



Local division Mannheim

UPC_CFI_210/2023
Order
of the Court of First Instance of the Unified Patent Court
issued on 14 February 2024

**here: Application for production of documents and protection of confidential information
acc. to R. 190/191, 262, 262A RoP**

Patent at issue

<i>Patent No.</i>	Proprietor
EP 2568724	Panasonic Holdings Corporation

The following

Confidentiality Regime

is hereby established.

In doing so, the court has taken into consideration that there is typically a recognisable need for confidentiality of business-related information contained in licence agreements. The procedure described in the steps below enables the parties to obtain comprehensive protection of trade secrets and allows the parties to submit the documents in the protected proceedings even without the need of a court order to produce them. If, according to the parties' consensus, the clauses usually contained in licence agreements do not permit production until a court order is issued, this has to be understood before the background that such orders aim at involving the respective licence agreement partner into the proceedings and its confidentiality regime prior to any production in the court proceedings. This interest is fully taken into account by the confidentiality regime which is hereby established, so that a court order to produce the respective documents does not appear appropriate for the time being. Rather, the agreement of the respective licence agreement partner must be obtained on this basis if necessary or, in the event of a refusal, a separate decision on the production must be made by the party concerned. The interests of the licence agreement partner of the party wishing to submit a licence agreement in the proceedings must therefore be safeguarded by the respective party. In this context, it has to be taken into consideration that the documents in question are those that the party wishes to submit and that

it is able to contact the third party concerned directly and efficiently. The court would first have to involve the third party, who is generally not represented by a representative in the proceedings, in the proceedings via the often time-consuming route of serving court documents abroad in accordance with the Hague Service Convention or the EU Regulation on Service of Documents. It also appears appropriate to arrange for the third party's statement to be provided via the party, because the party itself has contributed to making it more difficult to produce documents in court proceedings by concluding corresponding contractual clauses.

The confidentiality regime is organised as follows:

1. The party's representative uploads the document containing confidential information at the time of submission **without any redactions**. Since this document is the basis for the court's decision on the application for protection of confidential information, the document must be submitted without any redaction (see in the affirmative also Düsseldorf Local Division of 14 February 2024 Order No. 8075/2024, App_7937/2024 regarding ACT_590953/2023 = UPC_CFI_463/2023). **The document is initially not visible to the opposing party and their representatives. Only the court can see the document.**
2. When uploading the document, the representative has the option of indicating in the Case Management System (CMS) that the document contains confidential information.
3. To this end, the representative is requested by the CMS to upload a redacted version of the document.
4. The representative then starts the workflow in the CMS provided for the application in accordance with Rule 262 and Rule 262A of the Rules of Procedure and uploads his application according to Rule 262 of the Rules of Procedure or Rule 262A of the Rules of Procedure. In this workflow, which is a "related proceeding" to the main proceeding, the representative is asked to select and confirm the documents to be kept confidential again. In this workflow, however, the document to be kept confidential is not uploaded again - it is only contained in the workflow of the main proceeding. In the 262/262A workflow, only the application is submitted.
5. The request under point 4. regarding Rule 262A of the Rules of Procedure may - if there is a need for this - be subject to a **procedural condition** to the effect that the document which is the subject of the application **is only deemed to be filed** and may only be used in the proceedings by the opponent and by the court, if the court **fully grants** the preliminary order securing the initial step of the opponent being invited to comment as well as the final order covering the protection of confidential information, which is being issued after hearing the opponent.
6. If the court intends not to allow the application or to allow it only in part, the court shall hear the applicant **in advance** and request him to make his final decision as to whether the document should be deemed to have been filed and can henceforth be taken into account by the opponent and the court. If the applicant decides to have the document treated as not submitted, its content will neither be taken into account by the court in reaching a decision, nor may it be used by the opponent in the proceedings - and of course not outside of them either.

7. In response to the application under point 4, the court shall, as a first step, issue a **preliminary order protecting the information**, which, on the basis of the applicant's unilateral submission that the document contains information, temporarily places it under comprehensive protection **before** the document is made accessible to the opposing party's representative - and initially exclusively to him. If, as in the present case, it concerns the submission of licence agreements relating to SEP patents, a corresponding preliminary interest to protect that information will generally be accepted. If, in individual cases, the court has doubts as to whether the information which, according to the applicant's submission, is supposed to be confidential, is actually confidential information, it will point this out to the applicant and give him the opportunity to comment, if it does not intend to issue a preliminary protective order. If the applicant then decides not to unconditionally submit the document, it will not be taken into consideration by the court and will not be made available to the opponent in its unredacted version.
8. If the filing of the document to be submitted is made conditional pursuant to paragraph 5, the opposing counsel shall initially be authorised to use the document solely for the purposes of his comments on the application pursuant to Rule 262A of the Rules of Procedure.
9. After the preliminary order fully protecting the document has been issued, or at the same time as it is issued, the court shall order the Registry to make the relevant confidential documents available to the opposing party's representative in their unredacted version via the CMS. The registry releases the documents manually via the available back office function. **Only now does the opposing lawyer - and initially only the opposing lawyer - have access to the so-called "unredacted version" for the first time.**
10. If the opposing representative indicates that he is only able to comment on the confidential nature of the information contained in the document once he has consulted with a natural person from his party, he must name this person or persons. The applicant will then be given another opportunity to comment on this, in particular on the suitability of the persons named. Depending on the circumstances of the case, the circle of persons who has access to the document is then extended accordingly by means of an adapted preliminary order. These persons will also be authorised to use the information initially solely for the purpose of commenting on the application pursuant to Rule 262A of the Rules of Procedure.
11. Upon receipt of the opposing party's comments, the court may grant further opportunity to comment or rule on the merits of the motion if it deems it allowable.
12. If the court considers the application to be only partially allowable or not allowable, it will inform the applicant of its intention before making its decision and give the applicant the opportunity to comment, if the application was subject to the condition set out in No 5 supra.

If the applicant decides not to submit the document, the court may not take it into account when making its decision. The opposing party may not use the document either in the proceedings or outside the proceedings. However, since the document was the subject of the proceedings, at least with regard to the application under Rule 262A of the Rules of Procedure, it shall remain in the file having regard to a possible appeal.
13. In the event of a request for access to the file by a third party not involved in the proceedings pursuant to Rule 262.3 of the Rules of Procedure, the document is protected from access by

the parallel request pursuant to Rule 262.2 of the Rules of Procedure and is not part of the access to the file by third parties.

Against the background of this regime, a decision on the applications pursuant to Rule 190 of the Rules of Procedure is not intended for the time being. It had to be taken into account here that at the current early stage of the proceedings, before receipt of the reply and reaction to the counterclaim for revocation, it cannot be validly assessed whether the submission of documents relating solely to the FRAND aspect will become relevant. The parties have the opportunity to submit the documents they deem relevant and to clarify and take into account any affected third-party interests themselves. Any documents to be produced can be submitted by means of a generic procedural application under Rule 9 Rules of Procedure in conjunction with a corresponding application under Rules 262/262A of the Rules of Procedure (here too, only the redacted version is initially visible to the opponent) or with the main pleadings that are still outstanding.

Issued on 14 February 2024

Dr. Tochtermann
Presiding judge and judge rapporteur