



Düsseldorf local division
UPC_CFI_539/2024

Order
of the Court of First Instance of the Unified Patent Court issued on
19 November 2025
concerning EP 3 212 356 B1

GUIDING PRINCIPLES:

1. With regard to the scope of the disclosure of the expert opinion/written report to the applicant, it must first be determined whether the information or evidence constitutes trade secrets or contains personal data of third parties or constitutes or contains other confidential information (Art. 58 UPC Agreement).
2. If this is the case, this information/evidence must be redacted if it is irrelevant to the question of infringement or possible acts of use.
3. If secret or confidential information relates to the question of infringement and/or the scope of acts of use, a decision must be made in each individual case as to whether it should be disclosed to the applicant, but the applicant is obliged to maintain confidentiality vis-à-vis third parties, or whether the applicant's knowledge should be restricted to a specific group of persons.

KEYWORDS:

Preservation of evidence; expert opinion Disclosure, confidentiality interests

APPLICANT:

Bekaert Binjiang Steel Cord Co. & Ltd., legally represented by CEP Yu Zhiao, authorised representative, No. 358, East Binjiang Road, Jiangyin City, People's Republic of China

represented by: Lawyer Dr Matthias Hülsewig, Preu Bohlig & Partner
Rechtsanwälte mbB, Couvenstraße 4, 40211 Düsseldorf,
Germany Electronic

delivery address: mhu@preubohlig.de

Contributing: Patent Attorney Wasilis Koukounis, Michalski Hüttermann &
Partner Patentanwälte mbB, Kaistraße 16A, 40221
Düsseldorf, Germany

RESPONDENTS:

1. **Siltronic AG**, legally represented by the Executive Board Klaus Buchwald, Dr Michael Heckmeier and Claudia Schmitt, Einsteinstraße 172, 81677 Munich, Germany

represented by: Solicitor Stratmann, Patent Attorney Dr Vocke, Hoffmann
Eitle Patent- und Rechtsanwälte, Arabellastraße 30, 81925
Munich, Germany

Electronic delivery address: hstratmann@hoffmanneitle.com

2. **Hinterberger GmbH & Co.KG**, represented by Hinterberger Verwaltungs-GmbH, which in turn is represented by its managing directors Bernhard Hinterberger and Herbert Hinterberger, Daimlerstr. 2, 84503 Altötting, Germany

patent at issue:

EUROPEAN PATENT NO. 3 212 356 B1

Panel/Chamber:

Judicial panel of the local division

Düsseldorf PARTICIPATING JUDGES:

This order was issued by Judge Dr Thom as rapporteur.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: Art. 58, 60 UPC Agreement, R. 262A RoP – Disclosure of the expert opinion and protection of confidential information

BRIEF DESCRIPTION OF THE FACTS:

1. The applicant is the sole proprietor of European Patent 3 212 356 B1 (Annex PBP 4; hereinafter referred to as the application patent), which was filed on 23 September 2015, claiming priority from PCT document CN2014/089963 dated 31 October 2014. The grant of the patent applied for was published on 30 January 2019. The initial opt-out was revoked and the revocation was entered into the CMS of the Unified Patent Court on 5 September 2024. The patent application is in force in Germany, Austria and Italy. It has not yet undergone any legal validity proceedings, nor are any such proceedings currently pending.
2. The first respondent manufactures and distributes silicon wafers for the semiconductor industry. It purchases the saw wires required for production from the applicant and from the Sunnywell Group, based in China (hereinafter: Sunnywell).
3. The second respondent is a logistics company that also provides storage space. The premises used by the second respondent include an external warehouse in Altötting. The first respondent uses the storage services of the second respondent to store the saw wires it uses.
4. On 19 September 2024, the applicant filed an application for an order to inspect the premises of the respondents and for an order to preserve evidence in advance of a main action.
5. The Düsseldorf local division then ordered an inspection and preservation of evidence in a procedural order dated 18 October 2024. Among other things, the order contained the following provisions for the protection of confidential information:

"III.

[...]

In the interests of protecting the respondent's trade secrets, which may come to light during the inspection and/or assessment, the expert and his assistant are instructed to maintain confidentiality towards third parties. If the expert engages an external testing laboratory to carry out measurements as part of the preparation of his report, he shall take appropriate measures to comply with his duty of confidentiality.

IV.

[...]

