

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

EOLAS TECHNOLOGIES INCORPORATED,

Plaintiff,

v.

ADOBE SYSTEMS INC., ET AL,

Defendants.

CASE NO. 6:09-cv-446

Hon. Leonard E. Davis

JURY

JOINT MOTION FOR ENTRY OF PROTECTIVE ORDER

Plaintiff Eolas Technologies, Inc. (“Eolas” or “Plaintiff”) and Defendants Adobe Systems Inc., Amazon.com, Inc., Apple Inc., Blockbuster Inc., CDW Corp., Citigroup Inc., eBay Inc., Frito-Lay, Inc., The Go Daddy Group, Inc., Google Inc., J.C. Penney Company, Inc., JPMorgan Chase & Co., New Frontier Media, Inc., Office Depot, Inc., Perot Systems Corp., Playboy Enterprises International, Inc., Rent-A-Center, Inc., Staples, Inc., Oracle America, Inc. (formerly known as Sun Microsystems Inc.), Texas Instruments Inc., Yahoo! Inc., and YouTube, LLC (collectively, “Defendants”) respectfully request that the Court enter a Protective Order in this case.

The parties have largely reached agreement on the form of the Protective Order. There are two remaining disputes needing resolution by the Court. First, the parties dispute section 5(b) and, specifically, whether the patent prosecution bar included in section 5(a) should be

applicable in reexamination proceedings involving U.S. Patent No. 5,838,906 or U.S. Patent No. 7,599,985 (collectively, “Patents-in-Suit”). Second, the parties dispute whether and to what extent the plaintiff may share one defendant’s confidential information with other co-defendants under section 1(b). The parties have met and conferred in good faith but are unable to resolve these issues.

1. Disputed Provisions

a. Prosecution Bar

Plaintiff proposes including the following provision in the Protective Order:

5(b). Because patent claims cannot be broadened during a reexamination, a reexamination of the Patents-in-Suit shall not trigger the patent prosecution bar of Section 5(a) above.

Defendants object to the inclusion of this provision, and propose the following:

5(b). For purposes of this section, and for the avoidance of doubt, a reexamination of a Patent-in-Suit shall be deemed a prosecution of a patent claiming the subject matter disclosed in the Patents-in-Suit, and, accordingly, the prosecution bar contained in Paragraph 5(a) shall apply to any such reexamination.

b. Disclosure of one party’s confidential information to other parties

Plaintiff proposes including the following provision in the Protective Order:

1(b). Plaintiff may disclose one Defendant's Protected Material to any other Defendant or Defendants through Court filings, oral argument in Court, expert reports, deposition, discovery requests, discovery responses, or any other means, without the prior written consent of the Defendant that produced the Protected Material, provided that Plaintiff marks such disclosure with the same confidentiality designation as utilized by the disclosing party and provided that Plaintiff follows the provisions of Paragraph 22(a).

Defendants object to the inclusion of this provision, and propose the following:

1(b). Notwithstanding the provisions of this Protective Order, and subject to the provisions of Paragraph 22(a), Plaintiff shall in good faith use reasonable efforts to avoid disclosing a Defendant's Protected Material to any other Defendant or Defendants through Court filings, oral argument in

Court, expert reports, deposition, discovery requests, discovery responses, or any other means. In the event that such disclosure can not be avoided without undue burden on Plaintiff, the following shall apply: (i) If Plaintiff intends to disclose a Defendant's Protected Material through oral argument in Court at a pre-trial hearing, or during the course of trial, paragraph 17(c) shall apply; (ii) If Plaintiff intends to disclose a Defendant's Protected Material through deposition, Plaintiff shall notify Defendants sufficiently in advance of such deposition to ensure that the Defendant whose Protected Material may be disclosed has a fair opportunity to object to the presence of any other Defendant or Defendants at the deposition; (iii) If Plaintiff intends to disclose a Defendant's Protected Material through Court filings, expert reports, discovery requests, discovery responses, or any other means, Plaintiff and the Defendant whose Protected Material will be disclosed shall meet and confer to discuss appropriate procedures for preventing unnecessary and potentially harmful disclosure of such Protected Material on certain other Defendants while reducing any administrative burdens on Plaintiff.

