specific
6 type of prosecution work undertaken for that client, to show that the attorney is a competitive decision
7 maker. *See, e.g., Methode Electronics, Inc. v. DPH-DAS LLC*, 2010 U.S. Dist. LEXIS 3604 (E.D. Mich.
8 2010) (finding risk that plaintiff's attorney could inadvertently apply the defendant's information to
9 shape claims for plaintiff in then-pending continuation proceedings for the patents at issue and make
10 claims "read" on new products rendered him a competitive decision maker); *Presidio Components, Inc.*
11 *v. Amer. Technical Ceramics Corp.*, 546 F. Supp. 2d 951, 958 (S.D. Cal. 2008) (Stormes, J.) (imposing
12 prosecution bar for plaintiff's prosecution attorney who worked at same firm as litigation team because
13 he would be involved in decisions concerning scope and emphasis such as drafting claims to read on
14 new products and new directions where sales were projected to be more critical); *Phoenix Solutions, Inc.*
15 *v. Wells Fargo Bank, N.A.*, 254 F.R.D. 568, 580 n.3 (N.D. Cal. 2008) (entering prosecution bar for
16 plaintiff's patent prosecutor who functioned as an in-house counsel with authority to make competitive
17 business decisions even though plaintiff and defendant were not direct competitors).

18 **B. Minority View.**

19 Under the minority view, patent prosecution, on its own, is insufficient to qualify an attorney as
20 a competitive decision maker. *In re Sibia Neurosciences, Inc.*, 1997 U.S. App. LEXIS 31828 (Fed. Cir.
21 1997). The minority view cases rely on *In re Sibia* for the rule that no prosecution bar should be entered
22 for patent prosecutors unless there is other specific evidence that the attorney is a competitive decision
23 maker. *See, e.g., Avocent*, 242 F.R.D. 574 (allowing plaintiff's prosecutors access to defendant's
24 confidential information because defendant showed only a "vague and generalized threat of future
25 inadvertent misuse of discovered materials"); *Island Intellectual Prop. LLC v. Promontory*
26 *Interfinancial Network*, 658 F. Supp. 2d 615 (S.D.N.Y. 2009) (finding counsel did not participate in
27 activities such as pricing and product design and thus was not a competitive decision maker);
28 *Greenstreak Grp., Inc. v. P.N.A. Construction Technologies, Inc.*, 251 F.R.D. 390 (E.D. Mo. 2008)

1 (finding outside counsel were not involved in pricing and product design and thus were not competitive
2 decision makers); *AFP Advanced Food Prods. LLC v. Snyder's of Hanover Mfg. Inc.*, 2006 U.S. Dist.
3 LEXIS 426 (E.D.Penn. 2006) (finding the threat of inadvertent use of defendant's confidential
4 information, on its own, is not enough to justify barring plaintiff's attorneys from prosecuting similar
5 patents for two years); *Pergo, Inc. v. Faus Grp., Inc.*, 2005 U.S. Dist. LEXIS 40601 (E.D.N.C. 2005)
6 (finding counsel did not advise on product pricing, design, invention, research, development, marketing
7 or sales and thus was not a competitive decision maker).

8 This court has already rejected the minority view and distinguished *In re Sibia* on the grounds
9 that it was decided before the significant post-*Motorola* line of cases. See *Presidio*, 546 F. Supp. 2d at
10 958. While *In re Sibia* is a Federal Circuit case and a patent prosecution bar is unique to patent law,
11 several other courts have rejected *In re Sibia* because it is an unpublished case. See, e.g., *Phoenix*
12 *Solutions*, 254 F.R.D. at 580 n.3. Further, this issue arises in the context of the appropriate scope of a
13 protective order. Fed. R. Civ. Proc. 26(c). Where issues of patent law control disposition of a discovery
14 dispute, the court must apply Federal Circuit law. *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175
15 F.3d 1356, 1359 (Fed. Cir. 1999). Here, however, the precedential effect of *In re Sibia* is disputed, and
16 the appropriate scope of a protective order is a matter generally committed to the sound discretion of the
17 district court. See Fed.R.Civ.P. 26(c); *Phillips v. GMC*, 307 F.3d 1206, 1211 (9th Cir. 2002).

