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BLOG

Judge Albright Resolves Scope of Patent Prosecution Bar in Defendants' Favor

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On November 11, 2022, Judge Albright resolved a discovery dispute over the appropriate scope of the patent prosecution bar in a protective order in favor of the defendants' broader proposal. Although the parties agreed that a prosecution bar was warranted, they disagreed on the appropriate scope of that bar.

The parties' proposed prosecution bars were far apart in scope. Defendants proposed that the prosecution bar prohibit the

> preparation or prosecution of any patent application related to the technology or subject matter of the patents-in-suit for which discovery was sought or related to HIGHLY SENSITIVE MATERIAL that was disclosed.

In contrast, plaintiff proposed that the scope of the prosecution bar be

> methods, systems, processes, or apparatuses that facilitate communications across or between IP-based communication systems or networks and that utilize user-specific attributes of the communication-initiating party and/or of the communication-receiving party for purposes of classification and/or routing of the communication across private networks or between private networks and public networks or that utilize an access code received from an access server to initiate a call to a callee.

Judge Albright did not include a detailed analysis for resolving the dispute in favor of the defendants. However, it is worth noting that defendants' proposed prosecution bar was consistent with the scope of a previous prosecution bar ordered by Judge Albright in a different case, whereas plaintiff's proposed prosecution bar was not, although it was consistent with the prosecution bar adopted in an NDCAL suit that included both parties in the current discovery dispute.

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