



- Courtesy Translation -

Guidelines for Handling Requests for Confidentiality During and Outside the Oral Proceedings in patent litigation before the Munich I Regional Court

(As of February 2020)

These Guidelines govern the handling of requests for confidentiality during and outside the oral proceedings in patent litigation by the two patent litigation Chambers of the Munich I Regional Court. They apply until the publication of updated Guidelines for patent disputes and for disputes related to utility models and semiconductor protection. The Chambers reserve the right to derogate from this rule in individual cases, after prior notice by the Courts. The respective German version is authoritative.

If the planned Sec. 145a of the German Patent Code (PatG) comes into force (discussion draft of the Federal Ministry of Justice and Consumer Protection: Draft of a Second Act to Simplify and Modernise Patent Law), the provisions of Secs. 16 to 20 of the German Trade Secret Code (GeschGehG) of 18 April 2019 (Federal Law Gazette I p. 466) shall apply mutatis mutandis to patent litigation. Until then:

If a party claims that it cannot present or submit contracts without measures to protect the confidential information contained therein, for example within the scope of its secondary burden of proof regarding the content of existing contracts, it must, prior to the written presentation or submission, ensure that the other party and any intervening parties who have already joined the proceedings conclude a confidentiality agreement out of court which makes this possible. If the other party unjustifiably refuses to conclude such a contract, the party in question need not disclose anything that requires confidentiality. The other party must then, however, independently present and prove, for example, any discrimination contrary to antitrust law, and cannot claim that the other party has not fulfilled its obligation to present. In the event of a later addition of secondary interveners, they must also sign an out of court non-disclosure agreement. Otherwise, the procedure set out in the decision of 13.08.2019 (ECLI:DE:LGMUEN1:2019:0813.7O3890.19.0A) shall apply.



If, for certain individual parts of the written submissions, special restrictions on access to the file and/or the oral proceedings and/or the judgment are to be applied for, the information to be kept confidential should, if possible, be submitted in a separate exhibit marked visibly on the first page. In the brief, instead of the secret, the reference in this separate exhibit must be mentioned. Care must be taken to ensure that the brief remains legible despite the (individual) references. The standard of Sec. 172 No. 2 of the German Courts Constitution Code (GVG) applies. Accordingly, it must be submitted in detail and made plausible that and why an important secret is present and that and why its worthiness of protection outweighs the public interest in a public debate in an oral hearing in the individual case. This standard also applies if the other parties to the proceedings should agree to the special need for confidentiality. For the principle of publicity is removed from the parties' disposition maxim. It is therefore suggested to submit substantiated written submissions in this respect in good time and to point out to whom what information is to be kept confidential, why, to what extent and for how long.

Insofar as one party claims, for example in the context of the submission of previously concluded licence agreements, that due to confidentiality agreements contained in these earlier agreements, it cannot submit these without a court order or make a submission on their content, it must draw attention to this in good time and propose a decision in accordance with Section 142 of the German Civil Procedural Code. The two Chambers will normally follow the suggestion and order the production, the production order being conditional on the other party and the intervening parties having previously concluded an out of court confidentiality agreement. If the other party unjustifiably refuses to conclude such a contract, it need not be submitted; if one of the secondary interveners does so, this party will be excluded from further proceedings to that extent. In appropriate cases, the plaintiff may also suggest a separation of proceedings in this respect, for example with regard to separable matters in dispute concerning this secondary intervener.

The two patent infringement Chambers will – in accordance with the German Trade Secret Code (GeschGehG) – take and maintain protective measures outside of the oral proceedings from the beginning and until proof of non-eligibility for protection is provided. During the oral hearings (and the subsequent decision), the two patent infringement Chambers will endeavour to avoid discussing or mentioning these secrets at all, if possible. Where it is indispensable to do so and where it is therefore necessary to decide on the exclusion of the public, the two



Chambers shall be need to rely on substantiated written submissions by the applying party in order to examine the prerequisites.

The above interim provisions shall also apply to disputes arising from utility models, semiconductor protection and supplementary protection certificates until a provision comparable to the planned Sec. 145a of the German Patent Code is created.

Insofar as such a regulation enters into force, the party to an already ongoing proceeding who wishes to continue to protect persons in need of confidentiality must immediately and independently of protective measures already taken on the basis of the interim regulation apply for the adoption of a decision in accordance with Sec. 16 (1) of the German Trade Secret Code (GeschGehG).

Insofar as the protection of certain information submitted in writing should be denied by the Court, the submitting party is free to have the documents removed from the file in accordance with the more detailed provisions of the decision of the Federal Court of Justice of 14 January 2020 "Inspection of files XXIV" (docket no. X ZR 33/19). The withdrawn contents will then not be handed over to the other parties to the proceedings and will not be taken into account in the decision.

Against the background of contractual freedom and the private autonomy of the market participants, the two Chambers refrain from prescribing the specific content of the contractual clauses referred to. However, the wording chosen must meet the requirements of the individual case and bring the conflicting interests of the two contracting parties to a fair balance. If necessary, drafts communicated by third parties for this purpose may be used in the formulation.
