



Federal Court of Justice

X ZR 33/19

Decision of 14.01.2020

Order

Defendant's reminder against the refusal to grant inspection of the documents referred to in Plaintiff's brief of 2 September 2019 is dismissed.

Grounds

I.

Plaintiff is suing Defendants for infringement of a patent relating to a mobile telephone system.

The Regional Court has fully convicted Defendants – as requested with the last first-instance motion – to render information and account and determined Defendants' liability to damages. The Court of Appeal dismissed the claim to accounting partially and at the same time dismissed Defendant's appeal (HRC Düsseldorf, dec. of 22 March 2019, 2 U 31/16; GRUR-RS 2019, 6087). The parties and Plaintiff's intervener appeal that decision and requested leave to appeal.

Among the files sent by the Court of Appeal is a special volume marked "Secrecy Protection" containing a brief and exhibits submitted by Plaintiff as part of its Response to the Appeal. Plaintiff has marked some pages of that brief and some of those exhibits as "strictly confidential" and has requested that the parts marked accordingly be disclosed only to certain persons and that they be made confidential.

The Court of Appeal rejected this request by order of 14 December 2016 and ordered Plaintiff to exchange the submitted documents for a partially redacted copy. Plaintiff then stated that, in addition to the full version, it had already submitted to the Court a partially redacted copy of the documents at issue.

By order of 17 January 2017, the Court of Appeal ordered that the parts marked as strictly confidential should only be brought to the attention of the intervener's legal



representatives, that they should also be bound to secrecy vis-à-vis the intervener, and that a non-disclosure agreement with more specific content should be concluded with regard to Defendant. There was no subsequent conclusion of such an agreement and no transfer of the unredacted documents to Defendants.

At the request of the Plaintiff's representative, the Registry of the Federal Court of Justice made the court files and the unredacted documents available to him. Plaintiff opposed the disclosure of those documents to Defendants' representatives. After consulting the Chairman, the Registry made the files without these documents available to Defendants' counsel.

Defendants request that they be granted access to the documents that have not yet been submitted to them. Plaintiff contests that request.

II.

Defendants' motion is admissible under Sec. 573 of the German Civil Procedural Code (ZPO). It is, however, meritless.

1.

The motion is admissible as a reminder against the decision of the Registry pursuant to Sec. 573 (1) S. 1 and (3) ZPO.

[...]

2.

The reminder is unfounded.

Defendants have no right of access to the documents at issue, since the documents have not become part of the court files and Plaintiff did not consent to their disclosure to Defendants without any special confidentiality measures.

a)

Pursuant to Sec. 299 (1) ZPO, the parties may inspect the files of the proceedings. According to Sec. 555 (1) ZPO, this provision applies accordingly in appeal proceedings.

The casefile includes, in principle, all briefs and documents produced before the Court of First Instance in connection with the proceedings. In the appeal instances, this also includes documents produced in the lower instances to which this condition applies.



Those are essentially the briefs and exhibits lodged by the parties and the documents produced by the Court itself. However, the records of the proceedings do not include files from other judicial or official proceedings (FCJ, dec. of 18 October 1951, IV ZR 152/50, NJW 1952, 305, 306).

b)

This dispute does not concern the documents consulted [by the Court], but those submitted by Plaintiff. Nevertheless, these do not fall within the scope of Sec. 299 (1) ZPO because Plaintiff submitted them only with reservation and the Court of Appeal refrained from passing them on to Defendants in view of this reservation.

According to Sec. 299 (1) ZPO, the right of a party to file inspection does not depend on the consent of the other parties or other parties to the proceedings. However, a distinction must be drawn between that question and the question of the conditions under which a document lodged by a party is to be included in the case file and thus covered by the right of inspection.

It is true that the question of which documents are to be placed on the file is in principle not a matter for the parties but for the Court of First Instance. The latter, in turn, must, in principle, take all documents relating to the case files that a party or other persons submit to the proceedings in question. If, however, a party indicates at the time of filing the documents that they are to be made available to the other party only under certain conditions, they will in any event not become part of the case file if the Court refrains from disclosing them to the other party in view of this reservation.

However, a party who wishes to provide certain information to the opponent only if special measures of confidentiality are taken has the possibility to initially submit only a partially redacted version of the documents concerned and to request the Court to order appropriate confidentiality measures (HRC Düsseldorf, dec. of 25 April 2018, 2 W 8/18, juris para. 7). If it submits the documents without appropriate confidentiality precautions, it must in principle expect that these will be made available to the other parties to the proceedings, irrespective of its own business and trade secrets (HRC Düsseldorf, 2 W 8/18, juris para. 8; c.f. HRC Munich, dec. of 8 November 2004, 29 W 2601/04, NJW 2005, 1130, 1131).

In principle, however, a party has also taken sufficient security precautions in this sense if, in addition to a partially redacted version intended for the case files and for service on the opponent, it also submits a complete version, making it clear that this version is only to be made available to the opponent under certain conditions. This approach is admittedly not very expedient, because the court may not, in principle, take into account



the redacted passages to the detriment of another party without granting the latter a hearing in accordance with the law (c.f. HRC Munich, NJW 2005, 1130). That circumstance does not, however, justify taking the documents into the casefile against the express will of the party submitting them.

Procedural acts must not be made subject to a condition. A violation of this principle generally has the consequence that the act is to be regarded as invalid or inadmissible (see, for example, FCJ, dec. of 11 July 1995, X ZR 99/92, BGHZ 130, 259 = GRUR 1996, 109, juris para. 95 – Clinical trials; dec. of 1 June 2017, V ZB 106/16, NJW-RR 2017, 1145 para. 11). In accordance with these principles, it cannot in principle be assumed that a party wishes to submit documents relating to legal proceedings if it makes their disclosure to the opponent subject to a condition. It is not necessary to determine whether the filing of briefs or other documents qualifies as a procedural act. In any event, as in the assessment of procedural acts, there must in principle be clarity from the outset when assessing whether certain documents should be included in the case file. This clarity is generally achieved when documents are submitted without reservation in respect of a particular procedure. On the other hand, it is lacking if the submitting party makes forwarding to the opponent subject to conditions.

c)

The refusal to grant access to the documents in question does not infringe Defendants' right to be heard.

However, Article 103(1) of the Basic Law would have been infringed if the Court of Appeal had based its decision on the documents in question to the detriment of Defendant without giving Defendants a reasonable opportunity to comment. However, such a violation can be objected to within the framework of an appeal or a motion for leave of appeal. There is no need for Defendant to have access to the relevant documents in that regard, since the infringement may consist precisely in the fact that the contested decision has no basis in the contents of the file.



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