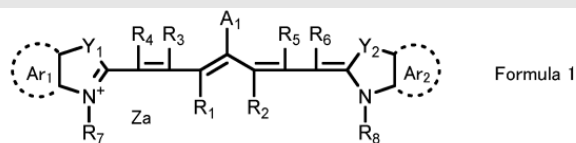


**UPC CFI, Local Division Düsseldorf, 27 March 2024,
Fujifilm v Kodak**



Formula 1

PATENT LAW – PROCEDURAL LAW

Confidentiality club membership rules are to balance (i) the right to have unlimited access to the file documents against (ii) the interest to protect confidential information, on the facts of a particular case ([Article 58 UPCA](#), [Rule 262A RoP](#))

• [Whereas certain guidelines how this balance can be struck may be developed, a schematic solution is not possible](#)

When deciding upon the level of restriction, again the circumstances of the case are to be taken into consideration.

• [Therefore the argument of the defendants that access should be restricted to three natural persons, which it presents as a common ground argument, is undifferentiated.](#)

• [The information for which the defendants seek protection concern a prior use right, which defendants allege to have acquired in 2017.](#)

In consequence, the facts submitted in this context – except for information in the context of enforcement security – relate to seven year old business practice. Hence, here the case as presented calls for a considerable amount of reasoning on the side of the defendants, why such information – which claimant describes as “historic” – still needs protection and why it – if disclosed to the claimant – would put claimant at an unfair and unjustified advantage as a competitor and would endanger the actual business of the defendants, if known by its competitor to date. Even more, the defendants do not even market the respective product anymore. In such a setting it appears to be a disproportionate burden upon the claimant to reduce the number of persons being able to assist the representatives in arguing the case before the court too strictly. Moreover, it has to be taken into consideration that only some parts of the confidential information are of importance to certain groups of persons the claimant request to be granted access. Whereas business figures will be more valuable information for claimant’s employees in its business department, technical details of defendants’ products and production development cycles appear to be of less interest and vice versa with regard to its employees working in its R & D department.

Before this background the defendants cannot be heard to limit the number of natural persons to three out of the five named persons they do not oppose to. The claimant, also having regard to the complexity of the dispute, has a legitimate interest to grant access to all five persons,

i.e. the respective group leaders and their supporting assistants.

Request, that employees from claimant’s R & D department must not be granted access, denied.

• [Claimant sets out in detail with persuasive arguments why it is necessary to exchange with these employees exactly, who are in a position to comment on defendants’ allegations before the background of the technical expertise in and knowledge of the industry sector. In a dispute revolving around technical aspects it is of fundamental importance that a party may have resort to technically qualified employees in order to exercise its right to be heard. Only in rare circumstances where e.g. cutting-edge technical improvements are at stake, which put the proprietor in a significant pole position on the market, further restrictions may be considered to be proportionate. This is not the case here.](#)

Requests of the defendants to set out in further detail, in which way the claimant has to organize itself in order to prevent the breach of the court’s protective order have to be rejected.

• [The information is sufficiently protected by the order of the court without such detailed measures to be ordered. A breach of the order will result in severe penalty payments.](#)

Rejected as manifestly disproportionate on the instant facts

• [requests to impose upon the named employees to refrain from getting involved in research and development, pricing or any other competitive decision making, and shall not be involved in prosecution of patent applications for a period of 5 years after the end of the present proceedings \(including potential appeal proceedings\).](#)

Source: [Unified Patent Court](#)

**UPC Court of First Instance,
Local Division Düsseldorf, 27 March 2024**

(Thomas, Thom, Lopes)
Düsseldorf Local Division
UPC_CFI_355/2023

Procedural Order

of the Court of First Instance of the Unified Patent Court
issued on 27 March 2024

concerning [EP 3 594 009 B1](#)

HEADNOTES:

1. When deciding an application to grant protection for the allegedly confidential information, the court has to weigh the right of a party to have unlimited access to the documents contained in the file, which guarantees its fundamental right to be heard, against the interest of the opposing party to have its confidential information protected.

