



UPC_CFI_22/2023
Provisional order
of the Court of First Instance of the Unified Patent Court,
issued on 24 October 2024

PARTIES TO THE PROCEEDINGS:

- 1) **10x Genomics, Inc.** represented by Prof. Dr Tilmann Müller-Stoy
(Claimant 1) – 6230 Stoneridge Mall Road,
94588-3260 Pleasanton, CA, USA

- 2) **President and Fellows of Harvard College,** Represented by Prof. Dr. Tilmann
(Claimant 2) – Richard A. and Susan F. Smith Müller-Stoy
Campus Centre, Suite 727E, 1350
Massachusetts Avenue, Cambridge,
Massachusetts 02138, USA

- 3) **Vizgen, Inc.,** Represented by Jérôme Kommer
(Defendant) – 61 Moulton Street, 02138
Cambridge, USA

PATENT IN DISPUTE:

Patent number Owner

EP4108782

President and Fellows of Harvard College

PRESIDING JUDGE:

Judge-rapporteur Sabine Klepsch LANGUAGE OF THE PROCEEDINGS:

German

SUBJECT MATTER OF THE PROCEEDINGS:

Patent infringement action

MOTIONS BY THE PARTIES:

In their written submission dated 29 August 2024, the plaintiffs requested that the contents of the BP 34 set of documents, which was submitted in response to order no. 33133/2024 in proceedings 32879/2024, be classified as confidential information and treated as strictly confidential. The confidential information may only be made available to the defendant's legal representatives and their secretariats ("Outside Attorneys' Eyes Only") as registered in the CMS as the legal team for this legal dispute. Any further access to the confidential information, in particular by employees or representatives of the defendant, shall be prohibited. Access to the confidential information by the respective legal representatives of the parties before the U.S. District Court for the District of Delaware, Case No. 1:22-cv00595-MFK, remains unaffected. It has also submitted a redacted version of this document.

They assert that Exhibit BP 34 is a licence agreement and that further agreements relating to it contain highly sensitive business information that would allow conclusions to be drawn about the nature and scope of the plaintiffs' business relationships. This business information is the plaintiffs' trade and business secrets within the meaning of Art. 58 and 24(1)(a) EPGÜ in conjunction with Art. 2 No. 1 of Directive (EU) 2016/943 on the protection of confidential know-how and confidential business information (trade secrets) against unlawful acquisition, use and disclosure ("Trade Secrets Directive"). They are neither generally known nor readily accessible to the circles that normally deal with this type of information. Nor are they known or readily accessible on the market. Furthermore, this information is subject to appropriate confidentiality measures on the part of the plaintiffs, who have lawful control over the information. Appropriate confidentiality agreements have been concluded with all employees who have access to the information. It is precisely because this information is secret that it has commercial value.

Furthermore, the licence agreement and other agreements accompanying the parallel proceedings before the U.S. District Court for the District of Delaware, Case No. 1:22-cv-00595-MFK, (hereinafter: US proceedings) due to the protective order agreed between the parties. The protective order ensures the protection of the parties' trade and business secrets and other confidential information in the US proceedings and prevents the information from being disclosed to the opposing party or the public. If the information were not limited to the defendant's legal representatives and the proceedings in this case, the protective order system would be rendered ineffective.

Restricting the "Confidentiality Club" to legal representatives is permissible if both parties agree to this (see also LK The Hague, order of 4 March 2024, UPC_CFI_239/2023, App_589842/2023, para. 10). In the present case, such mutual agreement exists. The information requiring confidentiality is part of the protective order from the parallel US proceedings, which restricts access to the parties' outside attorneys, excluding the parties themselves (see also Order No. 40053/2024 in Case 39808/2024, p. 2). The parties had agreed with the competent US court that documents that were part of the protective order and had been identified by the defendant in the present UPC proceedings and whose submission had been requested by it should be subject to confidentiality protection providing for access restriction to "outside attorneys' eyes only".

The defendant requests

1. that the application be dismissed insofar as paragraph 2 thereof restricts access to the unredacted version of Annex BP 34 to the defendant's legal representatives and does not grant access to any employee or representative of the defendant.
2. The defendant may make the designated information available to Ms ██████████ .

