



Düsseldorf Local Division
UPC_CFI_336/2024
UPC_CFI_605/2024

Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 23 December 2024
concerning EP 3 065 184 B1

Claimant:

Maxeon Solar Pte. Ltd., represented by its CEO, 8 Marina Boulevard #05-02, Marina Bay Financial Centre, 018981 Singapur,

Represented by: Attorney-at-law Christian Harmsen, Attorney-at-law Dr Bastian Selck, Bird & Bird LLP, Carl-Theodor-Straße 6, 40213 Düsseldorf,

Electronic address for service: [...]

Contributing: Patent Attorney Dr Felix Harbsmeier, Patent Attorney Cameron Walker, Bird & Bird LLP, Am Sandtorkai 50, 20457 Hamburg,
Tjibbe Douma und Carlos van Staveren, Bird & Bird (Netherlands) LLP, Gustav Mahlerlaan 42, 1082 MC Amsterdam, Niederlande,

Defendants:

1. **Aiko Energy Germany GmbH**, represented by ist CEOs Dr Christian Frank Peter und Haojie Lu, Niederkasseler Lohweg 18, 40547 Düsseldorf, Germany,
2. **Solarlab Aiko Europe GmbH**, Dr Christian Frank Peter, Berliner Allee 29, 79110 Freiburg im Breisgau, Germany,
3. **Memodo GmbH**, represented by its CEOs Enrico Brandmeier, Daniel Schmitt und Tobias Wenleder, Eichenstraße 11 a-d, 85445 Oberding, Germany,
4. **Aiko Energy Netherlands B.V.**, represented by its CEO, Schiphol Boulevard 201 – 1118 BG - Schipol, the Netherlands,
5. **Libra Energy B.V.**, represented by ist CEO Bram van Duijn, Eendrachtsstraat 199, 1951 AX Velsen-Noord, the Netherlands,
6. **VDH Solar Groothandel B.V.**, represented by its CEO, Finlandlaan 1, 2391 PV, Hazerswoudedorp, the Netherlands,
7. **PowerDeal SRL**, represented by its CEO, Rue du Fond des Fourches 41, 4041 Herstal, Belgium,

8. Coenergia Srl a Socio Unico, represented by its CEO, Foro Buonaparte 55, 20121 Milan, Italy,

Defendants 1., 2. and 4. represented by:

Attorney-at-law Gertjan Kuipers, Attorney-at-law Hendrik Jan Ridderinkhof and other Representatives before the UPC of Hogan Lovells International LLP, Strawinskylaan 4129, 1077 ZX Amsterdam, the Netherlands,

Electronic address for service:

[...]

Contributing:

Attorney-at-law Dr Henrik Lehment, Attorney-at-law Vanessa Zipperich and other Representatives before the UPC of Hogan Lovells LLP, Dreischeibenhaus 1, 40211 Düsseldorf, Germany,

Patent Attorney Dr Andreas Schmid, Patent Attorney Cedrik Rohr and other Representatives before the UPC of Hogan Lovells International LLP, Karl-Scharnagl-Ring 5, 80539 Munich, Germany,

Defendants 3. and 5. to 8. Represented by:

Attorney-at-law Dr Constantin Kurtz, Attorney-at-law Dr Stefan Eck, Attorney-at-law Maximilian Reif, Klaka Rechtsanwälte Partnerschaft mbB, Delpstraße 4, 81679 Munich, Germany,

Electronic address for service:

[...]

Contributing:

Patent Attorney Dr Markus Herzog, Patent Attorney Manuel Millahn, Weickmann & Weickmann Patent- und Rechtsanwälte PartmbB, Richard-Strauss-Straße 80, 81679 Munich, Germany,

PATENT IN SUIT:

EUROPEAN PATENT NO. 3 065 184 B1

PANEL/DIVISION:

Panel of the Düsseldorf Local Division

DECIDING JUDGES:

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

LANGUAGE OF THE PROCEEDINGS: English

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

GROUNDS FOR 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; UPC_CFI_347/2024 (LD Düsseldorf), Order of 21 August 2024, ORD_46902/2024, Valeo Electrification v. Magna).

2.

The formal requirements of R. 262A.2 and .3 RoP were complied with. The Claimant's and Defendants' 3., 5. to 8. 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 Claimant has not substantially disputed that the information contained in the passages marked in green in the Statement of Defence and the Counterclaim for Revocation and Exhibit HL 35 constitutes trade secrets.