2. A party seeking protection for confidential information has – in a first step – to put forward

sufficiently substantiated arguments, why it believes the information concerned is to be protected. It is therefore not enough to have resort to general circumstances such as there being competition between the parties to the dispute. The court has to be put in a position to understand, why the applicant believes that the concrete information to be protected is vulnerable and confidential. It is therefore necessary to substantiate with regard to each redacted part of the written submissions, why this explicit part of the submission amounts to confidential information.

3. Once adequate explanation in that regard has been received, it is then for the court to decide, which extent of certainty has to be reached for the court to believe that the applicant's allegations are true. The necessary level of persuasion that the information is confidential in nature may differ having due regard to the substance matter of the dispute.

4. In a further step, the court has to strike a balance between the adequate level of protection of said confidential information and the right of the claimant to have sufficient access to the information in order to exercise its right to be heard. In this context, [R. 262A.6 RoP](#) establishes with all desirable clarity as a ground rule of paramount importance that at least one natural person from each party and the respective lawyers or other representatives are to be granted access in order to ensure a fair trial. When deciding upon the level of restriction, again the circumstances of the case are to be taken into consideration. Whereas in some cases a restriction may be more important to safeguard the confidential information concerned, in other cases the right to full access to the files of a party trumps the interest of protection.

KEYWORDS:

Protection of confidential information; [R. 262A RoP](#); confidential information; confidentiality club

CLAIMANT:

FUJIFILM Corporation, 26-30, Nishiazabu 2-chome, Minato-ku, Tokyo 106-8620, Japan, represented by: Lars Baum, HOYNG ROKH MONEGIER, Steinstraße 20, 40212 Düsseldorf, Germany electronic address for service: ...

DEFENDANT:

1. **Kodak GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs ... and ..., at the same place, represented by: Eva Acker, Freshfields Bruckhaus Deringer Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz 1, 40545 Düsseldorf, Germany electronic address for service: ...

2. **Kodak Graphic Communications GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs ... and ..., at the same place, represented by: Eva Acker, Freshfields Bruckhaus Deringer Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz 1, 40545 Düsseldorf, Germany electronic address for service: ...

3. **Kodak Holding GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs ... and ..., at the same place,

represented by: Eva Acker, Freshfields Bruckhaus Deringer Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz 1, 40545 Düsseldorf, Germany electronic address for service: ...

PATENT AT ISSUE:

European patent n° [EP 3 594 009 B1](#)

PANEL/DIVISION:

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This order was issued by Presiding Judge Thomas acting as judge-rapporteur, by the legally qualified judge Dr. Thom and the legally qualified judge Lopes.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS:

Patent infringement action – [Rule 262A RoP](#) Final order of the panel

SUMMARY OF THE FACTS AND STATEMENT OF FORMS OF ORDER SOUGHT BY THE PARTIES: :

The defendants put forward information in their statements of defence allegedly being of confidential nature. The respective information is highlighted in grey. With regard to said information the defendants submitted an application for protection of confidential information under R. 262A RoP using the dedicated workflow in the CMS (App_6761/2024) and uploaded redacted versions of their written submissions.

The defendants request:

1. to classify the information listed in more detail in the following table (which are highlighted in gray in the Statement of Defence or marked as confidential (evidence)) submitted in in ACT_578607/2023 as confidential ([Rule 262.2 RoP UPC](#));

		Description
a)	Marginal no. 87 to 109, 115 to 11, 124 to 126, 131 and 135 Exhibit FBD-T 9 to 15a	Information on Defendants research and development process
b)	Marginal no. 483, 496, 498, 500, 503, 508 to 510, 512 to 518 and 520 Exhibit FBD-T 27	Information on Defendant's business figures

