



**Local division Mannheim**  
**UPC\_CFI\_219/2023**

**Order**  
**of the Court of First Instance of the Unified Patent Court, Mannheim**  
**Local Division**  
**issued on 10 July 2024**  
**concerning EP 2 568 724**

Plaintiff:

**Panasonic Holdings Corporation** - 1006, Oaza Kadoma, Kadoma-shi - 571-8501 - Osaka - JP  
represented by Christopher Weber

defendant:

**Xiaomi**                      Represented by Dr Corin Gittinger  
**Technology**  
**Germany GmbH**  
(party to the main  
proceedings - Not  
provided) -  
Niederkasseler  
Lohweg 175 -  
40547 -  
Düsseldorf - DE

**Xiaomi**                      Represented by Dr Corin Gittinger  
**Technology**  
**France S.A.S**  
(Party to the main  
proceedings - Not  
provided) - 93 rue  
Nationale  
Immeuble  
Australia - 92100 -  
Boulogne-  
Billancourt - FR

**Xiaomi Technology Italy S.R.L** Represented by Dr Corin Gittinger  
(Party to the main proceedings - Not provided) - Viale Edoardo Jenner 53 - 20158 - Milan - IT

**Xiaomi Technology Netherlands B.V.** Represented by Dr Corin Gittinger  
(Party to the main proceedings - Not provided) - Prinses Beatrixlaan 582 - 2595BM - Den The Hague - NL

**Odiporo GmbH** Represented by Dr Corin Gittinger  
(party to the main proceedings - Not provided) - Formerweg 9 - 47877 - Willich - DE

**Shamrock Mobile GmbH** Represented by Dr Corin Gittinger  
(Party to the main proceedings - Not provided) - Siemensring 44H - 47877 - Willich - EN

STREITPATENT:

EUROPEAN PATENT NO. EP 2568724

ADJUDICATING BODY/CHAMBER:

Mannheim local division JUDGES:

This Order was issued by the Chairman and judge-rapporteur Dr Tochtermann.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: Request for protection of secrets pursuant to R. 262A VerfO on the request for referral

**FACTS OF THE CASE:**

In the present case, the plaintiff applies for protection of secrecy pursuant to R. 262A VerfO with regard to information contained in the unredacted further version of its Reply, including annexes, and with regard to the negotiations between the parties to the legal dispute. Firstly, for the purpose of the opinion, orders were issued for the provisional protection of confidential information relating to licence agreements. The need to protect the information was sufficiently demonstrated. The Order of 30 April 2024 had the following scope:

1. *The following information is provisionally classified as confidential for the purpose of commenting on the application for protection of secrecy pursuant to Rule 262A of the Rules of Procedure:*

*Information concerning patent licence agreements which the applicant has concluded with third parties (whereby this information also includes, but is not limited to, the patent licence agreements themselves), as well as information concerning contractual negotiations on these relevant patent licence agreements which the applicant or a company associated with it has concluded with third parties or the conclusion of which the applicant or a company associated with it is currently negotiating, whereby this also includes such information which concerns the respective contractual relationship after conclusion of the contract, in particular*

*-licence agreements submitted as a result of the submission order;*

*-The versions highlighted in yellow*

*-The attachments FRAND BV labelled as "Strictly confidential";*

*Such information and annexes must be included in the application for an Order for the production of evidence and the related confidentiality applications under R. 262.2 and R.262A and the*

*statements of the plaintiff dated 15 April 2024 and the related confidentiality requests pursuant to R. 262.2 and R.262A.*

2. *Ordered that the information in paragraph 1 on the part of the defendant shall only be*
  - *the authorised representatives, their assistants (including experts and their team members) and*
  - *may be brought to the attention of the following reliable person, namely:- [...].*
  