No other provisions of the competing Proposed Protective Orders are disputed. The Proposed Protective Order including the disputed language for Sections 5(b) and 1(b) is attached as Exhibit A.

2. Argument with respect to Prosecution Bar

a. Plaintiff's Argument

The '906 patent has already been subjected to two reexaminations. Some of the defendants in this case (*e.g.* Adobe) urged the first reexamination. Accordingly, it is likely that one or more of the defendants will again seek a reexamination of the patents-in-suit as part of their litigation strategy. In light of this history, Eolas' proposal recognizes that any subsequent reexamination of the patents-in-suit would require the participation of its litigation counsel, expert witnesses and in-house counsel — those persons with the most knowledge of the patents-in-suit and their validity. This proposal is reasonable and warranted by the facts and circumstances presented herein.

The parties have agreed to a prosecution bar for prosecution-related activities other than reexamination of the patents-in-suit. *See* Exhibit A at ¶ 5(a). This agreed prosecution bar —

together with the other agreed provisions of the protective order — ensures those who have access to confidential information do not use that information when prosecuting patents. *Wi-Lan, Inc. v. Acer, Inc.*, Nos. 2:07-CV-473, 2:07-CV-474 (TJW), 2009 U.S. Dist. LEXIS 53918, at *15 (E.D. Tex. June 23, 2009) (citing *U.S. Steel Corp. v. United States*, 730 F. 2d 1465, 1468 (Fed. Cir. 1984)). The agreed portions of the protective order also provide safeguards preventing Eolas’ counsel from revealing defendants’ confidential information to any reexamination counsel or agent (*i.e.* those not authorized to receive such information). See Exhibit A at ¶¶ 8-11. Additionally, Eolas may not use defendants’ confidential information for any purpose other than the litigation. *Id.* at ¶¶ 1(a), 6(a).

“[T]he district court must balance th[e] risk [of inadvertent disclosure] against the potential harm to the opposing party from restrictions imposed on that party’s right to have the benefit of counsel of its choice” to determine the scope of the prosecution bar. *In re Deutsche Bank Trust Co. Ams.*, 605 F.3d 1373, 1380 (Fed. Cir. 2010) (citations omitted). The risk that the confidential information of a defendant will be disclosed, even inadvertently, in reexamination of the patents-in-suit is exceedingly small — especially in light of the aforementioned safeguards already built into the agreed portions of the protective order. Reexaminations proceed as a matter of public record and the procedures of the Patent Office restrict the activities that occur during a reexamination. Conversely, barring Eolas’ litigation counsel, expert witnesses and in-house counsel — those persons most familiar with the patents-in-suit and the validity arguments made as part of the litigation and prior reexaminations of the ’906 patent — imposes an undue burden on Eolas. Accordingly, this balancing does not favor extending the prosecution bar to reexamination proceedings.

With respect to a prosecution bar, each party has a burden of proof. The Federal Circuit held that the defendants, as the “party seeking the imposition of a patent prosecution bar” are required to “show that the information designated to trigger the bar, the scope of activities prohibited by the bar, the duration of the bar, and the subject matter covered by the bar reasonably reflect the risk presented by the disclosure of proprietary competitive information.” *In re Deutsche Bank*, 605 F.3d at 1381. It also held that, Eolas, as the party opposing the imposition of the bar, is required to show two things:

(1) that counsel’s representation of the client in matters before the PTO does not and is not likely to implicate competitive decision making related to the subject matter of the litigation so as to give rise to a risk of inadvertent use of confidential information learned in litigation, and

(2) that the potential injury to the moving party from restrictions imposed on its choice of litigation and prosecution counsel outweighs the potential injury to the opposing party caused by such inadvertent use.

Id. Eolas can make the required showing, the defendants cannot.