2. to order that the information subject to confidentiality under Item 1. above shall be subject to an appropriate duty of confidentiality, i.e., shall be kept confidential by anyone who becomes aware of it by reason of his or her participation in these proceedings (as a party, representative, witness, expert, court employee, or otherwise) and shall not be used or disclosed outside of these court proceedings unless he or she has become aware of it outside of these proceedings, provided that it became available to the receiving party on a non-confidential basis from a source other than the Defendant or its affiliates, provided that such source is not bound by a confidentiality agreement with or other obligation of secrecy to a Defendant or its affiliates;

3. Plaintiff may make available the information under Item 1. only to those representatives and internally to those employees that have a legitimate need to access the information. The access is limited to Plaintiffs legal representatives and a maximum of three employees to be

named by the Plaintiff pursuant to Rule 262.A RoP UPC; whereby the named employees shall not be involved in research and development, pricing or any other competitive decision making, and shall not be involved in prosecution of patent applications for a period of 5 years after the end of the present proceedings (including potential appeal proceedings);

4. to point out

a. that the obligation to maintain secrecy pursuant to Item 1. shall continue to apply after the court proceedings have been concluded unless the disputed information becomes known or readily accessible to persons in the circles that usually have access to such information;

b. that the information to be kept confidential pursuant to Item 1. shall be kept confidential by all persons who become aware of it due to their participation in these proceedings (as a party, representative, witness, expert, or otherwise) and that it shall not be used or disclosed outside of these proceedings unless they have become aware of it outside of the proceedings, provided that it became available to the receiving party on a non-confidential basis from a source other than the Defendant or its affiliates, provided that such source is not bound by a confidentiality agreement with or other obligation of secrecy to a Defendant or its affiliates;

c. that in the case of a culpable violation, the court may impose a recurring penalty payment on the obligated party for each violation and enforce it immediately;

The judge-rapporteur by way of a preliminary order dated 7 February 2024 granted access to the unredacted version of said documents exclusively to the claimant's authorised representatives and their assistants pending a final decision upon the confidentiality request and invited the claimant to comment.

In response, the claimant submitted that the information allegedly being confidential in nature failed to be of such quality, that a restriction to three employees was not justifiable on the facts of the case at hand and characterized the restrictions to be imposed upon claimant's employees under item 3 of defendants' request to be disproportionate.

Accordingly, claimant requests:

A. As a main request, to dismiss all Requests of the Request of Protection of Confidential Information of February 6th, 2024.

B. As a subsidiary request,

I. should the Court in principle find a fixed limitation of employees of the Claimant justified, to grant the Claimant the right to provide access to the confidential information to further employees upon request.

II. to grant access to the information specified in Request 1 of the Request for Protection of Confidential Information of February 6th, 2024 to any private expert, upon request.

III. to otherwise dismiss the Requests of the Request for Protection of Confidential Information of February 6th, 2024.

C. As a further subsidiary request,

I. to grant access to the information specified in Request 1 of the Request for Protection of Confidential

Information of February 6th, 2024 to the following nine employees of the Claimant:

- Ms. ... , Intellectual Property Legal Division
- Mr. ... , Intellectual Property Legal Division
- Mr. ... , Manager, Intellectual Property Technology Division
- Mr. ... , Senior Manager, Intellectual Property Technology Division
- Mr. ... , Intellectual Property Technology Division
- Mr. ... , Manager, Graphic Communication Laboratory
- Mr. ... , Manager, Synthetic Organic Chemistry Laboratory
- Mr. ... , Senior Manger, GC Business
- Mr. ... , Senior Manager, GC Business

and to grant the Claimant the right to provide access to the confidential information to further employees upon request.

II. to grant access to the information specified in Request 1 of the Request for Protection of Confidential Information of February 6th, 2024 to any private expert upon request.

