

3 TAKEAWAYS

Prosecution Bars with Parallel Post-Grant Proceedings

At issue with the courts is whether a protective order should preclude the lawyers involved in the litigation from advising or participating in potential claim amendments for an existing patent in a parallel invalidity proceeding. Atlanta Associate [Christopher Leah](#) discusses this issue and shares key takeaways:

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Courts may be inclined to extend Prosecution Bars beyond the model protective order from the Northern District of California to aspects of post-grant proceedings, including inter partes review (IPR), post-grant review (PGR), and complex business method proceedings (CBM).

Although IPRs do not allow a patent owner to broaden claims, courts may still be concerned that the patent owner can use confidential information acquired during litigation to narrowly tailor the language of the amended patent. This allows the patent owner to avoid prior art and more closely resemble the actions of the alleged infringer, thereby improving its position in the litigation (see *DeCurtis v. Carnival*).

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For additional consideration:

- Although courts may state that the phrase “indirectly draft or advise the amendments to patent claims” is not vague, it can create a gray area in practice as to what is and is not “indirect” and thus what is and is not barred.
- Having a checklist based on the model protective order may be helpful when drafting or reading a Prosecution Bar in a case.

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