According to Defendant's 1., 2. and 4., this information relates to the revenue, profit and sales figures and allows conclusions to be drawn about the profitability of the challenged embodiments and the market position of Defendants 1., 2. and 4. As these Defendants further pointed out, since the Claimant is a competitor of the Defendants' group of companies, there is also a risk that the Claimant's unlimited access to this information could influence the pricing of the Claimant's products or the products of its affiliates and/or the strategy for the distribution of the products in the Member States concerned by the action, to the disadvantage of the Defendants and their group of companies. Therefore, Defendants 1., 2. and 4. are of the opinion that the interest of the Defendants and their group of companies in confidentiality and restricted access also applies to the methods of calculating the enforcement securities, as the calculation methods could lead to conclusions on competitively relevant confidential information on turnover, profit and sales figures. Therefore, in the opinion of Defendants 1., 2. and 4., there is an interest in protecting this information, not only with respect to the Claimant, but also with respect to Co-Defendants 3., 5. to 8.

The latter have not disputed that Defendants 1., 2. and 4. have a corresponding interest in maintaining confidentiality. Nor does the Claimant's submission cast doubt on the sufficiently justified interest of Defendants 1., 2. and 4. in maintaining confidentiality.

To the extent that the Claimant refers to the possible need to redact the enforcement security in the judgement due to a security order, there is no such automatic mechanism. It is completely unclear at this stage whether the Court will accept the Defendant's argument as to the need for such a security and, if so, in what amount. It is also not clear that any security that may be set will allow any conclusions to be drawn about the information used by the Defendants in calculating the security they consider necessary.

4.

Insofar as Defendants 1., 2. and 4. also claim confidentiality with respect to some of the technical submissions highlighted in grey in the Statement of Defence and the Counterclaim for Revocation and contained in Exhibit HL 16, it is undisputed that the relevant information has already been submitted in the parallel proceedings before the District Court of Mannheim without any measures to protect the confidentiality having been taken (or even applied for) there.

Even if the case file is only accessible to third parties under certain conditions, the information in question is at least already known to the Claimant. It is no longer constitutes a secret for the Claimant. The same applies to Defendant 5., who, together with Defendants 1. and 2., submitted the information to the Mannheim District Court.

However, the information in question could not only be discussed in the public oral hearing at the Mannheim District Court. It could also appear unprotected in the judgement and thus be accessible to third parties. Why, in view of this, a corresponding confidentiality order is now necessary before the UPC is not clear and has not been explained in detail by Defendants 1., 2. and 4. The conditions for a confidentiality order are therefore not met in relation to this information.

5.

The question of who is entitled to access cannot yet be definitely answered with regard to the Claimant. As regards Defendants 3., 5. to 8., a final order could already be made as to the group of authorised recipients.

a)

Pursuant to R. 262A.6 RoP, the group of authorised parties must include at least one natural person of the party concerned. This applies in any event unless, as here, the parties have not agreed otherwise.

In the first instance, only the party whose access is to be restricted can assess how many people need access in order to exercise its rights effectively. Similarly, only the party concerned is in a position to identify the individuals concerned and has insight into the necessary internal processes. Once the party has exercised its right of proposal on this basis, it is up to the party claiming confidentiality to raise specific objections in a second step. It is not sufficient for the party to object to the proposal in general terms. If the party in question objects to the proposed number of natural persons, it is rather up to that party to explain why the protection of the information for which confidentiality is requested would be jeopardised by the proposed person in particular, despite the confidentiality obligations that also exist vis-à-vis the authorised users. On the other hand, if that party objects to the number of persons proposed, it is up to that party to explain in concrete terms why its rights would be compromised by the proposed number of natural persons.

However, in order for the party seeking the protection of confidential information to be able to raise such objections, it must be provided by the party subject to the confidentiality order with a minimum amount of information about the persons concerned. This includes, in any case, information as to whether the person concerned is an employee of the party itself or a third party, and the function of the person concerned.

The Claimant has not yet made such a submission. It only provided for three names without any explanation. The decision as to which natural persons on the Claimant's side should be granted access to the relevant information is therefore postponed.

The Claimant is given the opportunity to supplement its submissions in this regard.

b)

Defendants 3., 5. to 8. do not request access for natural persons, with the exception of Defendant 7. This access must be granted, as can be seen from the operative part of this order.

