



## Hamburg - Local Chamber

### UPC\_CFI\_54/2023 Preliminary injunction of the Court of First Instance of the Unified Patent Court issued on 03 November 2023

#### HEADNOTES

Finalisation of a confidentiality order and restriction of access under Rule 262A. Determination and substantiation of business and trade secrets.

Reliable people. KEYNOTES

Rule 262A.Art. 58 UPCA. Art. 9 Directive (EU) 2016/943. trade secrets. Final order.

#### DISPUTE PARTIES

- 1) **Avago Technologies International Sales Pte. Limited**  
(Party to the main proceedings - Plaintiff) - 1  
Yishun Avenue 7 - 768923 - Singapore - SG  
Represented by Florian Schmidt-Bogatzky
  
- 2) **Tesla Germany GmbH**  
(Defendant) - Ludwig-Prandtl-Straße 27-29 -  
12526  
Berlin - DE  
Represented by Dr Marcus Grosch

3) **Tesla Manufacturing Brandenburg SE**  
(Defendant) - Tesla Str. 1 - 15537 Grünheide  
(Mark)  
- EN

Represented by Dr Marcus Grosch

STREITPATENT

Patent number

Owner

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**EP1612910**

Avago Technologies International Sales Pte. Limited

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APPLICANTS

1) **Tesla Manufacturing Brandenburg SE**  
Tesla Str. 1 - 15537 Grünheide (Mark) - DE

Represented by Dr Marcus Grosch

2) **Tesla Germany GmbH**  
Ludwig-Prandtl-Straße 27-29 - 12526 Berlin -  
DE

Represented by Dr Marcus Grosch

ORDERING JUDGE:

Judge-rapporteur Stefan Schilling

LANGUAGE OF THE PROCEEDINGS:

German

SUBJECT OF THE PROCEEDINGS:

Patent infringement suit

#### MOTIONS BY THE PARTIES:

In a statement dated 2 October 2023, the defendants requested that access to the passages highlighted in grey in the statement of defence (under C. IV. 3 c), D. I. 2. a] [4], E. II. and sub D. I. 2. a] [5]) as well as to Annexes B 2 and B 4 attached to the statement of defence, to restrict access to certain persons in accordance with R. 262A.1 UPC-VerfO and to declare any further access inadmissible. You have also submitted redacted versions of these documents.

Reference is made to the preliminary order of the Judge-Rapporteur dated 4 October 2023 for the defendant's reasons.

#### Defendants 1) and 2) request the court:

It is ordered that the information contained in the statement of defence is

- a. Information on the technical implementation of the attacked embodiment (all highlighted in grey, in particular sub C.IV.3.c) and Annex B 2),
- b. Information under D.I.2.c (all highlighted in grey) and Annex B 4,
- c. Information regarding the purchase prices of individual chips (all highlighted in grey, in particular sub D.I.2.a)(4)), and
- d. Information related to the defendant's sales result to be forecast (all highlighted in grey, in particular sub E.II and sub D.I.2.a)(5)),

is confidential information that must be treated as strictly confidential and may not be used or disclosed outside of the present legal dispute, even after its conclusion. The plaintiff may only make the specified information accessible to such representatives and internally only to such employees who have a legitimate interest in it. Internal access is to be limited to a maximum of three reliable persons who are to be named to the court and the defendants. Any further access to the designated information must be declared unauthorised.

#### The applicant claims that the Court should,

the provisional procedural order of 4. October 2023 with the access restrictions in a timely manner.

#### BRIEF DESCRIPTION OF THE PROCESS

By provisional order of the judge-rapporteur dated 4 October 2023, access to the confidential version of the statement of defence dated 2 October 2023 and the confidential versions of Annexes B 2 and B 4 was restricted to the plaintiff's representative personally until a final confidentiality order was issued and the plaintiff's representative was obliged to maintain confidentiality. As the case management system only served the redacted versions of the documents, the unredacted documents were sent from lawyer to lawyer on 9 October 2023 at the request of the rapporteur.

has been sent. The plaintiff's representative has been given the opportunity to comment on this application within 14 days. At the same time, the defendant was granted a period of 10 days to respond in order to give the defendant the opportunity to raise any objections, in particular to the persons named by the plaintiff. The plaintiff submitted a statement 14 days after receiving the unredacted documents and the defendant replied within 7 days.

The parties are in dispute as to whether the information on the technical implementation of the attacked embodiment (plaintiff's response under C. IV. 3 c] and Annex B 2) constitutes a trade secret with regard to the detailed data sheet, which is also available to third parties and which was submitted by the plaintiff as Annex EIP 7. The defendants, on the other hand, argue that the exact, product-specific design of the contested embodiment is not generally known either in its entirety or in the exact arrangement and composition of its components and is also the subject of confidentiality measures within the Tesla Group.

