



KATHER · AUGENSTEIN
RECHTSANWÄLTE

Higher Regional Court Karlsruhe

6 U 122/22

Decision of 04 October 2023

Decision

I. The information listed in the table below, including the Exhibits listed, is classified as confidential:

[...]

II. It is pointed out,

- that the parties, their legal representatives, witnesses, experts, other representatives and all other persons involved in this litigation or having access to documents of this litigation must keep the classified information confidential and must not use or disclose it outside the judicial proceedings, unless they have gained knowledge of it outside the proceedings;
- that these obligations continue to exist after the conclusion of the legal proceedings. This does not apply if the court of the main proceedings has denied the existence of the trade secret in dispute by a final judgment or as soon as the information in dispute becomes known or readily accessible to persons in the circles that usually handle such information;
- in the event of culpable infringement, the court may impose on the obligor an administrative fine of up to EUR 100,000 or up to six months imprisonment for each infringement and enforce it immediately.

III. Plaintiff's further request for confidentiality in the "Appeal Response (Part 2 - FRAND)" dated 31 August 2022 is rejected.

Reasoning

The motions on confidentiality in Plaintiff's "statement of defense in the appeal proceeding (Part 2 - FRAND)" dated 31 August 2022 are to be granted in part.



I.

The order is based, insofar as granting, on Sec. 145a German Patent Act in conjunction with Sec. 16 (1), Sec. 20 (5) sentence 1, 2 in conjunction with Sec. 16 (2) and Secs. 17, 18 Ac on Trade Secrets. In this respect, it corresponds in content to the admissible and substantiated motions on confidentiality under 1. and 3. in Plaintiff's " statement of defense in the appeal proceeding (Part 2 - FRAND)" of 31 August 2022, adapting the wording of the law ("indicate" instead of "instruct", "confidential" instead of "strictly confidential").

1.

The fact that the parties in any case agree that the contents of their licensing negotiations is classified as confidential and have agreed to maintain confidentiality does not prevent the admissibility of the application. The deviating opinion of the Regional Court Mannheim (GRUR-RR 2023, 285 et seq.; this approach rejecting Hoppe, GRUR-RR 2023, 288; Drescher/Dilbaz, GRUR-Prax 2023, 407; Oldekop, GRUR Patent 2023, 130, 131; different opinion also evidently Kühnen, Handbuch der Patentverletzung, 15th ed. Kap. D Rn. 147 f.) contradicts Senate's established practice and is not shared by the Senate.

The need for legal protection can already not be denied, because the requested classification as a trade secret pursuant to Sec. 16 (1) Act on Trade Secrets has the consequence, inter alia, that all persons involved in the dispute or having access to its documents are subject to the obligation under coercive measures to treat the information classified as confidential (Sec. 16 (2), Sec. 17 Act on Trade Secrets) and, in addition, third parties who have a right to file inspection may only be provided with file contents in which the statements containing trade secrets have been made unrecognizable (Sec. 16 (3) Act on Trade Secrets; mandatory and in this respect extending beyond the requirement to consider confidentiality interests, which can be derived abstractly from Sec. 299 (2) German Code of Civil Procedure; cf. Alexander in Köhler/Bornkamm/Feddersen, UWG, 41. Aufl., GeschGehG § 16 para. 36; Kühnen, loc.cit. para. 187). Contrary to the view of the Regional Court Mannheim (loc. cit.), these are not mere legal reflexes of the protection granted by law to the owner of the trade secret, which are not supported by a legitimate interest of the applicant. Irrespective of whether the law "primarily" envisages the risk of disclosure by the opposing party, it is in any case (also) one of the legal consequences intended by the unambiguous legal provision that the owner of the trade secret



can achieve, by means of a classification to be applied for by him, that the risk of disclosure by other persons is reduced in the manner provided for in Sec. 16 paras. 2, 3, Secs. 17, 18 Act on Trade Secrets. According to the explanatory memorandum to the Act, the comprehensive group of persons affected by the obligation to maintain confidentiality is expressly intended to extend the protection of owners of trade secrets against disclosure of the trade secret during public proceedings (BT-Drs. 19/4724, p. 35). By means of a confidentiality agreement between the parties, different to the decision under the Act on Trade Secrets, it cannot be achieved, for example, that the court's executive board is bound by the judicial classification of certain information as confidential when deciding in future on a request for file inspection after conclusion of the proceedings pursuant to Sec. 299 (2) German Code of Civil Procedure, i.e. that this classification - in the words of the explanatory memorandum to the Act - "effects" the administration of justice (BT-Drs. 19/4724, loc. cit.). The classification thus goes beyond the protection already resulting from other civil, criminal or public law provisions. An assumption that the legal consequences concerning third parties under Sec. 16 (2), (3), Secs. 17, 18 Act on Trade Secrets in question here were dispensable in view of a level of protection that can already be derived from other laws would inadmissibly disregard the intention of the legislature, which has been expressed in the aforementioned provisions. In particular, a different assessment cannot be based on the fact that Sec. 20 (2) Act on Trade Secrets provides for a hearing only of the opposing party.

2.

The substantive requirements according to Sec. 145a German Patent Act in conjunction with Sec. 16 (1) Act on Trade Secrets are met. The information introduced into the proceedings by Plaintiff, the classification of which is requested, may be a trade secret within the meaning of these provisions.

3.

From the wording of Sec. 16 (1) Act on Trade Secrets ("may") it is deduced that the decision on the classification lies within the discretion of the court (cf. only Higher Regional Court Düsseldorf, GRUR-RR 2023, 110, 111; Alexander in Köhler/Bornkamm/Feddersen, UWG, 41st ed., Business Secret Act § 16 para. 27 mwN). This does not require further discussion here, nor does the question of whether only very special circumstances can speak against a



classification (Alexander, loc. cit.; Hoppe, WRP 2023, 546, 547, both with an emphasis on the relevant points). In the case in dispute, the requested (mere) classification as confidential (Sec. 16 (1) Act on Trade Secrets) is in any case required in the discretion of the Senate, because it also protects Plaintiff from disclosure of the information by parties other than those already bound by the confidentiality agreement and to third parties (see above). It can be left open whether the content of a confidentiality agreement of the parties can speak against further access restrictions pursuant to Sec. 19 (1) Act on Trade Secrets (see Higher Regional Court Düsseldorf, GRUR-RR 2023, 110, 111 f).

4.

There was no need to request Defendant to comment. In any case, according to Senate's discretion and its constant practice with regard to its power to annul and amend (Sec. 2 (2) sentence 2 Act on Trade Secrets), it would be sufficient if Defendant would have the opportunity to comment after the present order of the measure (Sec. 20 (2) sentence 1 Act on Trade Secrets). This is sufficient, especially since the parties in any case agree that the contents of their licence negotiations must be classified (exclusively) vis-à-vis third parties and have agreed on confidentiality. Apart from this, Defendant has had sufficient opportunity to comment on the motions submitted to it.

II.

The motion on confidentiality to 2. in the same pleading is unfounded. There is no legal basis for the court order to treat the classified information confidential. The obligation to treat the information confidential is a mandatory legal consequence pursuant to Sec. 16 (2) Act on Trade Secrets, to which the court merely has to refer pursuant to Sec. 20 (5) sentence 2 Business Secret Act.

III.

There are no reasons to admit the appeal on points of law pursuant to Sec. 574 (1) no. 2, (2), (3) German Code of Civil Procedure.