Insofar as the Defendants 1., 2. and 4. do not wish to grant access to even one natural person of Defendant 7., such a restriction would be in clear contradiction to R. 262A.6 RoP. According to this rule, *“the number of persons shall not be greater than necessary [...] and shall include at least one natural person.”* In any case, unless the party concerned voluntarily waives this right of access, he or she has a right of access for a natural person. This is the only way to ensure that the party concerned is fully informed about the progress of the proceedings and, on that basis, can adequately exercise its rights in the proceedings. This applies irrespective of the extent to which the party in question affects the party concerned. The protection of classified information is ensured by the fact that authorised parties are also subject to a confidentiality order with penalties for non-compliance (UPC_CFI_355/2023 (LD Düsseldorf), Order of 27 March 2024, ORD_7096/2024, Fuji-film v. Kodak).

To the extent that the Defendant 7. requests access for another lawyer, there is no need to grant such access. Either the lawyer for whom access is requested is actively involved in the case. In this event, it is already the responsibility of the Defendant’s 7. representatives to grant access as part of their team, with the consequence that they are also responsible for ensuring that these other lawyers keep the information confidential. Or that other lawyer is not actively involved in the case. In this situation, there is no need to grant access to the confidential information. Rather, the Defendant’s 7. interest in confidentiality will prevail (UPC_CFI_347/2024 (LD Düsseldorf), Order of 9 September 2024, ORD_49462/2024 – Valeo v. Magna).

6.

The Court has refrained from setting an upper limit on the potential penalties to be imposed. This gives the Court the necessary flexibility to take account of the circumstances of each individual breach of the confidentiality order and to determine the penalty payments on that basis (UPC_CFI_347/2024 (LD Düsseldorf), Order of 9 September 2024, ORD_49462/2024 – Valeo v. Magna).

ORDER:

- I. The following information is classified as confidential within the meaning of Art. 58 UPCA, R. 262.2 RoP:
 1. The green-shaded statements/numbers included in the Statement of Defence and Counterclaim for Revocation submitted by Defendants 1., 2. and 4. and dated 21 October 2024 relating to revenue, profit and sales figures of Defendant 1. and Defendant 4. including the green-shaded details on the calculation methods for the enforcement securities;
 2. Exhibit HL35 which concerns details related to the revenue, profit and sales figures of Defendant 1. and Defendant 4.
- II. Access to the unredacted version of the Statement of Defence and the Counterclaim for revocation submitted by Defendants 1., 2. and 4. and dated 21 October 2024 including Exhibit HL 35 shall be restricted,
 1. on the part of the Claimant:

to the following representatives of the Claimant:

- Attorney-at-law Christian **Harmsen**
- Attorney-at-law **Dr Bastian Selck**

and members of their internal team actively involved in these proceedings, including support staff,

whereas the decision on the number and names of the natural persons authorised to access the information is postponed pending the Claimant's additional submissions;

2. on the part of the Defendants 3. and 5. to 8.:

a) to the following representative of Defendants 3. and 5. to 8.:

- Attorney-at-law **Dr Constantin Kurtz**

and members of his internal team actively involved in these proceedings, including support staff;

b) and the following natural persons of Defendant 7:

- Mr. [...].

- III. Information classified as confidential in paragraph I. shall be treated as such by the Claimant's and Defendant's 3. and 5. to 8. representatives and their teams and by the natural reliable persons that have been granted access until further notice and 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 Defendants or their affiliates, provided that such source is not bound by a confidentiality agreement with or other obligation of secrecy with the Defendants 1., 2. and 4. or their affiliates.
- IV. In the event of a culpable breach of this Order, the Court may impose a penalty payment for each breach, to be determined having regard to the circumstances of each case.
- V. If the Claimant's or Defendant's 3. and 5. to 8. representatives named in paragraph II. 1. 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, Christian Harmsen, Dr Bastian Selck and Dr Constantin Kurtz 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.
- VI. The Claimant is given the opportunity to supplement its submissions with respect to the natural persons for whom access is requested **by 10 January 2025.**

- VII. Defendant's 1., 2. and 4. request for protection of confidential information concerning the grey-shaded statements included in the Statement of Claim and the Counterclaim for Revocation and Exhibit HL 16 is rejected.

To the extent that the Preliminary Procedural Order on the protection of secrets dated 25 October 2024 exceeds the scope of this Order, it is hereby lifted.

DETAILS OF THE ORDER:

App_57498/2024 and App_57500/2024 under main file references ACT_36426/2024 and CC_57043/2024

UPC numbers: UPC_CFI_336/2024 and UPC_CFI_605/2024

Type of procedure: Infringement action and Counterclaim for revocation

Issued in Düsseldorf on 23 December 2024

NAME UND SIGNATURE

Presiding Judge Thomas