As to the first prong, given the other protections of the agreed protective order, together with the fact that “sections 305 and 314 of the patent statute expressly curtail the scope of the reexamination” (*see Pall Corp. v. Entegris, Inc.*, No. 05-CV-5894, 2008 U.S. Dist. LEXIS 96682, at *14 (E.D.N.Y. Nov. 26, 2008)), it is highly unlikely that participation in reexamination proceedings by Eolas’ litigation counsel, expert witnesses and in-house counsel will risk inadvertent use of confidential information learned in litigation. This Court has already recognized this fact, noting “[c]laims can only be narrowed during reexamination; they cannot be broadened. This is very different from patent prosecution where claim scope is being initially determined. Thus, the risk of harm to Apple is already greatly limited.” *Mirror Worlds, LLC v. Apple, Inc.*, 2009 U.S. Dist. LEXIS 70092 at *5 (E.D. Tex. Aug. 11, 2009) (Davis, J.).

As to the second prong, Eolas would face substantial injury if its litigation counsel, expert witnesses and in-house counsel were excluded from reexamination. These persons have the “knowledge necessary to help reexamination counsel respond to the PTO” and their participation therein “would lessen the financial burden” on Eolas if the patents were put in reexamination again. *Hochstein v. Microsoft Corp.*, No. 04-73071, 2008 U.S. Dist. LEXIS 72750, at *10, 11 (E.D. Mich. Sept. 24, 2008). This too has already been recognized by this Court, noting that “the Court has serious concerns about a policy that would encourage defendants to file for reexamination while excluding plaintiff’s counsel from participating in the reexamination, thereby forcing a plaintiff to defend a patent in two separate venues with two teams of attorneys.” *Mirror Worlds*, 2009 U.S. Dist. LEXIS at *6.

This is not an issue of first impression for the Court. In *i4i Limited Partnership v. Microsoft Corp.*, No. 6:07-cv-00113-LED, slip op. at 2 (E.D. Tex. Sept. 8, 2009) (Davis, J.) the Court held, in the context of a request for litigation counsel and their expert to participate in an interview with the patent examiner as part of a reexamination of the patent-in-suit in that case, that:

The Court ORDERS that (1) McKool Smith and Dr. Rhyne may attend and participate in interviews with the USPTO examiner, (2) Dr. Rhyne may submit a declaration on behalf of i4i to the USPTO, and (3) McKool Smith and Dr. Rhyne may assist reexamination counsel in responding to actions and decisions of the USPTO during the reexamination process and any appeals related thereto, provided that McKool Smith and Dr. Rhyne may not reveal Microsoft’s confidential information to the USPTO or any reexamination counsel or agent and McKool Smith and Dr. Rhyne may not use Microsoft’s confidential information for any purpose other than the litigation. *See Mirror Worlds, LLC v. Apple, Inc.*, No. 6:08-cv-88, 2009 U.S. Dist. LEXIS 70092 (E.D. Tex. Aug. 11, 2009) (Davis, J.).

Similarly, in *Mirror Worlds*, the Court found that:

In light of Mirror Worlds' stipulation and for the reasons given above, the risk of inadvertent misuse of Apple's confidential information does not outweigh the prejudice to Mirror Worlds if the prosecution bar is applied to the reexamination proceedings. While there may be situations that warrant excluding litigation counsel from participating in reexamination proceedings, Apple has not met its burden to show that this is one of those situations. Accordingly, the Court DENIES Apple's motion.

Mirror Worlds, 2009 U.S. Dist. LEXIS at *6. The same standard from these cases should control here. Eolas' litigation counsel, expert witnesses and in-house counsel should be permitted to participate in the reexamination of the patents-in-suit, provided they abide by the other provisions of the protective order.¹

Other Courts analyzing this issue have also determined that a prosecution bar should not apply to reexamination proceedings. For example:

- *Pall Corp.*, 2008 U.S. Dist. LEXIS at *12, 14, 19, 20 (finding that the prosecution bar did not extend to reexamination proceedings given (i) the little risk of litigation counsel misusing confidential information within the reexamination procedure given that sections 305 and 314 of the patent statute expressly curtail the scope of the reexamination, (ii) that the prosecution bar contained no express reexamination prohibition; thus, it was the defendant that "must establish a compelling need to expand the Protective Order"; and (iii) that the confidential information would be irrelevant, as