3. *The persons named under item 2 are obliged to treat the confidential information under item 1 as strictly confidential - also 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 defendants with regard to the information contained in the unredacted versions of the aforementioned documents. They may not be used or disclosed outside these court proceedings unless they have come to the knowledge of the receiving party outside these proceedings. However, this exception only applies if this information was obtained by the receiving party on a non-confidential basis from a source other than the plaintiff or its affiliated companies, provided that this source is not itself bound by a confidentiality agreement with the plaintiff or its affiliated companies or by any other confidentiality obligation towards them.*
  
4. *A penalty payment in an amount to be determined by the court may be imposed for each case of non-compliance with this Order.*
  
5. *The information and/or documents submitted which are the subject of the above applications shall not be deemed to have been filed and may not be used in the proceedings by the opposing party and the court unless the applicant expressly declares within 14 days of receipt of the final decision that the information and/or documents submitted shall nevertheless be deemed to have been filed and may be used in the proceedings by the opposing party and the court.*
  
6. *The **defendant** has until **9 May 2024** to comment on the plaintiff's requests for secrecy protection.*
  
7. *The **plaintiff** has until **9 May 2024** to comment on the information and on the question of whether the documents should be deemed to have been filed and may be used in the proceedings by the opponent and the court.*

The parties were each given the opportunity to comment in the confidentiality procedure.

The defendants (uniform statement of 10 May 2024 in response to the plaintiff's confidentiality applications of 15 March and 15 April 2024) objected to the scope of the confidentiality regulation requested. The scope of use of the applicant's licence agreements should include all proceedings pending at the UPC, including the cases pending at the Munich local division. In addition, it must be possible to exchange information with other persons who are lawfully in possession of the same information, even if they are obliged to maintain confidentiality. In particular, access to other external lawyers of the defendant, namely the representatives in the parallel UK proceedings and national infringement proceedings before the Regional Courts of Mannheim and Munich I, must be authorised. Finally, two further employees of the defendant would need to be authorised to access the information in addition to the one employee previously conceded by the plaintiff. These persons would already know the information from German national patent infringement proceedings and UK proceedings anyway. Insofar as the defendants object to the application initially filed by the plaintiff to surrender or destroy the information concerned after the final conclusion of the proceedings and to threaten a penalty payment with a minimum rate of € 100,000 for the infringement, which the court has already not included in the preliminary Order but rejected, these points of dispute have become procedurally obsolete due to the most recent versions of the application pursued by the plaintiff (see below on the plaintiff's most recent applications).

Finally, the defendants request that the final confidentiality regime be established:

I. Item 2. of the provisional Order of 30 April 2024 be amended as follows:

2. Ordered that the information in paragraph 1 on the part of the defendant shall only be

- the authorised representatives in the present proceedings (UPC\_CFI\_218/2023, UPC\_CFI\_219\_2023 and UPC\_CFI\_223\_2023) and in the parallel proceedings between the plaintiff and the respective defendants in the proceedings before the Regional Court Munich I (Ref. 21 O 9854/23, 21 O 9855/23, 21 O 9856/23 and 21 O 9429/23), before the Regional Court Mannheim (Ref. 14 O 67/23, 14 O 90/23, 14 O 91/23 and 14 O 92/23), before the Munich local division of the Unified Patent Court (UPC\_CFI\_213/2023, UPC\_CFI\_220/2023, UPC\_CFI\_224/2023), as well as before the High Court of Justice of England & Wales (case number HP-2023-000025), their auxiliaries (including experts and their team members) and
- the following reliable persons, namely:
  - [...]

may be brought to the attention of

II. definitively reject the remainder of the applicant's applications insofar as they go beyond the Chamber's provisional Order of 30 April 2024.

