



Procedural Order
of the Court of First Instance of the Unified Patent Court
Düsseldorf Local Division
issued on 8 August 2024
concerning EP 2 697 391 B1

HEADNOTES:

1. In general, there is no reason to limit the authorised representatives of a party to a certain number or even to UPC representatives and their internal assistants, who must also be named (connection to UPC_CFI_471/2023 (LD Mannheim), Order of 3 July 2024, ORD_33986/2024 Aylo Freesites v. DISH). However, it must be clear who is obliged to maintain confidentiality and who can be held responsible and legally liable in the event of a breach of the confidentiality order.
2. In principle, it is the responsibility of each party to identify the natural persons to be granted access to the confidential information. Once a party has done so and has identified the natural persons to whom it wishes to grant access to the confidential information, it is for the other party to state the reasons why, in its opinion, such access should not be granted in the particular case.

KEYWORDS:

Confidentiality order; confidentiality club; summary proceedings; proceedings on the merits; access of representatives

Claimant:

10x Genomics, Inc., 6230 Stoneridge Mall Road, 94588-3260 Pleasanton, CA, USA, legally represented by the Board of Directors, this represented by the CEO Serge Saxonov, *ibid*,

represented by: Attorney-at-law Prof. Dr. Tilman Müller-Stoy, Attorney-at-law Dr. Martin Drews, Patent attorney Dr. Axel Berger, Prinzregentenplatz 7, 81675 Munich, Germany

electronic address for service: mueller-stoy@bardehle.de

DEFENDANT:

Curio Bioscience Inc., 4030 Fabian Way, Palo Alto, CA 94303, USA, represented by its CEO Stephen Fodor, *ibid*,

represented by: Attorney-at-law Agathe Michel-de Cazotte, European Patent attorney Cameron Marschall, 1 Southampton Row WC1B 5HA London, United Kingdom,

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PATENT AT ISSUE:

European patent n° EP 2 697 391 B1

PANEL/DIVISION:

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This order was issued by Presiding Judge Thomas acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: R. 262A RoP – Protection of confidential information

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

The parties have already faced each other in summary proceedings (ACT_590953/2023, UPC_CFI_463/2023), in which the Court has issued orders to protect the Defendant's confidential information (see Order of 11 March 2024, ORD_8559/2024; Order of 22 March 2024, ORD_14983/2024).

In the main proceedings, the Defendant has now filed a statement of defence and also seeks the protection of information that it considers to be confidential.

According to the Defendant, the Court of Appeal has held that a Rule 262A RoP order continues to apply after the proceedings unless the order states otherwise. Therefore, there was no need for a

new order in the appeal proceedings if the information was already protected by a Rule 262A RoP order. The Defendant submits that the same reasoning applies to the infringement action. In the alternative, should the Court consider that a new Rule 262A RoP order is necessary, the Defendant seeks a confidentiality order restricting the unredacted versions of the confidential statement of defence and the confidential exhibits CR-1 and CR-2 to the same conditions as in the Order of the Düsseldorf Local Division of 11 March 2024.

The Claimant argued that the UPC legal framework does not require that the access of the Claimant's legal representatives and their internal assistants to be limited to a certain number or even a certain number of named persons. Furthermore, the Claimant considers that the number of authorised employees should be increased to three natural persons.

The Claimant seeks:

- I. Access to the unredacted version of the unredacted Statement of Defense and the unredacted versions of Exhibits CR-1 and CR-2 is to be extended on part of the Claimant to the following persons:
 - (1) the Claimant's legal representatives, insofar as they are authorized UPC representatives, and their internal support staff, whereby only those UPC representatives and their support staff of the law firm of the Claimant's legal representatives shall have access to the confidential information, if they are actively working on this proceeding;
 - (2) the following natural persons of the Claimant:

[...]

Alternatively:

- II. To the discretion of the court, the circle of person already granted access to the unredacted Statement of Defense and the unredacted Exhibits CR-1 and CR-2 pursuant to the procedural order of March 18, 2024 is additionally extended to:
 - Dr. Kerstin Galler, attorney-at-law and UPC representative
 - Dr. Axel Berger, German and European patent attorney and UPC representative
 - Dr. Markus Ackermann, German and European patent attorney and UPC representative
 - Antje Weise, attorney-at-law and UPC representative
 - [...]

The Court gave the Defendant the opportunity to respond to the Claimant's submissions. The Defendant did not make use of the opportunity to do so.

GROUNDS OF THE ORDER:

1.

Art. 9(1) and (2)(a) of Directive (EU) 2016/943 provides that, in judicial proceedings, access to documents submitted by the parties or third parties containing trade secrets or alleged trade secrets may, upon request, be restricted in whole or in part to a limited number of persons. The protection of confidential information is provided for in Art. 58 UPCA and implemented in R. 262A RoP (see UPC_CFI_54/2023 (LD Hamburg), Order of 3 November 2023, ORD_577703/2023 - Avago Technologies International v. Tesla Germany; UPC_CFI_463/2023 (LD Düsseldorf), Order of 11 March 2024, ORD_8550/2024 - 10x Genomics v. Curio Bioscience).

2.

The formal requirements of R. 262A.2 and .3 RoP were complied with. The Claimant's representatives were also heard before the confidentiality order was issued, as required by R. 262A.4 RoP. It made use of the opportunity to submit observations.

3.

The confidentiality orders issued in the previous summary proceedings do not preclude an order under R. 262A RoP in the main proceedings.

