

ORAL ORDER: The Court has reviewed Plaintiff's discovery dispute motion ("Motion"), (D.I. 122), via which Plaintiff seeks an order stating that Defendant has violated the Protective Order ("PO") entered in this case and should be sanctioned by being required to withdraw any Motion to Amend claims it filed in the inter partes review proceeding ("IPR") for the 922 patent. After reviewing the Motion, the briefing related thereto, (D.I. 123; D.I. 124; D.I. 130), and having heard argument during a teleconference on February 13, 2023, the Court hereby ORDERS that the Motion is DENIED without prejudice to renew. The Court rejects Plaintiff's assertion that the second sentence of paragraph 6(a) of the PO has anything to do with the parties' obligations as to IPR proceedings; that sentence relates only to "advice" given regarding "prosecution" of patents in the U.S. Patent and Trademark Office ("PTO"), which is not at issue here. (D.I. 33, ex. A at 11) The third sentence of paragraph 6(a) is the one that applies, inter alia, to "inter partes review proceedings[.]" (Id. at 11-12) But the parties drafted that sentence only to preclude "the use of all Designated Material" by covered persons "for the purpose of amending, crafting, or drafting of [certain] patent claims on behalf of the Receiving Party[.]" (Id.) Plaintiff suggests that this sentence prohibits any acts at all by covered persons for the purpose of claim amendment in an IPR. But the parties and their counsel are sophisticated, and if they had wished for that type of broader prohibition, they would have drafted the sentence to read "This subparagraph further precludes any act by such persons for the purpose of amending..." or something to that effect. Therefore, and in the absence of proof that any covered person has actually used Designated Material for the purpose of amending patent claims in the IPR, the Court cannot grant the Motion. That said, the Court takes no position as to whether Plaintiff might in the future be able to show a violation of the third sentence of the PO, nor as to whether Plaintiff would be entitled to obtain discovery regarding that subject in this Court. Ordered by Judge Christopher J. Burke on 2/13/2023. (mlc) (Entered: 02/13/2023)

As of February 14, 2023, PACER did not contain a publicly available document associated with this docket entry. The text of the docket entry is shown above.

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