

Trial Counsel Having Access To Defendant's Confidential Information Permitted To Represent Patentee In Reexamination Proceeding. (Thynge, MJ)

Xerox Corp. v. Google, Inc.

In *Xerox Corp. v. Google, Inc.*, 270 F.R.D. 182 (D. Del. 2010), Magistrate Judge Thynge rejected proposed language in a protective order that would have barred Xerox's trial counsel from assisting in a reexamination proceeding. In the dispute over the protective order, the Defendants argued that Xerox's trial counsel could use Defendants' confidential information produced during discovery to strategically narrow Xerox's claims in a corresponding reexamination. *Id.* at *5 - *6. While the Court agreed that "any use of [Defendants'] confidential information by [Xerox] during reexamination would be improper," the Court nonetheless determined that the risk of such use was outweighed by the potential harm to Xerox in denying them their choice of reexamination counsel. *See id.* at *6-*8.