III. to otherwise dismiss the Requests of the Request for Protection of Confidential Information of February 6th, 2024.

D. As a further subsidiary request,

I. to grant access to the information specified in Request 1 of the Request for Protection of Confidential Information of February 6th, 2024 to the following three employees of the Claimant:

- Mr. ... , Manager, Intellectual Property Technology Div.
- Ms. ... , Intellectual Property Legal Div.
- Mr. ... , Manager, Graphic Communication Laboratory

and to grant the Claimant the right to provide access to the confidential information to further employees upon request.

II. to grant access to the information specified in Request 1 of the Request for Protection of Confidential Information of February 6th, 2024 to any private expert upon request.

III. to otherwise dismiss the Requests of the Request for Protection of Confidential Information of February 6th, 2024.

The judge-rapporteur – in a further preliminary order dated 15 February 2024 – invited the defendants to comment to claimant's submissions and requests.

The defendants answered by reiterating their requests for protection of confidentiality, demanded to reject claimant's requests because granting unlimited access or access to the group of employees contained in the subsidiary requests was unacceptable. Furthermore, they put forward concerns with regard to the individual natural persons named by claimant. However, the defendants clarified that they do not oppose involvement of external private experts.

In a further preliminary order dated 26 February 2024 the judge-rapporteur therefore allowed access to such private experts and modified the initial order

accordingly. Moreover, claimant was invited to justify why access to the information has to be granted to more than three employees. Both parties were invited to comment.

Claimant responded by setting out in detail why the nine persons individually named had to be granted access to the allegedly confidential information to enable claimant to comment with sufficient substance to the submissions of defendant regarding its prior use right defence, insisting on the necessity to have persons from claimant's R & D department to get involved and reiterated its legal arguments.

The respondents answered by requesting further to their initial requests:

9. to order that the access to information under Item 1 for the natural persons from the Plaintiff to be named shall only be provided by the Plaintiff's legal representatives to the employees named in the pre-Order through the following means:

- Granting access via a digital data room hosted by Plaintiff's legal representative or by a third party appointed by the Plaintiff and approved by both parties that solely allows viewing and physical printing with a watermark and prevents downloading, copying, forwarding or screenshots of the displayed information whereby access to the digital data room ends after the final termination of the proceedings or

- Physical delivery of watermarked hard copies, which hard copies and any printed copies from the digital data room may not be copied physically or scanned electronically;

10. to order that any hard copy or electronic copy of the information under Item 1. and summaries or notes relating to information under Item 1. shall be destroyed, deleted, or returned to the Defendants by the Plaintiff after the final termination of the proceedings. This shall not apply to the Plaintiff's legal representative to the extent that this provision conflicts with professional conduct relating to retention obligations;

11. to order that the access to the confidential information to the persons to be named shall be granted only after the expiry of a reasonable period of at least 5 working days from the issuing of the final order;

12. to order – in the event, that the final order is issued by the panel and not by the judge-rapporteur or the presiding judge – that the final order may be subject to appeal under [Rule 220.2 RoP UPCA](#).

and justified their additional requests.

In his last preliminary order dated 7 March 2024 the judge-rapporteur outlined an intended final order granting the nine named employees of claimant access to the allegedly confidential information and invited the parties to comment.

The Defendants took advantage of this opportunity and requested to the previous request under item 9 in light of an order recently issued by the Düsseldorf Local Divisions ([UPC CFI 463/2024](#), [App 8500/2024](#), [Order issued on 11 March 2024](#)):

13. to order the Plaintiff to take appropriate measures to ensure that the information obtained by the named employees that is subject to this confidentiality order

remains confidential and is not used outside of these proceedings. In particular, the Plaintiff must ensure that the information subject to the confidentiality obligation is only contained in secure electronic files at the Plaintiff to which only the named employees have access. Insofar as the information subject to the confidentiality obligation is printed by one of the named employees, suitable measures must be taken to ensure that only the named persons have access to these printouts.

For the sake of completeness, the details of the orders as well as the facts and arguments contained in the parties' written submissions are hereby included by way of reference. All orders issued in the parallel proceedings between the parties pending at the Mannheim and the Düsseldorf Local Division have been aligned in an attempt to arrive at a harmonized resolution of the legal issues concerned.