¹ While Eolas believes that the safeguards articulated by the Court in *i4i* and *Mirror Worlds* are already built into the agreed portions of the protective order (*see* Exhibit A at ¶¶ 1(a), 6(a), 8-11), to the extent that the Court does not find that the protections in the agreed portions of the protective order are stringent enough, Eolas would be willing to agree to an express prohibition that its "outside counsel would not prosecute the reexamination," (though it could participate in the reexamination) and that it "would not reveal defendants' confidential information to any reexamination counsel or agent" and that it would "not use defendants' confidential information for any purpose other than the litigation." *Mirror Worlds*, 2009 U.S. Dist. LEXIS at *4-5.

the reexamination proceeding only implicates matters in the public record—the patent and prior art);

- *Kenexa BrassRing Inc. v. Taleo Corp.*, No. 07-521-SLR, 2009 U.S. Dist. LEXIS 12002, at *5, 5 n.1, 6 (D. Del. Feb. 18, 2009) (finding that the prosecution bar did not extend to the reexamination because (i) “[t]he scope of the claims cannot be enlarged by amendment in reexamination”; (ii) the “reexamination involves only the patent and the prior art, defendant’s confidential information is basically irrelevant to the reexamination”; and (iii) “defendant filed the request for an inter partes reexamination of one of plaintiff’s patents-in-suit, the reexamination is part and parcel of the instant case”);
- *Hochstein*, 2008 U.S. Dist. LEXIS at *10, 11 (finding good cause for allowing participation because the reexamination involved only matters of public record, Microsoft’s confidential information was not relevant to the proceedings, litigation counsel had knowledge necessary to help reexamination counsel respond to the PTO, litigation counsel participation would lessen the financial burden on the patent holder, and the reexamination was part of Microsoft’s litigation strategy);
- *Document Generation Corp. v. Allscripts, LLC*, No. 6:08-CV-470, 2009 U.S. Dist. LEXIS 52874, at *3, 8 (E.D. Tex. June 23, 2009) (finding that the proposed protective order did not need to prohibit the patentee’s litigation counsel from participating in reexamination proceedings, given the prohibition in reexamination against the amendment of claims that would enlarge the scope of the patent); and
- *Crystal Image Tech., Inc. v. Mitsubishi Elec. Corp.*, No. 08-307, 2009 U.S. Dist. LEXIS 32972, at *9 (W.D. Pa. Apr. 17, 2009) (finding that it would allow the plaintiff’s

litigation counsel to participate in the reexamination if it was the opposing party that initiated the reexamination, and if litigation counsel accepted an express legal obligation not to rely on confidential information supplied by the opposing party).

For the foregoing reasons, Eolas' proposal on the Protective Order should be adopted.

b. Defendants' Argument

In a recent decision, the Federal Circuit articulated the standard for determining whether to apply a prosecution bar, the very issue presently before this Court. *See In re Deutsche Bank Trust Co. Americas and Total Bank Solutions, LLC*, 605 F.3d 1373, 1375 (Fed. Cir. 2010) (granting mandamus to resolve "an important issue of first impression in which courts have disagreed," *i.e.*, whether and under what circumstances a patent prosecution bar should be applied).

Defendants respectfully request that this Court enter their Proposed Protective Order based on the Federal Circuit's holding in *In re Deutsche Bank*. Defendants seek to apply a prosecution bar preventing Eolas's counsel that reviews Defendants' confidential technical information from participating in the prosecution of the claims of the Patents-in-Suit during a reexamination proceeding, a reasonable precaution designed to prevent the intentional or inadvertent use of Defendants' confidential information for improper purposes outside this litigation. Given the significant risk of harm to Defendants, there is no reason why Eolas, for example, would require the involvement of its litigation counsel in a reexamination, particularly in view of Eolas's previous reliance on the law offices of Charles Krueger in the Northern District of California to prosecute its patents (including two reexaminations) (Ex. B-1, B-2, B-3, B-4²), and on other counsel for a prior litigation involving one of the Patents-in-Suit (Ex. B-5).

