Any effort by the party seeking the bar to obtain a bar broader than the same subject matter of the information should be viewed strictly. Another facet of appropriate breadth is whether the bar should cover only U.S. cases, or also preclude prosecution of foreign filings.[180]

A fourth and related issue is whether the bar applies only to the client that the lawyer is representing in the case, or whether it should prohibit a lawyer who is representing any client within the scope of the technological definition from prosecuting applications.[181] If the practitioner is representing multiple clients in the same narrow field of technology, then a broad bar may seem appropriate. However, the obvious consequence of a broad bar is severe economic impact on the practitioner. Clearly, a court should weigh these competing concerns in determining whether the bar should preclude prosecution for any client other than the one which the lawyer is representing in the litigation.

Another aspect of the protective order is the definition of what constitutes "prosecution." Incorporating into the protective order definitions of which activities are prohibited, and which are not, is crucial. For example, some courts hold that the bar only applies to lawyers who "actually draft patent applications, claim language for patent applications or arguments made in support of patent applications related to" the disclosed materials.[182] This definition can be critical. For example, in *Chan v. Intuit, Inc.*,[183] the party seeking to bar the opposing party from access to information defined "patent prosecution" as follows:

> "Patenting" shall mean and include:
>
> (i) preparing and/or prosecuting any patent application (or portion thereof), whether design or utility, and either in the United States or abroad . . . ;

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attorneys have access to the Defendant's highly confidential information, they will be barred from prosecuting patents 'relating to the broad subject matter of the patents in suit,' that is, LCD technology . . . .

Commissariat a L'Energie Atomique, 2004 U.S. Dist. LEXIS 12782, at *6.

180. Medtronic, Inc. v. Guidant Corp., 2001 U.S. Dist. LEXIS 22805, at *11 (D. Minn. Dec. 19, 2001) (seeking bar as to domestic and foreign filings).

181. *See* Nazomi Communications, Inc. v. Arm Holdings PLC, 2002 U.S. Dist. LEXIS 21400, at * 6 (N.D. Cal. Oct. 11, 2002) (patentee argued that bar should be as to all clients that lawyer is representing in the technology area); Motorola, Inc. v. Interdigital Tech. Corp., No. 93-488-LON, 1994 U.S. Dist. LEXIS 20714, at *18 (D. Del. Dec. 19, 1994) (court precluded prosecution only of the client involved in the litigation, ITC, not any other clients). Interestingly, the *Motorola* court presumed that the ethical duty to its client, ITC would prevent the firm "from prosecuting patent applications for other clients that are of similar subject matter as ITC's patents in this case." *Id.* at *18 n. 5.

182. Medtronic, Inc. v. Guidant Corp., 2001 U.S. Dist. LEXIS 22805, at *15 (D. Minn. Dec. 19, 2001).

183. 218 F.R.D. 659 (N.D. Cal. 2003).

(ii) preparing patent claim(s) relating to any of the fields listed above;
(iii) providing advice, counsel or suggestion regarding, or in any other way influencing, claim scope and/or language, embodiment(s) for claim coverage, claim(s) for prosecution, or products or processes for coverage by claim(s) relating to the field(s) listed ... above; and
(iv) assisting, supervising, and/or providing counsel to anyone in connection with doing any of the foregoing.[184]

The district court rejected only one part of this definition, holding Paragraph 4(a)(iv) was "too broad and overly restrictive."[185] Inclusion in a protective order of too broad a definition unnecessarily and perhaps unfairly restricts the prosecution activities of the prosecuting-litigator, and with little actual, commensurate benefit to the opposing party.[186] An important issue to consider is whether the definition should include re-examination proceedings.[187]

Finally, as noted above, the prosecuting-litigator should determine whether the protective order should make exception for disclosures appropriate under the new PTO procedure in MPEP Section 724.01.[188] By including such a provision, the prosecuting-litigator can ensure that the protective order permits disclosure to the PTO of material information in a manner that preserves the confidentiality of the information.

The terms of the protective order on each of these issues can dramatically affect not just the client but the lawyer as well. For example, many patent practitioners develop expertise in narrow technologies,[189] and so a ban as to all clients in a "field" or "subject matter"—if broadly defined—could cost the lawyer significant revenue. Likewise, a client who relies on such a practitioner for

184. *Id* at 662.
185. *Id.* at 662; *see also* Promega Corp. v. Applera Corp., No. 01-C-244-C, 2002 WL 32359938 (W. D. Wis. June 7, 2002) (analyzing scope of protective order as applied to person who sat on board of several companies).
186 *See also Andrx Pharm., LLC v. Glaxosmithkline, PLC,* 236 F.R.D. 583 (S.D. Fla. 2006) (scope of claims constituted "competitive decision-making").
187 *See Microunity Sys., Eng'r., Inc. v. Dell, Inc.,* 2005 WL 2299440 (E.D. Tex. July 18, 2005) (party moved for clarification that protective order precluded participation in reexamination proceedings, but denying that scope of protection)
188. The public policy in ensuring that material information be disclosed to the PTO should, if it can be done in compliance with Section 724.01, outweigh any need to avoid disclosing information to the PTO. *Cf.* Beckman Indus., Inc. v. Int'l Ins. Co., 966 F.2d 470, 475 (9th Cir. 1992) (analyzing modification of protective order to permit disclosure of information in other court proceedings).
189. The lawyer in *In re Sibia*, for example, prosecuted applications for fifty clients in the same general field.