It does not dispute the existence of confidential information relating to the licence agreement in Annex BP 34 and the further agreements relating thereto. However, the present case does not involve a situation in which, contrary to the wording of Rule 262A(6) of the Rules of Procedure, access may exceptionally be denied to at least one natural person from each party. Such an exclusion is possible in exceptional cases with the consent of all parties. However, no such agreement between the parties exists with regard to Annex BP 34, nor has it been prompted by the US proceedings. In its present statement, the defendant is particularly concerned with the equal treatment of the licence agreement it has submitted and the licence agreement submitted by the plaintiffs, together with the amendments in Annex BP 34. Both licence agreements are subject to the provisions of the US protective order for the US proceedings, and both licence agreements should be subject to a procedural order in the present proceedings granting access to the licence agreement not only to the legal representatives but also to at least one natural person of the opposing party.

REASONS FOR THE FINAL ORDER:

1.

With regard to the confidentiality requests under lit. a) to c), it can be assumed with the certainty required for an order under R. 262A VerfO that business or trade secrets exist. This has not been disputed by the defendant.

a) The request is admissible. According to Article 9(1) and (2), subparagraph 2(a) of Directive (EU) 2016/943, in legal proceedings, access to documents submitted by the parties or third parties that contain business secrets or alleged business secrets may be restricted in whole or in part to a limited number of persons upon request. The protection of confidential information is provided for in Article 58 of the EPGÜ and implemented in Rule 262A of the EPG Rules of Procedure. The requirements for the application under Rules 262A.2 and .3 of the Rules of Procedure are met. The court invited the representative of the other party to comment in accordance with Rule 262A.4 of the Rules of Procedure, and the representative made use of this opportunity.

b) The application is justified with regard to the confidentiality request. According to Rule 262A.5 of the Rules of Procedure, this is particularly the case if the reasons given by the applicant for the order significantly outweigh the other party's interest in unrestricted access to the information or evidence in question. The defendant can successfully argue that, overall, the information constitutes trade secrets with the certainty required for a confidentiality request under R. 262A VerfO. In this context, the existence of a trade secret does not have to be established to the satisfaction of the court; it is sufficient if it is highly probable, as shown by the wording in Article 9(1) and (2)(a) of Directive (EU) 2016/943, which alternatively refers to "alleged trade secrets". Article 58 EPGÜ also refers to the possibility of ordering protective measures "to protect trade secrets, personal data or other confidential information of a party to the proceedings", thus establishing a broader scope of protectable information. It is not apparent that the individual pieces of information are generally known in their entirety or in the exact arrangement and composition of their components, and this has not been disputed by the defendant. The confidentiality order does not unduly prejudice the defendant's interest in unrestricted access to the information in question.

2.

Access to the information or evidence concerned was to be restricted to certain persons, R. 262A.1 VerfO. According to R. 262A.6 VerfO, the number of persons referred to must not exceed what is necessary to comply with the parties' right to an effective remedy and a fair trial and must include at least one natural person from each party and the respective lawyers or representatives of those parties.

However, an exception to the requirement of a natural person may be made if the parties agree to restrict access to "Outside Attorneys' Eyes only" (cf. LD Den Haag, Order of 4. March 2024 – UPC_CFI_239/2023,

App_589842/2023, para. 10; LD Hamburg, order of 15 August 2024 – UPC_CFI_22/2023, ORD_ 40053/2024, APP_39808/2024). In such a case, there is the possibility of restricting access to legal representatives as a "confidentiality club".

In the present case, the circumstances presented by the plaintiffs indicate that such an agreement exists. The documents submitted in exhibit BP 34 are part of a discovery in proceedings between the parties before the U.S. District Court for the District of Delaware. There, the confidential information is protected by a protective order in such a way that only the parties' legal representatives are allowed access; the document is marked as "Outside Attorneys' Eyes Only Information" in this respect. In a motion dated 7 June 2024 (Exhibit BP 35), the defendant requested that the US court lift the protective order so that it could then submit protected documents in the present proceedings. In its application, the defendant argued that the same confidentiality standards applied in the present legal dispute as before the US court. In particular, it emphasised that the EPG also protects the documents.

"Outside Attorneys Eyes Only" would be possible. The request referred to the documents that are also the subject of the first and second requests for disclosure. The US court then asked the parties to agree on a list of documents that the defendant might be able to request for disclosure in the proceedings here. The parties did so, and the first proposal for such a list in an email dated 14 June 2024 (Exhibit BP 36) from one of the defendant's US attorneys to the plaintiffs' US attorneys already contained the three documents submitted in Exhibit BP 34. The plaintiffs' legal representatives then clarified in an email dated 20 June 2024 that the documents to be submitted to the EPG should enjoy the same protection as that granted to them by the protective order in the US proceedings. The defendant's legal representative agreed to this in an email dated 21 June 2024 (see Annex BP 36).