GROUNDS OF THE ORDER:

I.

The panel decides the matter at hand upon request by the judge-rapporteur under [R. 331.2 RoP](#).

II.

When deciding the application of the defendants to grant protection for the allegedly confidential information, the court has to weigh the right of a party to have unlimited access to the documents contained in the file, which guarantees its fundamental right to be heard, against the interest of the opposing party to have its confidential information protected. Both fundamental principles have to be balanced against each other on the instant facts of the particular case. Whereas certain guidelines how this balance can be struck may be developed, a schematic solution is not possible.

1.

[Art. 56\(2\) UPCA](#) stipulates that the court shall take due account of the interest of the parties and shall, before making an order, give any party the opportunity to be heard, unless this is incompatible with the effective enforcement of such order. Furthermore, [Art. 76\(2\) UPCA](#) points out that the parties must have had an opportunity to present their comments in the course of the proceedings before the UPC.

[Art. 58 UPCA](#) on the other hand sets out that the court may order that the collection and use of evidence in proceedings before it be restricted or prohibited or that access to such evidence be restricted to specific persons to protect trade secrets, personal data or other confidential information of a party to the proceedings or of a third party, or to prevent an abuse of evidence. Therefore the Agreement also pays attention to the legitimate interest of a party that its confidential information is to be protected as far as the opponent's right to be heard allows.

According to [R. 262A.1 RoP](#) a party may therefore make an application to the court for an order that certain information contained in its pleadings or the collection and use of evidence in proceedings may be restricted or prohibited or that access to such information or evidence be restricted to specific persons. The application may be allowed by the court considering in particular whether the grounds relied upon by the applicant for the order

significantly outweigh the interest of the other party to have full access to the information and evidence in question ([R. 262A.5 RoP](#)). The number of persons which are granted access to such information or evidence shall be no greater than necessary in order to ensure compliance with the right of the parties to the legal proceedings to an effective remedy and to a fair trial, and shall include, at least, one natural person from each party and the respective lawyers or other representatives of those parties to the legal proceedings ([R. 262A.6 RoP](#)).

2.

The Agreement and the Rules of Procedure thereby show that on principle a party to a proceeding before the UPC has an unlimited right to have resort to the contents of the file and the information submitted by its opponent. Being able to digest the facts and arguments put forward by the opposing party is an indispensable prerequisite which enables the party concerned to develop its own arguments and therefore ensures the fundamental right to be heard before it has to accept a decision by the court. The court's power to finally and with binding effect decide on behalf of the parties upon their matter is only vested upon the court once the right to be heard has been respected. In consequence, any limitation of the free access to the file has to be justified.

3.

A party seeking protection for confidential information, therefore, has – in a first step – to put forward sufficiently substantiated arguments, why it believes the information concerned is to be protected. It is therefore not enough to have resort to general circumstances such as there being competition between the parties to the dispute. For the court to be able to assess whether it may limit a party's access to the file, it has to be furnished with concrete arguments which make it sufficiently plausible that the facts which are sought to be protected are confidential in nature. Where a party fails to submit sufficient arguments, a limitation in access by the opposing party has to be denied. The court has to be put in a position to understand, why the applicant believes that the concrete information to be protected is vulnerable and confidential. It is therefore necessary to substantiate with regard to each redacted part of the written submissions, why this explicit part of the submission amounts to confidential information.

4.