18 C. Cases Addressing Scope of Prosecution Bar.

19 Some of the cases that enter prosecution bars limit the bar to either only those patents at issue in
20 the litigation, or to any of the litigating party's patents related to the patents-in-suit. See, e.g.,
21 *Interactive Coupon Mktg. Group*, 1999 U.S. Dist. LEXIS at *11 (barring plaintiff's counsel from
22 prosecuting "any patent application for plaintiff relating to the subject matter of the patents-in-suit").
23 Other cases have expanded the scope of the prosecution bar to apply not only to patents belonging to the
24 litigating parties, but to counsel's other clients who may have patents related to the technology at issue.
25 See, e.g., *Commissariat*, 2004 U.S. Dist. LEXIS at *8 (barring plaintiff's attorneys from accessing
26 defendant's highly confidential information because they were prosecuting patents involving the LCD
27 technology at issue for defendant's competitors); *Medtronic, Inc. v. Guidant Corp.*, 2001 U.S. Dist.
28 LEXIS 22805, *11 (D. Minn. 2001) (barring attorneys who received "Outside Attorneys Eyes Only"

1 information from participating for one year in prosecuting patents “for inventions related to the
2 treatment of abnormal cardiac rhythms”); *Cummins-Allison Corp. v. Glory Ltd.*, 2003 U.S. Dist. LEXIS
3 23653, *34-*35 (N.D. Ill. 2004) (barring counsel from prosecuting “any patent application relating to
4 the subject matter of the patents-in-suit”).

5 Rather than focus the restriction on patent prosecutors, some courts have imposed the bar on
6 patent litigators where those litigators also advise patent prosecutors regarding issues in prosecution.
7 *See, e.g., Cheah IP LLC v. Plaxo, Inc.*, 2009 U.S. Dist. LEXIS 40823, *5-*6 (N.D. Cal. 2009) (rejecting
8 argument that litigators were not competitive decision makers based on litigators providing assistance to
9 patent prosecutors for patents related to patents-in-suit); *c.f. Nazomi Communications, Inc. v. Arm*
10 *Holdings PLC*, 2002 U.S. Dist. LEXIS 21400 (N.D. Cal. 2002) (finding litigators were not competitive
11 decision makers based on their firm’s general patent prosecution practice because the firm did not
12 prosecute patents for plaintiff).

13 **3. Prosecution Bar.**

14 This court must decide whether the BD attorneys who prosecute or materially assist others who
15 prosecute patents in the area of molecular diagnostic tests and instrument systems *for any client* should
16 be prohibited from reviewing Gen-Probe’s most confidential technical information. Gen-Probe argues
17 that BD’s counsel should be forced to make a choice: either litigate this case or prosecute patents
18 involving molecular diagnostic tests and instrument systems, but not both. Gen-Probe asks this court to
19 impose a prosecution bar like it did in *Presidio*, 546 F. Supp. 2d 951. While the issue raised here bears
20 certain similarities to the issue presented in *Presidio*, there are important differences. In *Presidio*,
21 plaintiff’s litigation counsel had also prosecuted the parent patent and the patent-in-suit. Consequently,
22 there was an appreciable risk that sensitive information received from the defendant might
23 unintentionally be used in prosecuting on-going patent applications for the plaintiff. Here, the risk is
24 less apparent, as litigation counsel and prosecution counsel at the defendant’s two law firms do not
25 prosecute any patents for BD. They do, however, prosecute patents for other clients, including
26 subsidiaries of BD, in the same general area of technology.

27 Gen-Probe argues that a patent prosecution bar will create a level playing field for all parties
28 because its lawyers will also be subject to the prosecution bar. Gen-Probe will look to non-prosecuting

1 attorneys or outside consultants for consultation on this litigation. Gen-Probe argues there is good cause
2 to impose the bar based on the substantial evidence it provided in the joint motion of BD copying Gen-
3 Probe's patent submissions by prosecution counsel acting under BD's control. Gen-Probe argues the
4 risk of inadvertent disclosure of its most guarded information is far outweighed by any burden imposed
5 on BD in this case.

