



UPC_CFI_22/2023
Preliminary procedural order
of the Court of First Instance of the Unified Patent Court, issued on
24 October 2024

PARTIES TO THE DISPUTE:

- 1) **10x Genomics, Inc.**
(applicant for 1)) - 6230 Stoneridge Mall
Road, 94588-3260 Pleasanton, CA, USA
Represented by Prof. Dr Tilmann Müller-
Stoy

- 2) **President and Fellows of Harvard College,**
(applicant for 2)) - Richard A. and Susan F. Smith
Campus Centre, Suite 727E, 1350 Massachusetts
Avenue, Cambridge, Massachusetts 02138, USA
Represented by Prof. Dr Tilmann Müller-
Stoy

- 3) **Vizgen, Inc,**
(defendant) - 61 Moulton Street, 02138
Cambridge, USA
Represented by Jérôme Kommer

PATENT IN DISPUTE:

Patent number Proprietor

EP4108782

President and Fellows of Harvard College

ORDERING JUDGE:

Judge-rapporteur Sabine Klepsch LANGUAGE OF THE PROCEEDINGS:

German

SUBJECT OF THE PROCEEDINGS:

Patent infringement action

APPLICATIONS OF THE PARTIES:

In a document dated 29 August 2024, the plaintiffs requested an order that the content of the BP 34 annex, which was submitted in response to order no. 33133/2024 in proceedings 32879/2024, is confidential information that must be treated as strictly confidential. The confidential information may only be made accessible to the defendant's authorised representatives and their secretariats ("Outside Attorneys' Eyes Only") as filed with CMS as the legal team for this litigation. Any further access, in particular by employees or representatives of the defendant, to the confidential information shall be inadmissible. Access to the Classified Information by the parties' respective counsel of record before the U.S. District Court for the District of Delaware, Case No. 1:22-cv00595-MFK, remains unaffected. She has also filed a redacted version of this document.

They argue that Annex BP 34 is a licence agreement and further agreements relating to it with completely highly sensitive business information that would allow conclusions to be drawn about the nature and scope of the plaintiffs' business relationships. This business information is trade and business secrets of the plaintiffs within the meaning of Art. 58 and 24 para. 1 lit. a) UPCA in conjunction with Art. 2 no. 1 of the Directive. Art. 2 No. 1 of Directive (EU) 2016/943 on the protection of confidential know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure ("Trade Secrets Directive"). They are neither generally known nor readily accessible to the circles that normally deal with this type of information. They are also not known or readily accessible in the market. Furthermore, this information is subject to appropriate confidentiality measures on the part of the plaintiffs, who have lawful control over the information. Appropriate confidentiality obligations have been concluded with all employees who have access to the information. Precisely because this information is secret, it is of commercial value.

In addition, the licence agreement and the other agreements were only disclosed with the restriction "Outside Attorney's Eyes Only" as part of the discovery accompanying the parallel proceedings before the U.S. District Court for the District of Delaware, Case No. 1:22-cv-00595-MFK, (hereinafter: US proceedings) due to the protective order agreed between the parties. The Protective Order ensures the protection of trade and business secrets and other confidential information of the parties in the US proceedings and prevents the information from being disclosed to the other side or the public. If the information is not limited to the defendant's counsel and to the proceedings here, the protective system of the Protective Order would come to nothing.

A restriction of the "Confidentiality Club" to the legal representatives is permissible if both parties agree to this (also LK Den Haag, order of 4 March 2024, UPC_CFI_239/2023, App_589842/2023, para. 10). In the present case, there was such mutual consent. The information requiring confidentiality is part of the protective order from the US parallel proceedings, which restricts access to the parties' outside attorneys to the exclusion of the parties themselves (see also order no. 40053/2024 in proceedings 39808/2024, p. 2). The parties had agreed with the competent US court that for documents that are part of the Protective Order and are identified by the defendant in the present UPC proceedings and whose production is requested by the defendant, a protection of secrecy is to be obtained that provides for the access restriction "Outside Attorneys' Eyes Only".

The defendant claims,

1. Dismiss the application insofar as paragraph 2 thereof restricts access to the unredacted version of Exhibit BP 34 to the defendant's authorised representatives and no employee or representative of the defendant is to be granted access.
2. The defendant may make the designated information available to Ms [REDACTED].