² Citations to "Ex. ___" as used herein are citations to the exhibits to the Declaration of Christopher C. Carnaval in Support of Defendants' Motion for Entry of Defendants' Proposed Protective Order, submitted herewith.

i. Applicable Law

Counsel may be barred from representing clients in certain matters before the U.S. Patent & Trademark Office (“USPTO”) when its role as “competitive decision maker” during prosecution may cause it to inadvertently use material provided under a protective order for inappropriate purposes. *See In re Deutsche Bank*, 605 F.3d at 1377-78; *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1467-68 (Fed. Cir. 1984). *In re Deutsche Bank* explains that an attorney’s substantial involvement in patent prosecution may constitute competitive decision-making, and often raises “an unacceptable risk of inadvertent disclosure,” even where claim scope is narrowed during prosecution. 605 F.3d at 1379-80.

[M]any attorneys involved in litigation are more substantially engaged with prosecution. Such involvement may include . . . ***strategically amending or surrendering claim scope during prosecution***. For these attorneys, competitive decisionmaking may be a regular part of their representation, and the opportunity to control the content of patent applications and the direction and scope of protection sought in those applications may be significant. . . . ***Such attorneys would not likely be properly exempted from a patent prosecution bar.***³

Id. at 1380 (emphases added). Indeed, “it is very difficult for the human mind to compartmentalize and selectively suppress information once learned, no matter how well-intentioned the effort may be to do so.” *FTC v. Exxon Corp.*, 636 F.2d 1336, 1350 (D.C. Cir. 1980) (quoted in *In re Deutsche Bank*, 605 F.3d at 1378).

Reexamination proceedings are, of course, a species of the patent prosecution activities discussed in *In re Deutsche Bank*, and there is no legal basis to treat reexamination proceedings differently. Indeed, on at least two occasions, Judge Ward has found that protective orders

³ *In re Deutsche Bank* therefore declined to adopt the reasoning set forth in several prior district court cases that the risk of harm from improper or inadvertent use of confidential information during reexamination is minimal because claim scope cannot be enlarged during reexamination. *Compare In re Deutsche Bank*, 605 F.3d at 1380 with *Pall Corp. v. Entegris, Inc.*, No. 05-CV-5894, 2008 U.S. Dist. LEXIS 96682 (E.D.N.Y. Nov. 26, 2008), and *Document Generation Corp. v. Allscripts, LLC*, No. 6:08-CV-470, 2009 U.S. Dist. LEXIS 52874 (E.D. Tex. June 23, 2009).

including prosecution bars applied to reexaminations. See *Visto Corp. v. Seven Networks, Inc.*, No. 2:03-CV-333-TJW, 2006 WL 3741891, at *7 (E.D. Tex. Dec. 19, 2006); *Microunity Sys. Eng'g., Inc. v. Dell, Inc.*, No. 2:04-CV-120 (E.D. Tex. Aug. 17, 2005) (Order, Dkt. No. 156). In *Visto Corp.*, Judge Ward explained that “[t]he purpose of the prosecution bar is to prevent outside counsel from using, even inadvertently, confidential information obtained in the lawsuit for purposes outside the lawsuit (e.g., drafting claims during patent prosecution). ***This is true even if the result of the reexamination is narrower claim language.***” 2006 WL 3741891, at *7 (emphasis added).

The risk of inadvertent disclosure or competitive use of confidential information learned during litigation must be balanced against the potential harm to an opposing party caused by restrictions imposed on its right to have the benefit of counsel of its choice. *In re Deutsche Bank*, 605 F.3d at 1380. A party seeking to impose a prosecution bar must show that the information triggering the bar, the scope of activities prohibited by the bar, the duration of the bar, and the subject matter covered by the bar reasonably reflect the risk presented by the disclosure of protected information. *Id.* at 1381. Further, a party seeking an exemption from a patent prosecution bar must show that an individual attorney’s involvement in prosecution activities will *not* “implicate competitive decisionmaking related to the subject matter of the litigation so as to give rise to a risk of inadvertent use of confidential information learned in litigation,” and that the potential injury to one party from restrictions imposed on that party’s right to counsel of its own choosing outweighs the potential injury to an opposing party caused by inadvertent use of that opposing party’s sensitive information. *Id.*