6 BD advances several arguments against imposition of the prosecution bar. First, it argues it will
7 be unfairly prejudiced if it cannot disclose Gen-Probe's "Highly Confidential" information to patent
8 prosecution counsel so as to use their technical expertise to help with this litigation. Second, it argues
9 the proposed bar is unnecessary, and in any event is too broad in scope and duration because it would
10 apply to any current or future client of Foley Hoag or Knobbe Martens, and would restrain their
11 attorneys from pursuing their own career opportunities in patent prosecution in the life sciences and
12 future in-house counsel positions for years to come. Third, BD argues that Gen-Probe has not
13 demonstrated any risk that its "Highly Confidential" information will be used by BD's outside litigation
14 counsel to prosecute patents to the prejudice of Gen-Probe. Fourth, BD argues that the ethics rules
15 governing attorneys, including the California Rules of Professional Conduct, eliminate any concern that
16 BD's litigation counsel will use Gen-Probe's "Highly Confidential" information to further its
17 representation of any unspecified third-party competitors in patent prosecution matters. Finally, BD
18 argues that Gen-Probe has not provided any reason why it requires greater protection than any former
19 client of Foley Hoag or Knobbe Martens receives.⁴

20 **A. Good Cause.**

21 In the initial joint motion, Gen-Probe explained it became concerned, when in the meet and
22 confer, Mr. Zelkind disclosed that attorneys in his firm were currently prosecuting patents for a BD
23 subsidiary in the same technology area. Mr. Zelkind, however, did not disclose any details regarding the
24 people involved or their involvement, if any, in this lawsuit. Swinton Decl. 1 ¶ 10. Mr. Ware, likewise,

25
26 ⁴BD argues that even though Gen-Probe has not shown good cause to implement the patent bar,
27 this court has shifted the burden to BD by requiring it to submit declarations from outside counsel
28 justifying why the bar should not be imposed. This court has not alleviated Gen-Probe of the burden
under Rule 26(c) to show good cause. Rather, the court ordered production of information that Gen-
Probe had requested but that BD refused to produce. This information was relevant to Gen-Probe's
argument for good cause and necessary to the court's consideration of whether Gen-Probe met its
burden.

1 refused to disclose how many of his colleagues were engaged in similar activities. Swinton Decl. 1 ¶
2 11. Further, Gen-Probe explains that of the approximately 26,000 documents it produced evidencing the
3 conception, reduction to practice, design and development of each claimed invention, it designated only
4 56 documents as “Highly Confidential” that would be subject to the bar. Gen-Probe asserts that those
5 documents are “exemplary invention documents that contain detailed molecular chemistry disclosures
6 regarding the design of the molecular diagnostic assays running on its TIGRIS commercial
7 embodiment” and are “inherent in the invention and reduction to practice of Gen-Probe’s automation
8 patents.” Swinton Decl. 2 ¶ 7.

9 The failure of BD’s counsel to discuss more details of their patent prosecution practices, coupled
10 with the proprietary value of the information in the documents at issue, constituted good cause to order
11 BD’s counsel to provide further information regarding its patent prosecution practices.

12 **B. Competitive Decision Making.**

13 Gen-Probe argues that by virtue of their prosecuting patents for Gen-Probe’s competitors in the
14 same technology area, patent prosecutors at Foley Hoag and Knobbe Martens engage in competitive
15 decision making. Gen-Probe cites to many cases, including this court’s decision in *Presidio*, where a
16 company’s outside counsel involved in patent prosecution are competitive decision makers who should
17 either choose to prosecute patents or participate in the litigation. Gen-Probe argues that a patent
18 prosecutor cannot effectively separate, in his or her mind, a competitor’s confidential information
19 obtained through discovery from the strategic business decisions a prosecutor must engage in for the
20 benefit of a client.

21 Considering the risk that patent prosecutors from Foley Hoag and Knobbe Martens could
22 inadvertently apply Gen-Probe’s information to shape claims for its competitors in patent prosecution
23 proceedings for patents related to the technology at issue, if based on a supporting factual record, those
24 patent prosecutors would be competitive decision makers. However, without further information as to
25 who, exactly, those prosecutors are, and which patent applications they are prosecuting for which
26 clients, the court cannot affirmatively find that the collective and unknown group of patent prosecutors
27 at Foley Hoag and Knobbe Martens working on unknown patents are competitive decision makers.