It does not deny the existence of information requiring secrecy with regard to the licence agreement of Annex BP 34 and the other agreements relating to it. However, the present case is not a constellation in which, contrary to the wording of Rule 262A.6 RoP, access by at least one natural person of each party can be excluded by way of exception. Such an exclusion is exceptionally possible with the agreement of all parties. However, such an agreement between the parties does not exist with regard to Annex BP 34 and was not prompted by the US proceedings. The defendant's main concern with the present statement is the equal treatment of the licence agreement submitted by it with the licence agreement and amendments in Annex BP 34 submitted by the plaintiffs. Both licence agreements are subject to the provisions of the US Protective Order for the US proceedings and both licence agreements should be subject to a procedural order in the present proceedings, which grants access to the licence agreement to at least one natural person of the opposing party in addition to the authorised representatives.

REASONS FOR THE FINAL ORDER:

1.

With regard to the requests for confidentiality pursuant to lit. a) to c), the existence of business or trade secrets must be assumed with the certainty required for an order pursuant to R. 262A RoP. The defendant has not denied this.

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 on application. The protection of confidential information is provided for in the UPC Agreement in Art. 58 and implemented in the RoP of the UPC Agreement in R. 262A. The requirements for the application under R. 262A.2 and .3 RoP are met. The court has invited the representative of the other party to comment in accordance with R.262A.4 RoP; the latter has also made use of this opportunity.

b) The application is justified with regard to the confidentiality request. According to R. 262A.5 RoP, this is the case in particular if the reasons given by the applicant for the order significantly outweigh the other party's interest in unrestricted access to the information or evidence in question. The defendant can successfully argue that the information as a whole is a trade secret with the certainty required for a confidentiality application under R. 262A RoP. 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, which is shown by the wording in Art. 9 (1) and (2) (a) of Directive (EU) 2016/943, which alternatively assumes the existence of a trade secret.

"alleged trade secrets". Art. 58 UPCA also speaks of 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 takes as a basis an extended circle of protectable information. The fact that the individual pieces of information are generally known in their entirety or in the exact order and composition of their components is not apparent and has not been denied by the defendant. The confidentiality order does not unduly prejudice the defendant's interest in unrestricted access to the information in question.

2.

Access to the information or evidence concerned was to be limited to certain persons, R. 262A.1 RoP. According to R. 262A.6 RoP, the number of persons referred to must 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 must include at least one natural person from each party and the respective lawyers or representatives of these parties to the proceedings.

However, an exception to the requirement of a natural person can be made if the parties agree to restrict access to "outside attorneys' eyes only" (see LD The Hague, order of 4 March 2024 - UPC_CFI_239/2023,

App_589842/2023, para. 10; LD Hamburg, order of 15 August 2024 - UPC_CFI_22/2023, ORD_40053/2024, APP_39808/2024). In such a case, there is the possibility of a restriction to the legal representatives as a "confidentiality club".

In the present case, the circumstances presented by the plaintiffs indicate a corresponding agreement. The documents submitted in Exhibit BP 34 are part of a discovery in proceedings between the parties before the U.S. District Court for the District of Delaware. There, the confidential information is protected under a protective order in such a way that only the parties' authorised representatives are permitted access; the document is marked as "Outside Attorneys' Eyes Only Information". By application dated 7 June 2024 (Exhibit BP 35), the defendant requested the US Court to open the Protective Order in order to be able to produce protected documents in the present proceedings. In the application, the defendant asserted that the same confidentiality standards would apply in the present litigation as before the US court. In particular, it was emphasised that the protection of the UPC Agreement "Outside Attorneys Eyes Only" would be possible. The application referred to the documents that are also the subject of the first and second requests for production. The US court then asked the parties to agree on a list of documents that the defendant could possibly request to be produced in the proceedings here. The parties did so, and the first proposal of such a list in an email dated 14 June 2024 (Exhibit BP 36) from one of the defendant's US counsel to the plaintiffs' US counsel contained the three documents submitted in Exhibit BP 34. In response, the plaintiffs' counsel clarified by email dated 20 June 2024 that the documents to be produced should enjoy the same protection before the UPC Agreement as granted to them by the Protective Order in the US proceedings. The defendant's counsel agreed to this in an email dated 21 June 2024 (see Exhibit BP 36).