ii. The prosecution bar should apply to reexamination proceedings

Under the Federal Circuit's test in *In re Deutsche Bank*, the Court should enter Defendants' Proposed Protective Order, which would apply the prosecution bar of Section 5(a) to any reexamination of a Patent-in-Suit. First, the information designated to trigger the bar is technical in nature, explicitly excludes financial data, and is therefore the kind of information potentially relevant to the preparation and prosecution of patent applications before the USPTO. *See id.* at 1381. Second, the bar would prohibit "the prosecution of any patent *claims*" during a reexamination of a Patent-in-Suit. Prosecuting patent claims involves influencing or controlling the direction or scope of protection sought and therefore presents a significant opportunity for competitive decision-making on the part of the prosecuting attorney. *See id.* at 1380. Prosecuting patent claims differs from the administrative or managerial work of reporting office actions, filing ancillary paperwork, or staffing projects. *See id.* at 1379-80. Finally, the proposed prosecution bar extends for only one year after the final resolution of this litigation and applies only to patent claims claiming the subject matter disclosed in the Patents-in-Suit.

That claim scope can only be narrowed during reexamination is not a basis for rejecting a prosecution bar. *See In re Deutsche Bank*, 605 F.3d at 1380; *Visto Corp.*, 2006 WL 3741891, at *7; *Microunity Sys. Eng'g.*, Order, at 1. In fact, the possibility of strategic claim narrowing based on Defendants' confidential information is exactly the kind of problem that necessitates the use of a prosecution bar. In the absence of a prosecution bar that applies to reexaminations, Eolas may use Defendants' confidential information gained in this lawsuit to narrow its claims to avoid prior art while focusing those claims on the details of Defendants' products disclosed in their confidential productions in this case. Thus, counsel's representation of Eolas before the USPTO in a reexamination of a Patent-in-Suit, if allowed, would "implicate competitive

decisionmaking related to the subject matter of the litigation so as to give rise to a risk of inadvertent use of confidential information learned in litigation.”⁴ *In re Deutsche Bank*, 605 F.3d at 1381.

The potential for injury, if any, to Eolas from restrictions on its choice of litigation and prosecution counsel is remote. According to the Federal Circuit, a district court should consider “the extent and duration of counsel’s past history in representing the client before the PTO, the degree of the client’s reliance and dependence on that past history, and the potential difficulty the client might face if forced to rely on other counsel for the pending litigation or engage other counsel to represent it before the PTO.” *Id.* Eolas used different counsel than its current litigation counsel during prosecution of the Patents-in-Suit (including two reexaminations), and throughout prior litigation involving one of the Patents-in-Suit. (Ex. B-1, B-2, B-3, B-4, B-5.) During the two previous reexaminations, Eolas used separate reexamination and litigation counsel, *neither of which was the McKool Smith law firm.* Eolas would not be harmed if required to rely, as it has in the past, on counsel other than its litigation counsel in the event of another reexamination of a Patent-in-Suit.

Application of the prosecution bar to reexamination proceedings is appropriate and necessary to mitigate the risk of harm to Defendants if protected material is inadvertently and improperly used against Defendants. For these reasons, Defendants respectfully request that the Court enter Defendants’ Proposed Protective Order.

⁴ Eolas’s willingness to agree to an express prohibition against its outside counsel “prosecuting” the reexamination, while retaining the right to have that same outside counsel “participate in” the reexamination, does nothing to alleviate Defendants’ concerns. Without further explanation, there is no practical distinction between “prosecuting” and “participating in.” The risk to Defendants remains the same.