28 To build a factual record, Gen-Probe asked for the identifications of the companies for which

1 Foley Hoag and Knobbe Martens prosecute patents in the technology area. Swinton Decl. 2 ¶ 3. In
2 response, Foley Hoag provided Gen-Probe a representative list of its molecular diagnostics clients. *See*
3 Fiacco Decl. 2, Ex. A. Knobbe Martens disclosed a BD subsidiary, but not a list. Swinton Decl. 2 ¶ 3.
4 Gen-Probe asked this court to order BD’s counsel to disclose their client lists so as to discover any
5 competitors. Based on BD’s expressed concerns regarding client confidentiality, such as disclosure of
6 clients working on new and unpublished patents, the court will not order BD to disclose those lists.

7 Gen-Probe also asks that BD disclose which patent prosecutors it will rely on for this litigation.
8 Regarding attorneys, BD cannot yet identify with certainty which attorneys it will rely on because the
9 case is in its initial stages, and counsel is not yet aware of the staffing needs required to review “Highly
10 Confidential” information, the role that each attorney will fulfill, or whether any specific attorney will
11 be indispensable to the litigation team. Fiacco Decl. 2 ¶¶ 6-7. Also, BD’s counsel needs flexibility in
12 its staffing to address events that will inevitably occur over the length of a long patent case, such as
13 medical and parental leave, trials, and other professional and personal commitment. Fiacco Decl. 2 ¶ 8;
14 Zelkind Decl. ¶ 6. Further, BD’s counsel argues it cannot anticipate their staffing needs because this is a
15 large case with eight asserted patents naming fifteen inventors, and there now also exists a second case
16 filed by Gen-Probe involving some of the same patents and accusing different BD products, and due to
17 the largess of these cases both firms require flexibility in staffing. Zelkind Decl. ¶¶ 6-8; Fiacco Decl. 2
18 ¶¶ 6-9. Notwithstanding these objections, Foley Hoag disclosed certain of its attorneys who may be
19 staffed on this case. These Foley Hoag associates explained that none of the technical areas of their
20 prosecution work involve automation, automated devices or penetrable caps similar to the technology
21 asserted in Gen-Probe’s patents. Russell Decl. ¶ 7; Sollins Decl. ¶ 4; Choi Decl. ¶ 7; Anderson Decl. 2
22 ¶¶ 6, 12.

23 Based on these disclosures, Gen-Probe does not challenge any of the identified Foley Hoag
24 associates--Kimberly Peaslee, Hathaway Russell, Peter Sollins, and technical specialist Peter Choi--or
25 argue they are competitive decision makers who should be prevented from reviewing Gen-Probe’s
26 “Highly Confidential” information. Further, based on the representations of BD’s counsel, Gen-Probe
27 does not believe that BD’s principal trial counsel, Mr. Ware, Ms. Fiacco and Mr. Carroll, or its principal
28 local counsel, Mr. Zelkind, prosecute patents or materially assist others in the prosecution of patents,

1 and thus does not seek a prosecution bar against them. Gen-Probe Reply, pp. 1, 9-10.

2 Based on this record, the court finds that there is not enough evidence to make a finding that
3 Foley Hoag's and Knobbe Martens' unidentified patent prosecutors working on unspecified patents for
4 unidentified clients are competitive decision makers.

5 **C. Balancing Test.**

6 The courts now employs a balancing test that weighs the risk of inadvertent disclosure of a
7 party's most confidential information against the opposing party's ability to litigate. *See, e.g., In re*
8 *Papst Licensing, GmbH, Patent Litig.*, 2000 U.S. Dist. LEXIS 6374 (E.D. La. 2000) (restricting Papst's
9 counsel because risk of inadvertent disclosure outweighed any impairment on Papst's ability to litigate).
10 Gen-Probe argues it will suffer prejudice because it faces a risk of inadvertent disclosure of its
11 confidential information to undisclosed competitors other than BD. In contrast, BD argues it will suffer
12 prejudice to its ability to litigate this case because its technically knowledgeable counsel would be
13 precluded from further assisting BD. Fiacco Decl. 1 ¶ 12. BD's representation would suffer and its
14 choice of counsel would be unduly prejudiced. Zelkind Decl. ¶ 7.