Should the Board, contrary to the application under I., contrary to expectations, consider a restriction of access for all six defendants to a single person to be appropriate, we request in the alternative

III. Item 2. of the provisional Order of 30 April 2024 be amended as follows:

2. Ordered that the information in paragraph 1 on the part of the defendant shall only be

- the authorised representatives in the present proceedings (UPC\_CFI\_218/2023, UPC\_CFI\_219\_2023 and UPC\_CFI\_223\_2023) and in the parallel proceedings between the plaintiff and the respective defendants in the proceedings before the Regional Court Munich I (Ref. 21 O 9854/23, 21 O 9855/23, 21 O 9856/23 and 21 O 9429/23), before the Regional Court Mannheim (Ref. 14 O 67/23, 14 O 90/23, 14 O 91/23 and 14 O 92/23), before the Munich local division of the Unified Patent Court (UPC\_CFI\_213/2023, UPC\_CFI\_220/2023, UPC\_CFI\_224/2023), as well as before the High Court of Justice of England & Wales (case number HP-2023-000025), their auxiliaries (including experts and their team members) and
- the following reliable persons, namely:
  - [...]

may be brought to the attention of

For its part, the plaintiff had the opportunity to comment on this submission and opposes the defendant's applications and arguments. An extension of access to three persons of the party is not necessary to soften the confidentiality regime of the UPC by allowing the exchange with litigants in court proceedings in other jurisdictions.

In response to a further request for protection of secrecy by the applicant, which was made with the submission of Reply Part II in the final version, in which all applications for comparative licences submitted in response to the order for reference are addressed, the court issued the following further order for protection of secrecy on 5 June 2024 in workflow 32822/2024 to 32818/2024:

1. *The following information is provisionally classified as confidential for the purpose of commenting on the application for protection of secrecy pursuant to Rule 262A of the Rules of Procedure:*

*Information concerning patent licence agreements which the applicant has concluded with third parties (whereby this information also includes, but is not limited to, the patent licence agreements themselves), as well as information concerning contractual negotiations on these relevant patent licence agreements which the applicant or a company associated with it has concluded with third parties or the conclusion of which the applicant or a company associated with it is currently negotiating, whereby this also includes such information which concerns the respective contractual relationship after conclusion of the contract, in particular*

*-licence agreements submitted as a result of the submission order;*

*-The attachments FRAND BV labelled as "Strictly confidential";*

*Such information and attachments are contained in the further version of the Reply and attachments.*

2. *Ordered that the information in paragraph 1 on the part of the defendant shall only be*
  - the authorised representatives, their assistants (including experts and their team members) and*
  - may be brought to the attention of the**following reliable person, namely: [...].*

3. *The persons named under item 2 are obliged to treat the confidential information under item 1 as strictly confidential - also 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 defendants with regard to the information contained in the unredacted versions of the aforementioned documents. They may not be used or disclosed outside these court proceedings unless they have come to the knowledge of the receiving party outside these proceedings. However, this exception only applies if this information was obtained by the receiving party on a non-confidential basis from a source other than the plaintiff or its affiliated companies, provided that this source is not itself bound by a confidentiality agreement with the plaintiff or its affiliated companies or by any other confidentiality obligation towards them.*
4. *A penalty payment in an amount to be determined by the court may be imposed for each case of non-compliance with this Order.*
5. *The information and/or documents submitted which are the subject of the above applications shall not be deemed to have been filed and may not be used in the proceedings by the opposing party and the court unless the applicant expressly declares within 14 days of receipt of the final decision that the information and/or documents submitted shall nevertheless be deemed to have been filed and may be used in the proceedings by the opposing party and the court.*
6. *The **defendant** has until **11 June 2024** to comment on the plaintiff's requests for secrecy protection.*

Most recently, the plaintiff, following indications from the court on a possible relevant paraphrasing of the information in need of protection, had requested that the protection of confidential information be structured as follows, stating all action numbers of the parallel proceedings and thus uniformly (uniform documents concerning all three parallel cases between the parties concerning EP 724, EP 270 and EP 315, each dated 31 May 2024 here in App 32822/2024; it was not possible to request comments in this workflow of the CMS after only the plaintiff was created as a party in the workflow - therefore, the parties were informed by email dated 5 May 2024 in App 32822/2024. May 2024 here in App 32822/2024; the defendants could not be invited to comment in this CMS workflow in the CMS, since only the plaintiff was created as a party in the workflow - therefore the parties were instructed by email of 5 June 2024 that the plaintiff would transmit the documents directly to the defendant in a secure manner and that the defendant would then comment via a new application under Rule 9 Verfo):