3. Argument with respect to disclosure of one party's confidential information to other parties

a. Plaintiff's Argument

Defendants' proposal seeks to impose additional, and unwarranted, administrative and logistical restrictions which fall more heavily on Eolas than defendants. Eolas, and each of the defendants, have already agreed to be bound by the agreed provisions of the protective order. These agreed provisions already protect the Protected Material of each party and require all parties (regardless of which party made the disclosure) to treat the Protected Material as such (*see* Exhibit A at ¶¶ 2(h), 7-11), limit the use of Protected Material to purposes related to this litigation (*see id.* at ¶¶ 1(a), 6(a)), require each person who receives Protected Material to agree to be bound by the protective order (*see id.* at ¶¶ 8-11), impose limitations on how Protected Material may be used (*see id.* at ¶ 6(a)), impose limitations on who can receive Protected Material (*see id.* at ¶¶ 8(b)-(c), 9(b)-(c), 10(b)-(c), 11(b)-(c)), and impose limitations on how Protected Material may be used in Court (*see id.* at ¶ 17). These protections are sufficient to protect the confidential information of one party if it is disclosed to another party.

The problem with defendants' proposal can be illustrated with an example. If Eolas were to utilize one infringement expert to render an infringement report addressing the Protected Material of more than one defendant — and despite the fact that Eolas would already be required to designate the report under the proper level of confidentiality — Eolas would nonetheless be required to go through and redact on a defendant-by-defendant basis the Protected Material of the other defendants. This would result in multiple versions of the same report. But there is no reason to impose this burden because the report would already be designated under the proper level of confidentiality. Therefore, even if the Protected Material of more than one defendant were included in the same expert report, the Protected Material would only be disclosed to

persons already authorized to receive it (*e.g.* outside counsel and experts of the defendants) and subject to the other protections of the protective order.

As another example, some of the prior art produced by some of the defendants is marked as Protected Material. If Eolas were to have its expert review and opine on this prior art, Eolas would be unable to provide its rebuttal expert report on validity issues to each defendant. Instead, Eolas would again be required to go through and redact on the prior art Protected Material before disclosing its rebuttal expert report to the other defendants — despite the fact that Eolas would already be required to designate the report under the proper level of confidentiality. As was true in the earlier example, because the report would already be designated under the proper level of confidentiality, the Protected Material would only be disclosed to persons already authorized to receive it (*e.g.* outside counsel and experts) and subject to the other protections of the protective order.

Defendants' professed concern that some are competitors with respect to each other ignores the reality that the protective order already has substantial safeguards built into it. For example, Google and Oracle are engaged in other litigation where they are adverse to each other. Google's professed concern that Oracle may obtain and use its Protected Material in that case ignores that the already-agreed provisions limit the use of Protected Material to purposes related solely to this litigation. Exhibit A at ¶¶ 1(a), 6(a). Similarly, while Apple and Google may be competitors in technology, there is little risk that technical information disclosed by Apple in this case will make it into the hands of Google employees developing Google products. This is because the already-agreed provisions of the protective order impose limitations on who can receive Protected Material. *See id.* at ¶¶ 8(b)-(c), 9(b)-(c), 10(b)-(c), 11(b)-(c).

In light of the substantial protections already afforded by the agreed portions of the protective order, defendants' proposal introduces additional and unwarranted limitations which fall disproportionately on Eolas. Eolas' proposal should therefore be adopted.

b. Defendants' Argument

Defendants respectfully request that the Court enter their proposed language for Paragraph 1(b) of the Proposed Protective Order. Defendants do not wish to impose any unnecessary or unreasonable burdens on Plaintiff. Rather, Defendants seek to avoid the unnecessary and potentially harmful disclosure of one Defendant's Protected Material to another Defendant, a significant concern given that many of the twenty-two Defendants in this case are direct competitors in technology markets at issue in this case. Moreover, Defendants and their counsel will likely be adverse to each other in future cases. (For example, Defendant Oracle-Sun recently filed a patent infringement suit in California against Defendant Google.) Defendants' proposed language attempts to address these concerns while minimizing potential administrative burdens on Plaintiff. In contrast, there is no basis for Plaintiff to unilaterally override the Defendants' serious confidentiality concerns in the name of its own administrative convenience. Plaintiff chose to sue twenty-two Defendants in one action – many of whom are direct competitors – and it should have to live with whatever administrative burdens result from this choice.