The Defendant rightly points out that the orders already made in the summary proceedings continue to have effect even after the conclusion of those proceedings. It is also reasonable to assume, in favour of the Defendant, that the orders relate to the same information which the Defendant now claims is confidential.

In order to take account of the particularities of summary proceedings, the group of persons granted access must be selected in such a way that the party affected by the preliminary order for the protection of confidential information is fully able to work and is in a position to comment on the merits of each point raised by the opposing party, taking into account the confidentiality interests of the opposing party (UPC_CFI_463/2023 (LD Düsseldorf), Order of 23 February 2024, ORD_9718/2024 - 10x Genomics v. Curio Bioscience). In other words, in summary proceedings, it may be necessary to widen the circle of persons who have access to confidential information from the outset and even before the confidentiality order is issued. In the further course of the proceedings, the Court must strike a balance in summary proceedings between the Applicant's interest in expediting the proceedings, the right to be heard and the confidentiality interest of the party applying for the order.

Depending on the circumstances of the case and taking into account the requests of the parties and their submissions, this may lead to a different confidentiality order from that which would have to be made in the main proceedings. Against this background, the parties are free to request a different confidentiality order in the main proceedings than in the previous summary proceedings.

4.

The Claimant has not disputed in detail that the information classified as confidential by the Defendant are trade secrets or at least confidential information. It must therefore be assumed that the information in question is worthy of protection.

5.

Regarding the group of authorised persons is concerned, the Mannheim Local Division rightly

pointed out that there is normally no reason to limit the access of Claimant's representatives to a certain number or even to UPC representatives and their internal assistants, who must also be named (UPC_CFI_471/2023 (LD Mannheim), Order of 3 July 2024, ORD_33986/2024 Aylo Freesites v. DISH). Where the Düsseldorf Local Division has ordered such a restriction in the past, this was due to the specific situation in the summary proceedings (UPC_CFI_463/2023 (LD Düsseldorf), Order of 11 March 2024, ORD_8550/2024 - 10x Genomics v. Curio Bioscience).

However, it cannot be ignored that R. 262A.6 RoP requires that the number of persons having access to the confidential information shall not be greater than is necessary to ensure that the rights of the parties to the proceedings to an effective remedy and to a fair trial are respected. This requirement also applies to the parties' representatives. Therefore, the number of representatives granted access to the confidential information should not be "unlimited" or "indeterminable". Nor should the latter be the case, as effective protection of confidential information also requires clear accountability. It must be clear who is obliged to maintain confidentiality and who can be held responsible and legally liable in the event of a breach of the confidentiality order.

Against this background, the Court has granted access to the representatives named as the Claimant's representatives in the statement of claim. In order not to restrict the Claimant's right to choose its legal representatives, the Court has granted these representatives the right to share the relevant information with their team working on the case. If the Claimant's representatives who have access to the confidential information make use of this possibility to share this information with other members of their team, it is their responsibility to ensure that their team maintains the confidentiality of the information. In the event of a culpable breach of the confidentiality obligations, the representatives who have been granted access to the information would therefore be liable. This also applies to a breach of confidentiality by their team members to whom they have granted access.

6.

The Defendant did not object to the Claimants' request to extend the group of natural persons entitled to access to three persons. The present order takes account of this. Moreover, the Defendant has not put forward any reasons that would justify limiting access to only one natural person. In principle, it is for the party concerned to identify the persons to whom access is to be granted. Once it has done so and identified the natural persons to whom it wishes to grant access to the confidential information, it is for the other party to state the reasons why, in its view, such access should not be granted in the particular case (UPC_CFI_463/2023 (LD Düsseldorf), Order of 11 March 2024, ORD_8550/2024 - 10x Genomics v. Curio Bioscience). However, the Defendants have not submitted any such grounds.

ORDER:

- I. Access to the unredacted version of the statement of defence (dated 15 July 2024), the updated statement of defence (dated 17 July 2024) and the unredacted version of exhibits CR-1 and CR-2, which are hereby classified as confidential, shall be restricted, on part of the Claimant to the following persons only:
 1. the following representatives of the Claimant:
 - Attorney-at-law and UPC representative **Prof Dr Tilman Müller-Stoy**
 - German and European Patent attorney and UPC representative **Dr Axel Berger**

and their teams, actively involved in these proceedings, including other attorneys-at-law, patent attorneys and support staff;

2. the following employees of the Claimant:

[...]

- II. The information referred to in paragraph I. above shall be treated as confidential by the Claimant's representatives, their assistants and the employees referred to in paragraph I. 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 Claimant or its affiliates, provided that such source is not bound by a confidentiality agreement with or other obligation of secrecy with the Claimant 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.

- III. 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.
- IV. If the Claimant's representatives named in paragraph I. above make use of the possibility of giving access to confidential information to other members of their team, it is their responsibility to ensure that their team maintains the confidentiality of the information. In the event of a culpable breach of the confidentiality obligations, Prof Dr Tilman Müller-Stoy and Dr Axel Berger would therefore be liable. This also applies to any breach of the duty of confidentiality by any member of their team to whom they have granted access.

DETAILS OF THE ORDER:

App_41690/2024 under main file reference ACT_15774/2024

UPC-number: UPC_CFI_140/2024

Type of procedure: Infringement action and Counterclaim for revocation

Issued in Düsseldorf on 8 August 2024

NAMES AND SIGNATURES

Presiding Judge Thomas