Once adequate explanation in that regard has been received, it is then for the court to decide, which extent of certainty has to be reached for the court to believe that the applicant's allegations are true. In this context the [directive \(EU\) 2016/943 of the European Parliament and of the Council of 8 June 2016](#) on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure (hereinafter: "trade secrets directive") oftentimes is also referred to in patent matters. Whereas the directive may serve as a general point of reference in order to determine the level and scope of protection of trade secrets throughout the European Union, still such reference is to be made with due diligence. It is to be

pointed out that the necessary scope of protection of confidential information may differ with regard to the nature of the dispute lying before the court. Whereas in a proceeding, in which a claimant applies for certain measures in order to prevent or obtain redress for the unlawful acquisition, use or disclosure of their trade secret, i.e. in an proceeding where the dispute centres around the question, whether the information concerned amounts to a trade secret, it may be sufficient to determine in line with [Art. 9\(1\) of the directive](#) whether that information is a trade secret or at least an "alleged trade secret" to issue an order. This can be justified so as to avoid that the main substance matter – does the information in fact represent a trade secret or not – is not already to be decided upon prematurely in the context of the procedural protective order. Still, it may be significantly different scenario, where the parties concerned are entangled in a patent infringement matter and in that context alone make reference to confidential information in order to support their legal arguments. Accordingly, the necessary level of persuasion that the information is confidential in nature may differ having due regard to the substance matter of the dispute.

5.

In the case lying before the court, the defendants put forward information they consider to be confidential in order to support their non-infringement argument that they benefit from a right based on prior use of the invention under [Art. 28 UPCA](#). Therefore, the dispute does not centre around an alleged unlawful acquisition, use or disclosure of a trade secret, but is about an alleged patent infringement. The defendants' application under [R. 262A RoP](#) is a related proceeding to the main proceeding, which is the patent infringement case. In such a procedural context it will in principle – except for situations of exceptional character – be sufficient for the court to arrive at an ample degree of certainty that the information is confidential. It then depends on the context of the allegations submitted, whether the court deems it appropriate or even necessary to explore the arguments in even more detail, e.g. by taking evidence in case there is dispute amongst the parties whether or not the information in fact is confidential. This has to be balanced against the right of the parties to a swift procedure as justice delayed is justice denied.

Taking into consideration on the instant facts that the counterarguments submitted by the defendants against the alleged infringement of the patent rights of claimant are largely built on the prior use right defence, it is of imminent importance to further the written stage of the proceedings which is still ongoing. Pending a final decision of the court upon the protection of the information submitted by the defendants and the confidentiality ring to be implemented for the sake of the proceedings, the claimant is not able to sufficiently reply to the defendants' arguments.

Whereas initially the allegations of the defendants lacked a sufficient degree of substantiation, the defendants then explained in adequate detail why the highlighted in-formation contained in its brief, which has been put forward to underpin its arguments, relate to

merely internal circumstances, which had not been shared with the public or competitors in the respective industry sector alike. Therefore the grounds relied upon by the defendants calling for protection of their information significantly outweigh the interest for the claimant to have full and unlimited access to the information and evidence in question.

6.

In a further step, the court has to strike a balance between the adequate level of protection of said confidential information and the right of the claimant to have sufficient access to the information in order to exercise its right to be heard.

In this context, [R. 262A.6 RoP](#) establishes with all desirable clarity as a ground rule of paramount importance that at least one natural person from each party and the respective lawyers or other representatives are to be granted access in order to ensure a fair trial. The provision therefore reflects the spirit of the trade secret directive, which also demands for access of at least one natural person from each of the parties and their respective representatives in order to guarantee the fundamental right to a fair trial (see recital 25 and [Art. 9 \(2\)](#) of the trade secrets directive). This has been an express decision by the Member States of the European Union which is to be respected by the UPC ([Art. 20, 24\(1\)\(a\) UPCA](#)). Whereas the proposal for the directive (COM (2013) 813 final) foresaw in its Art. 8(2) an in-camera procedure, this element has been erased due to fundamental concerns raised by the majority of EU Member States that such a procedure impairs the party's right to be heard. Before this background, the arguments of the defendants referring to a deviating national practice in the Netherlands allowing for attorneys' eyes-only confidentiality clubs on the basis of the Dutch Code of Civil Procedure are bound to fail as this procedural law is inapplicable here and counter to the sources of law to be respected by the UPC as construed by the panel.