The agreement to implement a confidentiality regime comparable to the protective order in the present proceedings relates to the content of all documents listed in the defendant's list, which also includes the documents contained in Annex BP 34. Although this agreement was reached by the US representatives of the parties before a US court, it was directly aimed at the submission of documents from the US discovery proceedings before the EPG. It was agreed for the present proceedings between the parties to the present proceedings.

The defendant's objection that there was no agreement between the parties that the licence agreement should be subject to an "outside attorneys eyes only" regime is not convincing in this respect. It is true that the first request for disclosure, which identifies the licence agreement in question as relevant evidence, may have already been made in the statement of defence in November 2023. In a written submission dated 31 May 2024, the defendant then expanded its request for submission to include additional documents and, for the sake of simplicity, repeated the requests already made in November 2023, which were thus made prior to the correspondence submitted by the plaintiffs (see Annexes BP 35 and 36). However, the earlier application does not invalidate the agreement, which can be inferred from the subsequent correspondence, to implement a confidentiality regime comparable to a protective order, which also covers the documents in Annex BP 34. In this respect, a distinction must be made between the time of the application for submission and the agreements reached between the parties, which also include the licence agreement. This is because the correspondence submitted by the plaintiffs as Annexes BP 35 and 36 shows that the agreement also covers the documents in Annex BP 34. For example, the email from the US

American representatives on 14 June 2024 in paragraphs 1, 5 and 23 with document number. The plaintiffs' representatives responded to this in an email dated 20 June 2024, making it clear that it is assumed that the defendant will treat the documents to be submitted to the EPG in the same way as under the protective order of the US court with regard to confidentiality orders. This was confirmed by the defendant's US representatives, who belong to the law firm of the local representative, in an email dated 21 June 2024. In this respect, there is no doubt that the agreement to implement a confidentiality regime comparable to the protective order in the present proceedings also covers the BP 34 set of documents.

Such an understanding may mean that there is no parallel with the licence agreement submitted by the defendant, which was concluded between the defendant and the second plaintiff. This is because three persons on the side of the first plaintiff have access to this agreement. The equality of arms that the defendant wishes to achieve is therefore not attained. However, the fundamental goal of equality of arms cannot lead to the undermining of an agreement reached by the parties with regard to, among other things, the BP 34 set of documents to establish a confidentiality regime comparable to the protective order.

3.

The order is not appealable per se under R. 220.1 VerfO. An appeal is therefore only possible in conjunction with an appeal against the final decision. No party has yet applied for leave to appeal under R. 220.3 VerfO. Leave to appeal ex officio does not appear to be necessary. The rapporteur's jurisdiction for the present order follows from R. 331.1 in conjunction with R. 334 and 335 VerfO.

FINAL ORDER:

1. It is ordered that the contents of the BP 34 file, which was submitted in response to order no. 33133/2024 in proceedings 32879/2024, constitute information subject to secrecy, which must be treated as strictly confidential and may not be used or disclosed outside the present legal dispute, even after its conclusion ("Confidential Information").
2. The confidential information may only be made available to the attorneys of record and their secretariats ("Outside Attorneys' Eyes Only") as listed in the CMS as the legal team for this legal dispute. Any further access to the confidential information, in particular by employees or representatives of the parties, is not permitted. Access to the Confidential Information by the respective attorneys of record for the parties in the proceedings before the U.S. District Court for the District of Delaware, Case No. 1:22-cv-00595-MFK, remains unaffected by this.
3. The persons named in section 2 are obliged to treat the confidential information referred to in section 1 as strictly confidential, even beyond the proceedings,

and to use the confidential information exclusively for the purposes of these proceedings. The aforementioned persons are also obliged to maintain confidentiality vis-à-vis the defendant with regard to the information contained in the unredacted versions of the aforementioned documents. The information may not be used or disclosed outside of these court proceedings, unless it has come to the knowledge of the receiving party outside of these proceedings. However, this exception only applies if this information has been obtained by the receiving party on a non-confidential basis from a source other than the plaintiffs or their affiliated companies, provided that this source is not itself bound by a confidentiality agreement with the plaintiffs or their affiliated companies or by any other confidentiality obligation towards them.

4. For each case of violation of the obligations under clause 3, a penalty payment in an amount to be determined by the court may be imposed.

Sabine Klepsch Presiding Judge and Rapporteur	SabineMaria Klepsch <small>Digitally signed by Sabine Maria Klepsch Date: 24 October 2024 09:28:00 +02'00'</small>
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DETAILS OF THE ORDER:

Order ORD_No. 49363/2024 in proceedings ACT_460565/2023

UPC number: UPC_CFI_22/2023

Type of case: Infringement action

No. of the associated proceedings: 49295/2024

Type of application: APPLICATION_ROP262A