



## Court Declines to Disqualify Outside Counsel Absent Clear Violation of Prosecution Bar

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A Northern District of Florida court denied a motion to disqualify plaintiffs' outside counsel based on an alleged violation of a prosecution bar because, although the issue was "not free of doubt," the court did not find a "clear violation" of the protective order. In reaching its decision, the court explained that disqualification is a "high bar" requiring compelling reasons and that motions to disqualify based on violating a prosecution bar, therefore, should only be granted "if the violation was clear." Here, the court found it was unclear whether outside counsel prosecuted patents "related to" the asserted patent, in violation of the order, because the scope of "related to" was not clearly defined.

In consolidated patent infringement actions involving U.S. Patent No. 10,514,223—directed to "forced reset triggers"—the parties agreed to a prosecution bar that prohibited outside counsel who received "highly confidential documents" from "participating in the prosecution of any present or future patent application...that is a **counterpart** to or **related** to the ['223 patent]." As the court noted, "[t]his prosecution bar, unlike most, has no explicit limit on subject matter, other than its reference to the '223 patent, **and no time limit.**"

After the infringement cases settled, the plaintiffs brought contempt proceedings against the defendants. In turn, the defendants moved to disqualify plaintiffs' outside counsel, Mr. Bellamy, for allegedly violating the prosecution bar when he prosecuted "several patents that, like the '223 patent, dealt with forced reset triggers," some of which "explicitly incorporated the '223 patent by reference." According to the defendants, such patents were "related to" the '223 patent and thus within the scope of the bar. Plaintiffs countered that the prosecuted

patents were not “related to” the ’223 patent because they were not “traceable to a common ancestor application through continuations, continuations-in-part, or divisionals.”

Before deciding the motion, the court determined that the phrase “counterpart” is a term of art in the patent field that applies to patents in different countries covering the same device. The parties agreed the patents prosecuted by Mr. Bellamy were not counterparts. The court then considered the phrase “related to” and found it was unclear in the prosecution bar at hand. According to the court, the patents prosecuted by Mr. Bellamy were “probably related” to the ’223 patent if the “ordinary, nontechnical” meaning of “related to” applied. However, it was not clear that meaning applied. The bar at issue was “different from the standard orders used in various districts” because it “has no explicit limit on subject matter, other than its reference to the ’223 patent, and no time limit.” As the court explained, “[i]t would be extraordinary to **forever** bar an attorney from prosecuting any patent ‘related to’ the ’223 patent only in the sense that the patent dealt with the same general subject matter.” The lack of express language permitting such an extraordinary result “support[ed] the view that the prosecution bar, properly construed, is not this broad.” On the other hand, narrowly “construing this prosecution bar to apply only to continuations, continuations-in-part, and divisionals” would allow outside counsel to “prosecute patents for ’223 work-arounds or other similar devices.” This “risks the unconscious or inadvertent use of the confidential information” during prosecution, which “is the very risk prosecution bars are intended to avoid.” Accordingly, neither interpretation was clearly correct on this record.

But the court determined that it need not resolve the meaning of “related to” because the lack of clarity in its meaning was sufficient reason to deny the motion to disqualify. Under the standard the court applied, “a motion to disqualify an adversary’s chosen counsel for violating a court order should be granted only if the violation was clear.” Here, the alleged violation was not clear in view of the uncertain meaning of “related to,” and thus the defendants failed to meet the “high bar” for disqualification.

Moreover, the court noted that even if the prosecution bar were construed in the defendants’ favor, the appropriate remedy “would be to prohibit [Mr. Bellamy’s] further involvement in prosecuting the patents,” not to disqualify him. As the court explained, “[a]ny future improper harm to the defendants could come only from Mr. Bellamy’s improper prosecution of extraneous patents,” not from litigating in a case where outside counsel has “access to the highly confidential documents, one way or the other.”

## **Practice Tip:**

Because enforcement of prosecution bars may be subject to a high standard, practitioners should choose language that clearly reflects the scope of barred activities, including by specifying both subject matter and duration covered by the bar, and should avoid relying solely on undefined terms of art, such as “related” patents.

*Rare Breed Triggers, LLC v. Big Daddy Enterprises, Inc.*, 1-21-cv-00149 (N.D.F.L. Dec. 9, 2025) (Robert L. Hinkle).

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