- I. according to R. 262A Verfo

1. the following information is to be classified as confidential, so that the provisions of R. 262A of the Code of Procedure apply, namely
  - a) Information on the licence negotiations that preceded the legal dispute and are still ongoing
    - The grey shaded versions
    - The attachments labelled "strictly confidential" FRAND"
  - b) Information concerning patent licence agreements which the applicant has concluded with third parties (whereby this information also includes, but is not limited to, the patent licence agreements themselves), as well as information concerning contractual negotiations on these relevant patent licence agreements which the applicant or a company affiliated with it has concluded with third parties or which the applicant or a company affiliated with it is currently negotiating, whereby this also includes such information which concerns the respective contractual relationship after conclusion of the contract, in particular
    - The versions highlighted in yellow
    - The FRAND attachments labelled "Strictly confidential with restrictions on persons

Such information is contained in the part of the Reply that has now been submitted without redaction.
2. Order that the information in section I.1b) on the part of the defendant only be
  - the authorised representatives, their assistants (including experts and their team members) and
  - the following reliable person, namely:
    - [...] may be brought to our attention;
3. the Order must be accompanied by a proportionate penalty payment in an amount to be determined by the court for each case of non-compliance;
4. to oblige the persons named in section I.2 to treat the confidential information pursuant to section I.1b) as strictly confidential beyond the proceedings and to use the confidential information exclusively for the purposes of these proceedings

With regard to the further details of the statements, reference is made to the documents and attachments submitted on the confidentiality complex in the various workflows.

**REASONS FOR THE DECISION:**

1. The plaintiff's view that the circumstances of the negotiations between the parties of which the defendants were already aware must be fully protected under Rule 262A of the Rules of Procedure cannot be accepted. A subsequent restriction of access on the part of the defendant is out of the question. Rather, this information can generally only be restricted in its intended use and be subject to protection against disclosure to uninvolved third parties in accordance with Rule 262 of the Rules of Procedure. However, protection from the public in decisions of the court is not possible.



not be considered without restriction insofar as only the abstract processes of the negotiation history are concerned, such as the timing of the negotiation and the fact that a certain step relating to the FRAND negotiations was completed, such as that a written contract offer or further claim charts were submitted at a certain point in time. This is because, in accordance with the Agreement and the Rules of Procedure, there is a public register, which makes it necessary for the public to be able to understand the contexts necessary for the legal understanding of the decision in the decisions that are then to be made. In this context, sufficiently abstract formulations can also be found in specific cases that take into account the public's legitimate interest in information on the one hand and protect the information that needs to be kept secret on the other. However, specific correspondence between the parties relating to the negotiation history, for example, which is submitted as attachments, can be protected as confidential information. With regard to access restrictions on the part of the respective counterparty, something different may apply in the event that - in the present case, no submission has been made - the parties have already deliberately restricted the groups of persons involved in the negotiations for a FRAND licence and subjected them to a comprehensive confidentiality obligation. However, it will also have to be taken into account in this context that the Convention and the Rules of Procedure provide for public access to the register and that in the decisions to be made, the context necessary for the legal understanding of the decision must also be comprehensible to the public. In this sense, the application under 1.a) of the plaintiff was to be granted only in part and rejected in all other respects.