15 BD's counsel argues a prosecution bar will cause the law firms and their clients severe prejudice.
16 For example, BD's outside counsel has an undivided duty of loyalty to each of its clients. *See Flatt v.*
17 *Superior Court*, 9 Cal. 4th 275, 289 (1994). If Gen-Probe's prosecution bar is imposed, BD's counsel
18 argues it would be forced to violate that duty of loyalty and choose between their clients. If the bar is
19 imposed, for example, Foley Hoag and Knobbe Martens may decide that they prefer to prosecute patents
20 for several other clients in the technology area rather than litigate this case, so they would be forced to
21 withdraw as counsel for BD, which could prejudice BD. Or, Foley Hoag and Knobbe Martens may
22 choose to litigate this case and abandon some of its patent prosecution activities, which could deprive
23 their patent prosecution clients of their choice of counsel and prejudice them in their proceedings. Also,
24 by imposing the prosecution bar, counsel argues that Gen-Probe would receive more protection of its
25 confidential information than Foley Hoag's or Knobbe Martens' clients, as both firms prosecute patents
26 for multiple clients in this technology area without any limitation on their representation. If those
27 clients--including BD--to which Foley Hoag and Knobbe Martens owe a duty of loyalty, have not asked
28 either of those firms to give up prosecuting patents for other competitors in the same area of technology,

1 BD argues it would be unfair to ask those firms to selectively eliminate their clients for the benefit of
2 Gen-Probe, to which those firms do not owe a duty of loyalty.⁵

3 Second, BD’s counsel argues that such a bar could violate California Rule of Professional
4 Conduct 1-500, which prohibits any agreement that restricts an attorney’s ability to practice law. *See*
5 *also Nazomi*, U.S. Dist. LEXIS at *8-*9 (presuming attorneys can abide by both terms of a protective
6 order and the Rules of Professional Conduct and only barring access where there is a significant danger
7 of inadvertent disclosure). If the bar is considered a covenant not to compete, it may be found
8 unenforceable. *See* Hricik Decl. ¶ 38.

9 Third, the bar could derail the careers of Foley Hoag’s newer associates. For example, Foley
10 Hoag uses a contract attorney who has a Ph.D. in biophysical chemistry and who focused her graduate
11 work on molecular diagnostics. Peaslee Decl. ¶ 3. She became a member of the Massachusetts bar in
12 January 2010. Peaslee Decl. ¶ 2. She intends to develop a legal career that includes patent prosecution,
13 which may include work in the area of her education, molecular diagnostics. Peaslee Decl. ¶ 6. If
14 subject to the prosecution bar, she would be precluded from working, for what would likely be a
15 substantial period of time, in her area of education. Peaslee Decl. ¶ 7.

16 In light of these ethical and career-impacting concerns, the court finds that BD’s outside counsel
17 would be prejudiced by imposition of the broad prosecution bar, and that such prejudice would
18 additionally flow to BD.

19 **D. Scope of Technology in Prosecution Bar.**

20 Gen-Probe and this court asked BD to propose a limit to the prosecution bar. As first proposed,
21 Gen-Probe seeks to impose the bar on all patent prosecutors at Foley Hoag and Knobbe Martens who
22 work in the area of molecular diagnostics. Molecular diagnostics includes all of the tests and methods to
23 identify a disease or predisposition for a disease through analysis of an organism’s molecules, such as

24
25 ⁵BD explains that ethical obligations prevent prosecution attorneys from taking on future
26 representation in a subject matter that bears a “substantial relationship” to the technology at issue in a
27 prior or current client relationship. Hricik Decl. ¶ 30. BD’s expert opines that courts construe the
28 “substantial relationship” requirement narrowly to protect the livelihoods of prosecuting attorneys as
well as their abilities to practice law. *Id.* The Patent Office has held that to be substantially related, two
patents must be at least “substantially identical.” Hricik Decl. ¶ 33; *Anderson v. Eppstein*, 59 USPQ 2d.
1280 (Bd. Pat. App. & Interf. May 11, 2001). Consequently, firms can represent multiple clients in the
same space without conflict or risk of misuse of confidential information. Hricik Decl. ¶ 30.