The agreement to effectuate a confidentiality regime comparable to the Protective Order in the present proceedings relates to the content of all documents listed in the defendants' list, which also includes the documents contained in the BP 34 attachment. Although this agreement was reached by the parties' US representatives before a US court, it was directly aimed at the production of documents from the US discovery proceedings before the UPC Agreement. It was agreed for the present proceedings between the parties to the present proceedings.

The defendant's objection that there is no agreement between the parties that the licence agreement should be subject to an "Outside Attorneys Eyes Only" regime is not convincing in this respect. It is true that the first request for submission, which identifies the licence agreement in question as relevant evidence, may already have been submitted with the statement of defence in November 2023. By document dated 31 May 2024, the defendant then extended its application for production to include additional documents and, for simplified handling, repeated the applications already submitted in November 2023, i.e. prior to the correspondence submitted by the plaintiffs (see Annexes BP 35 and 36). However, the prior filing of the application does not invalidate the agreement, which can be inferred from the subsequent correspondence, to bring about a secrecy protection regime comparable to the Protective Order, which also includes the documents of the BP 34 annex. In this respect, a temporal distinction must be made between the submission of the request for production and the agreements made between the parties, which also include the licence agreement. This is because the correspondence submitted by the plaintiffs as Annexes BP 35 and 36 shows that the documents in Annex BP 34 are also covered by the agreement. The email from the US

American representatives of 14 June 2024 in paragraphs 1, 5 and 23 with document number. The plaintiffs' representatives responded to this by email dated 20 June 2024 and made it clear that it was assumed that the defendant would treat the documents to be produced before the UPC Agreement in the same way as under the US court's Protective Order with regard to confidentiality orders. This was confirmed by the US representatives of the defendant, who belong to the law firm of the representative here, in an email dated 21 June 2024. In this respect, there is no reasonable doubt that the agreement to effectuate a secrecy protection regime comparable to the Protective Order in the present proceedings also covers the BP 34 asset bundle.

Such an understanding may have the consequence that there is no parallelism with the licence agreement submitted by the defendant, which was concluded between the defendant and the plaintiff 2). This is because three persons have access to this contract on the part of plaintiff 1). An equality of arms, which the defendant wishes to achieve, is therefore not achieved. However, the fundamental objective of equality of arms cannot lead to an agreement reached by the parties with regard to, among other things, the BP 34 plant bundle to create a secrecy protection regime comparable to the Protective Order being cancelled out.

3.

The order is not appealable per se under R. 220.1 RoP. 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 RoP. It does not appear necessary to authorise the appeal ex officio. The competence of the judge-rapporteur for the present order follows from R. 331.1 in conjunction with R. 334 and 335 VerfO. R. 334 and 335 RoP.

FINAL ORDER:

1. It is hereby ordered that the content of the BP 34 annex, which was submitted in response to order no. 33133/2024 in proceedings 32879/2024, is classified information that must be treated as strictly confidential and may not be used or disclosed outside the present legal dispute, even after its conclusion ("Classified Information").
2. The Confidential Information may only be made accessible to the authorised representatives and their secretariats ("Outside Attorneys' Eyes Only") as filed with CMS as the legal team for this legal dispute. Any further access, in particular by employees or representatives of the parties, to the confidential information is not permitted. Access to the Confidential Information by the parties' respective counsel of record in the proceedings before the U.S. District Court for the District of Delaware, Case No. 1:22-cv-00595- MFK, remains unaffected.
3. The persons named under point 2 are obliged to treat the confidential information under point 1 as strictly confidential - even beyond the proceedings.

and to use the confidential information exclusively for the purposes of these proceedings. The aforementioned persons shall also be bound to secrecy vis-à-vis the defendant with regard to the information contained in the unredacted versions of the aforementioned documents. The information may not be used or disclosed outside these court proceedings unless it has 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 plaintiffs or their affiliates, provided that this source is not bound by a confidentiality agreement with the plaintiffs or their affiliates or by any other obligation of confidentiality 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 the obligations under section 3.

Sabine Klepsch Presiding judge and rapporteur	Sabine Maria Klepsch
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Sabine Maria Klepsch	Digitally signed by Sabine Maria Klepsch Date: 2024.10.24 09:28:00 +02'00'
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DETAILS OF THE ORDER:

Order ORD_No. 49363/2024 in proceedings ACT_460565/2023 UPC
number: UPC_CFI_22/2023
Type of action: Action for infringement
No. of the related procedure: 49295/2024 Type
of application: APPLICATION_ROP262A