

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

SECURUS TECHNOLOGIES, INC.,	§	
	§	
Plaintiff,	§	
v.	§	CIVIL ACTION NO.
	§	3:16-CV-01338-K
GLOBAL TEL*LINK CORPORATION,	§	
	§	
Defendant.	§	

ORDER

Before the Court is Plaintiff Securus Technologies, Inc.’s Motion to Disqualify Sterne, Kessler, Goldstein & Fox, P.L.L.C. As Counsel for Defendant Global Tel*Link Corporation (Doc. No. 67). Plaintiff Securus Technologies, Inc. (“Securus”) has requested that this Court disqualify the law firm of Sterne, Kessler, Goldstein & Fox, P.L.L.C (“Sterne”) from representing the Defendant, Global Tel*Link Corporation (“GTL”) in this matter. For the following reasons, the Court **DENIES** Securus’ motion but **orders** Sterne to maintain the ethical, protective wall already in place at Sterne to prevent unauthorized access to and use of Securus’ confidential information that is subject to and protected by the Protective Orders issued by this Court.

Prior to January 2017, GTL was represented by Kellogg, Huber, Hansen, Todd, Evans & Figel, P.L.L.C (“Kellogg”). Mr. Michael Joffre and Mr. J.C. Rozendaal were both Kellogg attorneys of record in this matter. In January 2017, Mr.

Rozendaal and Mr. Joffre moved from Kellogg to Sterne. As of this date, both law firms, Kellogg and Sterne, represent GTL in this matter.

Securus asserts that Sterne must be disqualified from representing GTL because it has some attorneys working on the instant litigation and other attorneys who represent GTL for its patent prosecution and for proceedings before the USPTO. Securus asserts that GTL's litigation counsel in this case has access to Securus' confidential information, and this confidential information might be transferred from these litigation attorneys to those working on USPTO proceedings or patent prosecutions. Specifically, the concern is that those attorneys working on GTL's patents and USPTO proceedings could use Securus' confidential information to Securus' detriment, for example by drafting claims so that they read onto Securus' products.

GTL responds that this is not a situation in which Sterne must be disqualified because Sterne, Mr. Rozendaal, or Mr. Joffre have never represented Securus, so none of them has any obligation of the ethical rules related to the confidential information of a former client. In this specific situation, GTL asserts that a protective order and an ethical wall will be sufficient to prevent unauthorized access and use of Securus' confidential information.

The Court agrees with GTL's argument that Mr. Rozendaal and Mr. Joffre do not technically have any duty to Securus as they would to a former client because they have never represented Securus. But the Court also recognizes the validity of

Securus' concerns regarding the safe-keeping and proper use of Securus' confidential information obtained by GTL's litigation counsel. Mr. Rozendaal and Mr. Joffre have access to Securus' confidential information through discovery in this matter; information GTL's attorneys working on its patents and USPTO proceedings would not have. Certainly, the improper use of this information could harm Securus; however, access to an opposing party's confidential information through litigation discovery is not an unusual situation, especially in patent litigation.

Protections for access and distribution of a party's confidential information are controlled through the use of protective orders. In this case, confidential information was protected upon the filing of the case by an automatic protection order put in place by the Court's Miscellaneous Order No. 62. This protective order was in place at the time that Mr. Rozendaal and Mr. Joffre moved from Kellogg to Sterne as well as at the time Securus filed this motion to disqualify. After the briefing on this motion to disqualify was completed, the parties filed a Joint Motion for Entry of Agreed Protective Order (Doc. No. 92), which was entered by the Court on July 7, 2017 (Doc. No 98).

This Agreed Protective Order places safeguarding restrictions on the dissemination and use of Securus' confidential information disclosed in this litigation, including: (1) restrictions on who can access the information; (2) restriction requiring that the confidential material be used only in this litigation and in the other cases between these parties that are pending in this district; (3) restriction specifically

preventing use of the information in any patent prosecution, reexamination, reissue, or review proceeding concerning any application or issue patent; (4) a patent prosecution bar preventing attorneys who have accessed confidential information from participating in GTL patent prosecution; and (5) a bar preventing attorneys who have accessed confidential information from participating in other patent review proceedings in which GTL would be able to amend claim language.

In addition to the protection already in place through the Agreed Protective Order, Sterne acknowledges that it has a duty to maintain the confidentiality of Securus' information. Sterne also acknowledges a concern may be raised about its ability to comply with its duty because Sterne has some lawyers working on this GTL litigation and other Sterne lawyers working on other GTL matters. Sterne has already established an ethical wall to separate its litigation section from its prosecution and USPTO sections. The Court agrees with Sterne and GTL that this is a prudent practice that Sterne shall continue to use to protect Securus' confidential information. The need to create and maintain this wall, however, does not come from an ethical rule that would disqualify Sterne. Sterne's duty to do this comes from the Miscellaneous Order and Agreed Protective Order issued by this Court.

GTL and its attorneys were obligated to safeguard this information in accordance with the Protective Orders in this case both before and after Mr. Rozendaal and Mr. Joffre moved to Sterne. At this time, there is no indication to the Court that any of GTL's counsel or their law firms have done anything to

violate these orders. There is also no indication that the move of these attorneys from Kellogg to Sterne has changed these attorneys' respect for or compliance with the Court's Protective Orders. The voluntary establishment of a protective wall by Sterne indicates to the Court that this law firm takes this duty seriously.

In its reply brief, Securus presented a proposed amendment to the default protective order language that Securus asserts would address some of its concerns if the Court refused to disqualify Sterne. The Court notes that this language was designed to amend the language in the Court's default Miscellaneous Protective Order in place at the time Securus filed its motion; the parties had not yet sought entry of a specific protective order. After Securus filed its reply brief, the parties submitted an Agreed Protective Order, which the Court entered. The Court carefully reviewed the proposed amendment language and the language of the current Protective Order. The Court concludes that the language of the current Agreed Protective Order sufficiently addresses Securus' concerns, and the proposed amendment language in the reply would place too high a burden on GTL's right to choose its counsel. The Court declines to adopt any of the additional amendment language proposed by Securus in its reply.

The Court **DENIES** the motion to disqualify to the extent that Securus seeks (1) an order from this Court disqualifying Sterne and any of its attorneys from representing GTL in this matter and (2) additional protective order language amending the Court's Miscellaneous Protective Order or the parties' Agreed

Protective Order. However, the Court **ORDERS** Sterne, Mr. Rozendaal, and Mr. Joffre to maintain the ethical wall already in place at Sterne to prevent unauthorized access to and use of Securus' confidential information that is protected by the Protective Orders issued by this Court.

SO ORDERED.

Signed September 18th, 2017.



ED KINKEADE
UNITED STATES DISTRICT JUDGE