1 DNA or RNA. Fiacco Decl. 1 ¶ 8. Some of the current and emerging applications of molecular
2 diagnostics include personalized medicine (i.e. custom treatment for a specific disease in a patient),
3 oncology (diagnostic and personalized medicine tests), antibodies, genetic testing for inherited disorders
4 and prenatal diagnosis, and predicting genetic risk of disease. Fiacco Decl. 1 ¶ 9. BD contends the
5 asserted patents, however, relate to only a narrow aspect of molecular diagnostics, specifically, a fully
6 automated stand-alone instrument for isolating, amplifying and detecting nucleic acids and the
7 penetrable caps for use with that instrument, and implies that any bar should be limited to this definition.
8 Based on this definition, BD asserts that the subject matter of the patents-in-suit is not relevant to any
9 molecular diagnostics patents currently being prosecuted by prosecutors at Foley Hoag or Knobbe
10 Martens. BD Response, p.8.

11 Gen-Probe replies that BD’s narrowed definition does not account for all the claims asserted in
12 these “automation” patents, which claim the molecular chemistry steps of “hybridizing,” “amplifying,”
13 and “detecting” a target nucleic acid sequence. Swinton Decl. 2 ¶ 6. Gen-Probe points out that in BD’s
14 196-topic document request it served on Gen-Probe on March 29, 2010, BD’s demands went beyond
15 any “mechanical” subject category and demonstrates BD’s real belief regarding the technology at issue:

16 All documents concerning the testing, manufacture, use, sale or offer for
17 sale of the TIGRIS Instrument, including all engineering notebooks, notes,
18 memoranda, correspondence, e-mails, prototypes, engineering change
19 orders, bills of material, research reports, development proposals, project
20 approvals, project summaries, new product disclosures or proposals,
21 drawings, sketches, schematics, models, computer models, simulations,
22 manufacturing specifications or protocols, testing specifications or
23 protocols, technical manuals, product manuals, service manuals, operation
24 manuals, samples, presentations, data files, meeting minutes, diaries,
25 calendars, publications, product specifications, product development
26 documents, theory of operation documents, failure modes and effects
27 documents, and any other design and technical documents.

23 Swinton Decl. 2 ¶ 8.

24 Based on this conflicting information, and the lack of an independent expert opinion that might
25 help define the scope of the technology at issue, the court will not impose a more narrowly-tailored
26 version of the prosecution bar.

27 **4. Ethical Wall.**

28 The parties acknowledge that Knobbe Martens prosecutes patents for a BD subsidiary,

1 HandyLab, Inc. Neither Mr. Zelkind nor Mr. Anderson works on patent prosecutions for that client.
2 Anderson Decl. 2 ¶ 10. Knobbe Martens plans to implement an ethical wall in the firm before receiving
3 any Gen-Probe “Highly Confidential” documents in this case by restricting access to those documents
4 only to people staffed on the case. *Id.* Any person staffed on the case will first be vetted to confirm that
5 he or she does not work on patent prosecution for any patent applications owned by HandyLab. *Id.*
6 Any person staffed on this case will be excluded from helping prosecute HandyLab patent applications.
7 *Id.*

8 Knobbe Martens also prosecutes patents for another BD subsidiary, GeneOhm Technology. Mr.
9 Anderson used to prosecute patents for them but is no longer responsible for that patent prosecution.
10 Anderson Decl. 2 ¶ 8. He does, however, occasionally help the prosecuting attorneys because of his
11 familiarity with the technology and experience prosecuting applications for these patent families.
12 Anderson Decl. 2 ¶ 8. While these patents can be considered to be within the area of molecular
13 diagnostics, he says they do not relate to the subject matter of the patents asserted here because they do
14 not cite to the Gen-Probe patents at issue as prior art. Anderson Decl. 2 ¶ 9. If, upon further
15 investigation, these patents are found to relate to the patents at issue, Knobbe Martens shall also
16 implement an ethical wall between the GeneOhm patent prosecutors and the attorneys assigned to this
17 case.