They also dispute whether the information regarding the purchase prices of individual chips set out in the statement of defence under D. I. 2. a) (4) and highlighted in grey constitutes business and trade secrets. In this respect, the plaintiff's representative has argued that the costs for a [...] chip are not a secret in the market.

Furthermore, the parties are in dispute as to whether the information set out in sub E. II. and sub D. I. 2. a) (5) regarding the sales result to be forecast are also business and trade secrets. In this respect, the plaintiff's representative asserted that the statements made by the defendant itself on pages 36 et seq. of the statement of defence were referred to "on the basis of publicly available figures".

With regard to the information relating to Annex B 4, the rapporteur had already pointed out in the provisional order of 4 October 2023 that the details of the disclosure to the plaintiff were likely to be decisive for its classification as a trade secret.

#### REASONS FOR THE FINAL ORDER:

1.

With regard to the confidentiality applications pursuant to lit. a) and c), the existence of business or trade secrets is to be assumed with the certainty required for an order pursuant to R. 262A Verfo, but not with regard to the confidentiality applications pursuant to lit. b) and d).

a)

The application is admissible. Article 9(1) and (2), subparagraph 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 be restricted, in whole or in part, to a limited number of persons upon application. The protection of confidential information is provided for in the UPCA in Art. 58 and implemented in the UPC Rules of Procedure in R. 262A. The requirements for the application pursuant to R. 262A.2 and .3 of the Rules of Procedure are met. The court must invite the representative of the other party pursuant to R. 262A.4 of the Rules of Procedure to

opinion; the latter has also made use of this option. b)

The application is justified with regard to the confidentiality applications under a) and c). According to R. 262A.5 of the Code of Procedure, this is the case in particular if the reasons cited by the applicant for the order significantly outweigh the interest of the other party in unrestricted access to the information or evidence in question.

aa)

The defendants can successfully argue that the information on the technical implementation of the challenged embodiment (statement of defence under C. IV. 3 c] and Annex B 2) is a trade secret with the certainty required for a confidentiality application under R. 262A of the Brussels Convention. The existence of a trade secret does not have to be established to the court's satisfaction, but it is sufficient if this is predominantly probable, as shown by the wording in Art. 9 (1) and (2) (a) of Directive (EU) 2016/943, which alternatively refers to "alleged trade secrets". Art. 58 UPCA also refers to the possibility of ordering protective measures "for the protection of trade secrets, personal data or other confidential information of a party to the proceedings" and thus provides an extended scope of protectable information.

It is not apparent that the exact, product-specific design of the contested embodiment is generally known in its entirety or in the exact arrangement and composition of its components. Rather, its design and the functionalities utilised are in all probability trade secrets. This cannot be changed by the fact that the 182-page data sheet of the similar chip MP 2855 submitted by the plaintiff as Annex EIP 7 may contain the basic functionality, because this says nothing about the implementations chosen by the defendants, which are also in dispute here.

Since the plaintiff is already in possession of the data sheet of a similar chip (MP 2855), the confidentiality order does not unduly prejudice the plaintiff's interest in unrestricted access to the information in question. The release of the information to her party representative and up to three employees of her group also sufficiently safeguards her ability to effectively pursue legal action.

bb)

The defendants can also successfully argue that the information regarding the purchase prices of individual chips (all highlighted in grey, there in particular sub D.I.2.a)(4)) is a trade secret with the certainty required for a confidentiality request under R. 262A of the German Constitution. Insofar as the plaintiff asserts that the costs of a [...] chip are not a secret in the market, this does not go to the heart of the confidentiality application. This is because, like the infringement action itself, it is not directed at the [...] chip, but at the challenged components for power control of this very [...] chip. The plaintiff has not objected to the fact that their costs are also known on the market.

On this point too, the confidentiality order does not unduly prejudice the plaintiff's interest in unrestricted access to the information in question and the possibility of effective legal action. In addition, the release of the purchase prices

towards their party representative and up to up to three employees of their group proportionality is ensured.

c)

However, the application is unfounded with regard to the confidentiality applications pursuant to lit. b) and d). aa)

The defendants argue unsuccessfully that the information under D.I.2.c (all highlighted in grey) and Annex B 4 is information that also requires protection vis-à-vis the plaintiff itself. This is contradicted by the fact that the defendants had already sent the letter in Annex B 4 to the plaintiff out of court. It is true that the defendants have submitted that the letter was sent to the plaintiff's representative via a secure transmission channel (beA) and to the domestic representative listed in the DPMA register for the patent in suit in a sealed envelope by courier, in each case with a confidentiality requirement. However, Annex B 4 does not contain the condition of a limitation of the circle of addressees, as now associated with the request for confidentiality pursuant to lit. b), so that it is highly unlikely that any reason for confidentiality can be assumed in relation to the plaintiff. In particular, it cannot be established that the defendant's interest in confidentiality would significantly outweigh the other party's interest in unrestricted access to the information or evidence in question.