Defendants' approach is reasonable and flexible. Defendants' proposal would only require Plaintiff to use "reasonable efforts" in avoiding the disclosure of one Defendant's Protected Material to another Defendant. To the extent any such efforts would impose undue burdens on Plaintiff, several additional provisions would apply depending on the intended method of disclosure:

- First, to the extent Plaintiff intends to make such a disclosure at a pre-trial hearing or during trial, Paragraph 17(c) shall apply. Plaintiff and Defendants are in agreement with respect to Paragraph 17(c), which merely requires Plaintiff to notify a Defendant that it intends to use its Protected Material at a pre-trial hearing only when such Material was not attached as an exhibit to any briefing. It further requires the parties to meet and confer prior to trial concerning Plaintiff's intended use of a Defendant's Protected Material at trial. Paragraph 17(c) emphasizes that "it is the burden of the Producing Party whose documents or materials are being used to make arrangements with the Court to ensure that its Protected Material remains confidential."
- Second, to the extent Plaintiff intends to make such a disclosure at a deposition, Plaintiff would be required to provide sufficient notice so that the Defendant whose Protected Material will be disclosed has a fair opportunity to object to the presence of any other Defendant at the deposition. This requirement is therefore similar to the already agreed upon requirements of Paragraph 17(c), which relates to hearings and trials but not depositions.
- Third, to the extent Plaintiff intends to make such a disclosure through any written means (*e.g.*, pleadings, expert reports, discovery requests), Defendants' proposal merely requires that Plaintiff and Defendant whose Protected Material will be disclosed meet and confer to discuss appropriate procedures for making such disclosure. In reaching an agreement, the parties must weigh the harm to Defendant resulting from unnecessary disclosure against the administrative burdens on Plaintiff in attempting to avoid that disclosure.

None of these provisions, which refer to or are based on other provisions that Plaintiff has already agreed to, or which merely require that the parties meet-and-confer, impose any undue hardship on Plaintiff.

Plaintiff takes the position that Defendants' proposal is not needed in view of the remainder of the Proposed Protective Order, which Plaintiff believes already addresses any concerns Defendants' might have. Defendants disagree. For example, while Paragraph 17(c) may address Defendants' concerns with respect to pre-trial hearings and trials, nothing in the Proposed Protective Order addresses these concerns with respect to depositions. In addition, while Paragraphs 1(a) and 6(a) prohibit the use of Protected Material for purposes other than litigating the present case, Defendants' proposal provides additional safeguards for reasons not unlike the reasons for including a prosecution bar. *See FTC v. Exxon Corp.*, 636 F.2d 1336, 1350 (D.C. Cir. 1980) (quoted in *In re Deutsche Bank*, 605 F.3d at 1378) (“[I]t is very difficult for the human mind to compartmentalize and selectively suppress information once learned, no matter how well-intentioned the effort may be to do so.”).

Defendants believe that their proposal provides a fair and reasonable balance between Plaintiff's and Defendants' interests. It represents a compromise between Plaintiff's proposal and the language previously included in Paragraph 1(b). Defendants' proposal would not impose burdens on Plaintiff any greater than what Plaintiff has already agreed to elsewhere in the Proposed Protective Order. Though not ideal to Defendants, Defendants believe that their proposal provides adequate protection. Defendants therefore respectfully request that the Court adopt Defendants' proposed language for Paragraph 1(b) of the Proposed Protective Order.

DATED: August 27, 2010

Respectfully submitted,

McKool Smith, P.C.

*/s/ Mike McKool (with permission by
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CERTIFICATE OF CONFERENCE

I certify that the parties have met on several occasions and conferred in good faith in an attempt to reach an agreement regarding the terms of the proposed Protective Order. The parties were unable to reach such an agreement. Accordingly, the parties jointly file this Motion for Entry of a Protective Order.

/s/ Christopher C. Carnaval, with permission
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by first class U.S. mail on this 27th day of August, 2010.

/s/ Michael E. Jones