18 **Conclusion and Order.**

19 The court finds that Gen-Probe has presented good cause for a legitimate concern that its
20 “Highly Confidential” information will be put at risk of inadvertent disclosure to potential competitors
21 in the field of molecular diagnostics. Because Gen-Probe does not have an attorney-client relationship
22 with the Foley Hoag or Knobbe Martens firms, it cannot benefit from the same protections and conflict
23 checking mechanisms those clients receive, and consequently it cannot provide informed consent to
24 disclosure of its confidential information. While Gen-Probe has not shown that the collective group of
25 patent prosecutors at Foley Hoag and Knobbe Martens working for unidentified clients in unknown
26 areas of patent prosecution are competitive decision makers, it did not have the tools to make such a
27 showing because Foley Hoag and Knobbe Martens understandably declined to provide that information
28 to Gen-Probe.

1 On the other hand, the Foley Hoag and Knobbe Martens firms would suffer prejudice if the court
2 ordered them to disclose their client lists and patent prosecutions to Gen-Probe so that Gen-Probe could
3 make a factual record to support its argument to impose the patent prosecution bar. Also, if the court
4 imposed the prosecution bar, BD would be prejudiced in its ability to litigate this case with its chosen
5 counsel. BD would also suffer from the downflow of prejudice that would be imposed on the Foley
6 Hoag and Knobbe Martens firms, as the careers of their attorneys, areas of expertise and client
7 relationships could be adversely impacted by imposition of the bar.

8 Recognizing the potential prejudice to both sides, this court attempts to strike the appropriate
9 balance by imposing the following requirement:

10 To provide further assurances to Gen-Probe that its “Highly Confidential” information is not
11 being freely passed around to all patent prosecutors at Foley Hoag and Knobbe Martens, and to provide
12 a record to Gen-Probe about who is reviewing its “Highly Confidential” information, and at the same
13 time not unduly burden BD’s counsel with staffing predictions or unworkable constraints, any attorney
14 or non-attorney technical specialist who works for outside counsel and engages in patent prosecution or
15 materially assists in patent prosecution, and who has not yet been disclosed in any of the papers filed in
16 relation to this joint motion, shall execute a declaration before receiving any of the opposing party’s
17 “Highly Confidential” documents in this case. The declaration shall give a brief background of the
18 individual’s general role and experience in patent prosecution, and shall detail whether that person is
19 actively involved in, or materially assisting others who are actively involved in, prosecuting patent
20 applications that relate to the subject matter of the patents-in-suit or disclose as prior art the patents-in-
21 suit. The declaration shall be served on the opposing party before disclosure of any “Highly
22 Confidential” information. The parties shall follow the same procedure for objecting to the receipt of
23 information by the proposed patent prosecutor as is already established for objecting to receipt of the
24 information by an independent expert. If the parties do not agree on disclosure to the proposed patent
25 prosecutor, the objecting party shall move the court for a ruling within seven days of the objection. The
26 objecting party may seek imposition of a prosecution bar as to the declarant.

27 While the court is aware that attorneys at these firms are already bound by state and likely firm-
28 wide ethical obligations, requiring the execution of the declaration will emphasize the importance to the

1 viewer to segregate Gen-Probe's confidential information from other clients of the firms who may
2 compete in the same technology area. It will also provide Gen-Probe with important information needed
3 to evaluate whether it thinks the attorney should be subject to a prosecution bar. This arrangement is not
4 meant to cast suspicion on an individual lawyer or technical specialist at Foley Hoag or Knobbe
5 Martens, but rather is a way for Gen-Probe to keep track of which patent prosecutors are reviewing its
6 confidential information, just as BD would be entitled to such information if Gen-Probe discloses BD's
7 "Highly Confidential" information to outside patent prosecutors or technical consultants.

8 The parties shall make the appropriate revisions to the proposed protective order reflecting this
9 requirement. The parties shall lodge that revised protective order with Judge Stormes by **May 5, 2010**.

10 **IT IS SO ORDERED.**

11 DATED: April 28, 2010

12 

13 Hon. Nita L. Stormes
14 U.S. Magistrate Judge
15 United States District Court