2. Nor can the plaintiff's view be accepted that the fact that the plaintiff enquired with the third-party licence agreement partners on the basis of the court's instructions and requested their consent to the submission must be kept secret. This is because it is a procedural step ordered by the court, which must also be reflected in the court's Orders. The step is intended to ensure that the interests of the third parties concerned have been safeguarded by encouraging the litigant to request the consent of the contracting party and thereby give it the opportunity to participate in the proceedings on its own initiative before a court order for production is considered. It is true that the specific content of the correspondence between the party requesting the submission and its licence agreement partner is regularly a date that must be kept secret, but not the mere fact of the application and the abstractly outlined response to it per se (in the sense of merely stating in the court order whether consent was given or not given or whether consent is subject to further conditions that may themselves require secrecy).
3. In the present case, the extension of access to the information in need of protection to three employees of the defendant is necessary, but also sufficient (for the standards developed, see local division Mannheim UPC\_CFI\_359/2023 of 21 March 2024 = GRUR Patent 2024, 253, 255 f. and local division Düsseldorf UPC\_CFI\_355/2023 ORD\_7096/2024 with identical content). The limitation to only one natural person requested by the plaintiff is already insufficient in view of the complexity of the FRAND discussion conducted in the present SEP proceedings. Conversely, however, the defendant's argument that the number of persons entitled to access should be determined by the number of defendants if they belong to a uniform group of companies for which the FRAND negotiation is centrally controlled is not convincing either. There is a justified need to be able to discuss the complex issues with the two other persons requested by the defendants. Moreover, for reasons of work organisation, it is also necessary to expand the group of persons beyond just one person in order to

for example, to cover cases of illness and holidays or other reasons for which an employee of the defendant may not be available. It is also necessary for an effective defence that the considerably extensive teams of legal representatives in the present case can confer with more than just one natural person from the defendant's side. This appears necessary solely due to the other known global disputes between the parties, in which the same persons belong to the Confidentiality Club and must participate in negotiations, for example, and may be prevented from attending the present proceedings as a result. No reservations have been made regarding the reliability of the persons named by the defendant. On the contrary, it has been submitted that the persons have also been included in the Confidentiality Club as sufficiently reliable in the parallel UK proceedings.

4. In proceedings before the UPC, access to the information in need of protection must only be granted to authorised representatives pursuant to Art 48 UPCA who are permitted to represent the parties in the specific proceedings. In this respect, the Mannheim local division cannot accede to the Order of the Munich local division, panel 1, of 4 July 2024, ORD\_26378/2024, UPC\_CFI\_220/2023), in the parallel proceedings conducted there. For tactical reasons, the possibility of coordination between litigation teams beyond the boundaries of the UPC, including with litigation teams handling national proceedings, may be desirable. However, this would unacceptably weaken the circle of persons who are directly bound by the secrecy protection orders of the UPC and frustrate the legitimate interest of the parties conducting proceedings before the UPC to be able to rely on the court's secrecy regime and to have a conclusive overview of its content and scope (as already stated by the Mannheim local division, Order of 3 July 2024 UPC\_CFI\_471/2023 ORD\_33986/2024 Reasons for decision at 6). In particular, if legal representatives are authorised in other jurisdictions, it no longer appears possible to check how they are bound by the confidentiality protection regime established there and whether there may be further disclosure to other litigation teams. In this respect, it is not sufficient to simply refer to the fact that the representatives active in the national proceedings are also bound by a confidentiality regime. In the present proceedings, as the high number of confidentiality applications shows, the parties attach great importance to confidentiality protection and were unable to agree on congruent regimes in terms of content. In the present case, there is also the fact that, in particular, the defendants are requesting the exchange with litigation representatives in the UK proceedings, but conversely, the Confidentiality Club there intensively shields the UK proceedings and the information in need of protection exchanged there from the proceedings here and the UK is neither a contracting member state of the UPCA nor, in the event of a violation, are the facilitated enforcement mechanisms of EU law available to effectively recover any penalty payments to be imposed by the court.
5. On the other hand, the defendants should in principle be allowed to coordinate with the trial representatives in the parallel proceedings pending between the parties before the Munich local division and to discuss the information in need of protection in this context. This is because, unlike the situation described in sub 4. above, a uniform procedural regime exists here, especially since the Munich local division has expressly referred in its proceedings to the secrecy protection regime established here (cf. Order of 14 February 2024 in the proceedings here) and has also adopted this regime for its proceedings. Even if the Orders of the local chambers differ in details, there is at least a comparable level of protection. However, the exchange with the legal representatives acting before the Munich local division is limited to the extent that they cannot use the knowledge gained from the proceedings here about information requiring protection on the basis of the authorisation granted by the cited Order of the local division.