7.

When deciding upon the level of restriction, again the circumstances of the case are to be taken into consideration. Whereas in some cases a restriction may be more important to safeguard the confidential information concerned, in other cases the right to full access to the files of a party trumps the interest of protection. Therefore the argument of the defendants that access should be restricted to three natural persons, which it presents as a common ground argument, is undifferentiated. The information for which the defendants seek protection concern a prior use right, which defendants allege to have acquired in 2017. In consequence, the facts submitted in this context – except for information in the context of enforcement security – relate to seven year old business practice. Hence, here the case as presented calls for a considerable amount of reasoning on the side of the defendants, why such information – which claimant describes as “historic” – still needs protection and why it – if disclosed to the claimant – would put claimant at an unfair and unjustified advantage as a competitor and would endanger the actual business of the defendants, if known

by its competitor to date. Even more, the defendants do not even market the respective product anymore. In such a setting it appears to be a disproportionate burden upon the claimant to reduce the number of persons being able to assist the representatives in arguing the case before the court too strictly. Moreover, it has to be taken into consideration that only some parts of the confidential information are of importance to certain groups of persons the claimant request to be granted access. Whereas business figures will be more valuable information for claimant's employees in its business department, technical details of defendants' products and production development cycles appear to be of less interest and vice versa with regard to its employees working in its R & D department.

Before this background the defendants cannot be heard to limit the number of natural persons to three out of the five named persons they do not oppose to. The claimant, also having regard to the complexity of the dispute, has a legitimate interest to grant access to all five persons, i.e. the respective group leaders and their supporting assistants.

8.

Furthermore, defendants cannot be heard with their request, that employees from claimant's R & D department must not be granted access. Claimant sets out in detail with persuasive arguments why it is necessary to exchange with these employees exactly, who are in a position to comment on defendants' allegations before the background of the technical expertise in and knowledge of the industry sector. In a dispute revolving around technical aspects it is of fundamental importance that a party may have resort to technically qualified employees in order to exercise its right to be heard. Only in rare circumstances where e.g. cutting-edge technical improvements are at stake, which put the proprietor in a significant pole position on the market, further restrictions may be considered to be proportionate. This is not the case here.

9.

Furthermore, the requests of the defendants to set out in further detail, in which way the claimant has to organize itself in order to prevent the breach of the court's protective order have to be rejected. The information is sufficiently protected by the order of the court without such detailed measures to be ordered. A breach of the order will result in severe penalty payments. This fact alone will cause claimant to implement appropriate internal measures of protection. The more detailed instructions in the Düsseldorf Local Division's [order of 11 March 2024 \(UPC CFI 563/2024, App 8500/2024\)](#) are case-specific and cannot be generalised. Moreover claimant is better equipped to decide upon such measures than the court or the defendants, which both have insufficient knowledge of the internal organisation and security policy of the claimant which may already be in place and may be used to this avail.

The same applies to the request to order that any hard copy or electronic copy of the information under Item 1. and summaries or notes relating to information under

Item 1. shall be destroyed, deleted, or returned to the defendants by the claimant after the final termination of the proceedings as the information may e.g. be needed in the course of seeking enforcement of the orders and decisions of the court so that the claimant still has a legitimate interest to be in possession and make of use of the information.

10.

Finally, the panel – in accordance with the view expressed by the judge-rapporteur in his preliminary order dated 7 February 2024 – rejects the requests of the defendants to impose upon the named employees to refrain from getting involved in research and development, pricing or any other competitive decision making, and shall not be involved in prosecution of patent applications for a period of 5 years after the end of the present proceedings (including potential appeal proceedings) as manifestly disproportionate on the instant facts.

III.

As the court's orders may provide for periodic penalty payments payable to the court in the event that a party fails to comply with the terms of the order ([R. 354.3 RoP](#)), the panel finds it appropriate to include an explicit reference to such power of the court in its order.