In this respect, a distinction must also be made between applications under R. 262.2 of the Code of Procedure on the one hand and R. 262A of the Code of Procedure on the other, in that an application for confidentiality under R.262A concerns confidentiality vis-à-vis the party to the proceedings, while applications under R. 262.2 concern confidentiality vis-à-vis third parties not involved in the proceedings. The defendants are at liberty to assert the confidentiality of this information in the event of a request for access to the file. With regard to the plaintiff itself, this is not appropriate due to the knowledge already acquired by the plaintiff itself.

bb)

The defendants also argue unsuccessfully that, with regard to the claims under sub E. II. and sub D. I. 2. a)

(5) on the sales result to be forecast were business and trade secrets. In this respect, the plaintiff's representative correctly asserted that the statements made by the defendants themselves on pages 36 et seq. of the statement of defence were reported "on the basis of publicly available figures". This is because even the defendants do not disclose their own forecast estimates with this information, which go beyond the calculation based on the official registration figures, the average price of the Tesla Model Y claimed by the defendants and the published return on sales. The defendants also merely extrapolate the figures already available by multiplying these three factors. Their own estimates with regard to any price changes not yet known to the market but planned, expected changes in sales or calculated changes in the return on sales for internal company reasons are not included in this calculation and are therefore not trade secrets.

2.

If the applications were granted, access to the information or evidence concerned was to be restricted to certain persons, R. 262A.1 of the Code of Procedure. According to R. 262A.6 Verfo

the number of persons referred to shall not be greater than necessary to ensure compliance with the right of the parties to the proceedings to an effective remedy and a fair trial and shall include at least one natural person from each party and the respective lawyers or representatives of those parties to the proceedings.

The plaintiff has named three persons who are employed by Broadcom Inc. and who, in addition to the plaintiff's representative, should be allowed to inspect the full versions of the documents. In this respect, the plaintiff has stated that the three persons named by it are those employees of Avago/Broadcom who generally accompany the litigation on the company side. In any event, [...] was known to the defendants or Tesla or the litigation representatives. [...] is another employee responsible for litigation. [...] is an engineer at Avago/Broadcom.

The defendants have not put forward any personal obstacles.

The fact that these persons are not employed by the plaintiff itself is irrelevant. For neither from R. 262A.6 ORP nor from Art. 9 para. 2 subpara. 3 of Directive (EU) 2016/943 can a limitation to natural persons of the company of the plaintiff itself be inferred. In his provisional order, the rapporteur also used the broader formulation of persons "from the plaintiff's company", which does not exclude employees from affiliated companies. In this respect, it must be taken into account that the group affiliation is not in dispute. The defendants have not denied the plaintiff's submission in the statement of claim that it, the plaintiff, is part of Broadcom Inc., a world leader in the field of semiconductor technology.

When exercising its discretion, the court was therefore able to take into account the fact that it is by no means unusual to incorporate industrial property rights into a legal entity other than the one that conducts the operational business and decides on the use of the property rights.

3.

It necessarily follows from the only partial maintenance of the preliminary injunction that the defendants submit corrected redacted versions of the documents in which those parts for which confidentiality protection is no longer ordered are made visible. For this purpose, the defendants will be given the opportunity to upload documents by way of commenting on this order.

4.

The order is not appealable per se in accordance with R. 220.1 VerfO. An appeal is therefore only possible together with an appeal against the final decision. To date, no party has applied for authorisation to appeal in accordance with R. 220.3 VerfO. It does not appear necessary to authorise the appeal ex officio.

FINAL ORDER:

1. It is ordered that the information contained in the statement of defence is
  - a. Information on the technical implementation of the attacked embodiment (all highlighted in grey, in particular sub C.IV.3.c) and Annex B 2),
  - b. [..]
  - c. Information regarding the purchase prices of individual chips (all highlighted in grey, in particular sub D.I.2.a)(4))
  - d. [..]

is confidential information that must be treated as strictly confidential and may not be used or disclosed outside of the present legal dispute, even after its conclusion.

2. The plaintiff may only make the designated information available to those representatives and internally only to those employees who have a legitimate interest in it. Access is limited to the authorised representatives of the plaintiff and to the following persons:
  - a. [...]
  - b. [...]
  - c. [...]

Any further access to the designated information is not permitted.

3. The more extensive provisional order dated 4 October 2023 shall expire with this order.
4. The defendants are ordered to immediately submit a version of the statement of claim adapted to the order so that it can be forwarded to the plaintiff without further limitation.

DETAILS OF THE ARRANGEMENT:

Order no. 577763 in proceedings ACT\_463258/2023 UPC

number: UPC\_CFI\_54/2023

Nature of the action: Action for infringement

No. of the related procedure: 577703/2023

Type of application: APPLICATION\_ROP262A

Issued in Hamburg on 03 November 2023

Judge Dr Schilling (Rapporteur)