Local Division Munich, Panel 1, in proceedings conducted outside the UPC. Use is strictly limited to the purposes of conducting proceedings before the UPC.

6. Insofar as the most recently filed application still contains a reference to the "statements highlighted in yellow", the plaintiff itself has clarified in its documents that it is not precisely the statements highlighted in this way (in their very specific wording) that are to be the subject of the application, but that the marking is only used to identify the specific submission it considers to be in need of secrecy, which can be included under the specific, general version of the application as granted.

**ORDER:**

1. The following information is classified as confidential in accordance with Rule 262A CR:
  - a) Information on the licence negotiations that preceded the legal dispute and are still ongoing, insofar as this concerns information from the "FRAND" annexes marked as "strictly confidential".
  - b) Information concerning patent licence agreements which the applicant has concluded with third parties (whereby this information also includes, but is not limited to, the patent licence agreements themselves), as well as information concerning contractual negotiations on these relevant patent licence agreements which the applicant or a company affiliated with it has concluded with third parties or which the applicant or a company affiliated with it is currently negotiating, whereby this also includes such information which concerns the respective contractual relationship after conclusion of the contract, in particular
    - The annexes FRAND BV marked as "Strictly confidential";
2. Ordered that the information in subparagraph 1(b) on the part of the defendant shall only be
  - the authorised representatives in the proceedings conducted before the Mannheim local division of the Unified Patent Court, their auxiliary persons (including experts and their team members) and the authorised representatives in the proceedings conducted before the Munich local division, panel 1, of the Unified Patent Court exclusively for the purpose of conducting proceedings before the Unified Patent Court (UPC\_CFI\_213/2023, UPC\_CFI\_220/2023, UPC\_CFI\_224/2023);
  - the following reliable persons for the aforementioned purposes, namely:
    - [...]may be brought to our attention.
3. The persons named in section 2 are obliged to treat the confidential information in accordance with section 1 as strictly confidential - even beyond the proceedings - and to treat the confidential information as strictly confidential.

Information exclusively for the purpose of conducting proceedings before the Unified Patent Court (UPC\_CFI\_219/2023, UPC\_CFI\_223/2023, UPC\_CFI\_218/2023, UPC\_CFI\_213/2023, UPC\_CFI\_220/2023, UPC\_CFI\_224/2023). The aforementioned persons are also bound to secrecy vis-à-vis the defendants with regard to the information contained in the unredacted versions of the aforementioned documents. They may generally not be used or disclosed outside of these court proceedings unless they have come to the knowledge of the receiving party outside of these proceedings. However, this exception only applies if this information was obtained by the receiving party on a non-confidential basis from a source other than the plaintiff or its affiliated companies, provided that this source is not bound by a confidentiality agreement with the plaintiff or its affiliated companies or by any other confidentiality obligation towards them.

4. A penalty payment in an amount to be determined by the court may be imposed for each case of non-compliance with this Order.
5. The further applications are rejected.
6. In view of the partial rejection of the plaintiff's applications for secrecy protection and the resulting intra-procedural condition of the secrecy protection regime of 14 February 2024, the information and/or the submitted documents that are the subject of the above applications are only deemed to have been submitted to the file and may only be used by the opponent and the court in the proceedings if the plaintiff does not

within **three days of receipt of this final decision**

contradicts.

#### NAMES AND SIGNATURES

Issued in Mannheim on 10 July 2024

Peter Michael Dr  
Tochtermann

Digitally signed by Peter  
Michael Dr Tochtermann  
Date: 2024.07.10 18:11:42  
+02'00'

Dr Tochtermann  
Presiding judge and judge-rapporteur