IV.

Since the questions decided upon in the case at hand are far from being well settled in the newly established Unified Patent Court, **leave to appeal is granted.**

So as not to create a *fait accompli*, the panel decides not to grant access for the further six natural persons named by the claimant, which are in dispute, before the time period for bringing an appeal and an appropriate time period to bring an application for suspensive effect before the Court of Appeal before it has elapsed. The court has seen that claimant objects to such an element of the order but finds that – at least as long as the applicable standards within the Rules of Procedure of the UPC are not sufficiently settled – such order is inevitable to safeguard defendants' interests to protect its confidential information. On the contrary it appears to be in the interest to further the proceedings to already grant three out of the five natural persons named by claimant and against which the defendants do not raise concerns immediate access to the information concerned in order to them being enabled to assist claimant's representatives in preparing its reply.

ORDER:

1. Access to the unredacted version of the Statement of defence dated 6 February 2024, containing confidential information as highlighted in grey therein, and to the unredacted version of Exhibits FBD-T 9 to 15a and to the unredacted version of Exhibit FBDT 27, which is hereby classified as confidential, shall be restricted exclusively to

- the claimant's authorised representatives and their assistants;
- any private expert upon request;
- with **immediate effect** to the following employees of the claimant:

- Ms. ... , Intellectual Property Legal Division

- Mr. ... , Manager, Intellectual Property Technology Division

- Mr. ... , Intellectual Property Technology Division.

d) Access is only granted to the following further six employees of the claimant after the period of 15 days for bringing an appeal under R. 220.2 RoP and an additional week, after having brought the appeal, during which an application for suspensive effect may be lodged, has elapsed – unless it is otherwise communicated by the parties to be appropriate at an earlier point of time:

- Mr. ... , Intellectual Property Legal Division
- Mr. ... , Senior Manager, Intellectual Property Technology Division
- Mr. ... , Manager, Graphic Communication Laboratory
- Mr. ... , Manager, Synthetic Organic Chemistry Laboratory
- Mr. ... , Senior Manager, GC Business
- Mr. ... , Senior Manager, GC Business.

2. The information referred to in paragraph 1 shall be treated as confidential by the claimant's representatives and their assistants, any private experts and the employees referred to in paragraph 1. Such information shall not be used or disclosed outside of these court proceedings, except to the extent that it has come to the knowledge of the receiving party outside of these proceedings, provided that the receiving party has obtained it on a non-confidential basis from a source other than the defendant or its affiliates, provided that such source is not bound by a confidentiality agreement with or other obligation of secrecy with the defendant or its affiliates.

This obligation shall also apply to the claimant.

The foregoing persons shall also be under an obligation to the claimant to maintain the confidentiality of the information contained in the unredacted versions of the foregoing documents.

This obligation of confidentiality shall continue to apply after the termination of these proceedings.

3. In the event of a culpable breach of this order, the court may impose a penalty payment for each violation which will be determined having regard to the circumstances of the individual breach.

4. All further requests of the parties are hereby rejected.

5. Leave to appeal is hereby granted.

DETAILS OF THE ORDER:

App_6761/2024 related to the main proceeding ACT_578607/2023

UPC-Number: UPC_CFI_355/2023

Subject of the Proceedings: Patent infringement action

Issued in Düsseldorf on 27 March 2024

NAMES AND SIGNATURES

Presiding Judge Thomas

Legally qualified Judge Dr. Thom

Legally qualified Judge Lopes

Information about appeal:

The present order may either – be the subject of an appeal by any party which has been unsuccessful, in whole or in part, in its submissions together with the appeal against the final decision of the Court of First Instance in the main proceedings, or – be appealed by

any party which has been unsuccessful, in whole or in part, in its submissions at the Court of Appeal with the leave of the Court of First Instance within 15 days of service of the Court of First Instance's decision to that effect (Art. 73(2)(b) UPCA, R. 220.2, 224.1(b) RoP).