Solicitor Dr Matthias Hülsewig, solicitor Dr Christian Kau, solicitor Dr Axel Oldekop, solicitor Milena Schwerdtfeger and patent attorney Wasilis Koukounis are obliged to maintain confidentiality towards the applicant and its employees with regard to facts that come to their knowledge in the course of executing the entire order and that relate to the business operations of the respondents.

[...]

VII.

The respondents shall be requested to comment on any confidentiality interests they may have after the expert opinion has been submitted by the experts commissioned to carry out this order. The above-mentioned representatives of the applicant, who were allowed to be present during the preservation of evidence and the inspection of the respondents' premises, shall be heard. Only then shall the court decide whether and to what extent the report and the copies and/or printouts of the applicant's documents, records, media and data referred to in section I 2.c) shall be brought to the applicant's personal attention and whether the duty of confidentiality for the applicant's representatives shall be lifted.

6. The inspection and preservation of evidence took place on 11 November 2024. By document dated 10 December 2024, the first respondent filed an application to review this order, which was rejected by the local division in its order of 16 April 2024.
7. The expert submitted his report dated 11 February 2025 to the file.

Applications of the parties:

8. The first respondent requests that
 1. to declare inadmissible the use of the following information and evidence contained in the expert opinion of technical expert Dr. Ing. Johannes Michael Zeiner dated 11 February and the accompanying annexes
 - 1.1 all information relating to claims 2 to 19 of EP 3 212 356 B1;
 - 1.2 all prices that were charged or paid for the saw wires;
 - 1.3 the quantity of saw wires ordered or delivered;
 - 1.4 information on the winding pitch of the saw wire on the longitudinal axis, specified as "Pitch: xx mm";
 - 1.5 details of the metal coating of the saw wire;
 - alternatively,
 2. to restrict access to the information and evidence referred to in paragraph 1 to the following persons:
 - 2.1 two representatives of the applicant who belong to the following group of persons:
 - Lawyer Dr Matthias Hülsewig, Preu Bohlig & Partner Rechtsanwälte mbB, Couvenstraße 4, 40211 Düsseldorf,
 - Lawyer Dr Christian Kau, Preu Bohlig & Partner Rechtsanwälte mbB, Couvenstraße 4, 40211 Düsseldorf,
 - Lawyer Dr Axel Oldekop, Preu Bohlig & Partner Rechtsanwälte

mbB, Leopoldstraße 11a, 80802 Munich,

- Solicitor Milena Schwerdtferger, Preu Bohlig & Partner Rechtsanwälte mbB, Leopoldstraße 11a, 80802 Munich,
- Patent Attorney Wasilis Koukounis, Kaistraße 16A, 40221 Düsseldorf

and

2.2 a representative body, employee or other associate of the applicant.

9. The applicant requests

that the applications of the first respondent in the document of 14 March 2025 be dismissed in their entirety and that the representatives of the applicant be authorised to submit the expert opinion of the permanent expert Dr Johannes Michael Zeiner dated 11 February 2025, together with all attachments and the information and evidence contained therein, to the applicant in full and to be allowed to disclose it.

Factual and legal issues in dispute:

10. The first respondent essentially argues that the local division did not issue any inspection or viewing order with regard to subclaims 2 to 19, so that the expert exceeded his mandate in his expert opinion. The use of these statements is inadmissible and may therefore not be made available to the applicant.
11. Furthermore, the prices that the supplier charges the first respondent and which the first respondent pays for these saw wires are commercial secrets of the first respondent. The products are not traded via intermediaries or trading platforms. The prices are stored in a software system that supports companies in streamlining their central business processes and provides a central data source. Access to this system is only possible via a protected transaction code, which is only given to a small group of people. In addition, disclosure of the prices is irrelevant to the question of infringement. The prices refer to a longer period of time, not just to a specific delivery. The applicant does not need to know the prices in order to assess whether the inspected item infringes the patent at issue. The second respondent is the logistics service provider of the first respondent, whose access to the software system in question is severely restricted. In addition, the two respondents had entered into a confidentiality agreement in this regard, and the employees of the second respondent are bound to secrecy under their employment contracts.
12. The purchase quantity influences the price. As a competitor, the applicant could use this knowledge to its advantage in future sales negotiations with defendant 1.
13. The material composition, in particular the brass coating of the saw wires,

was specially developed by the first respondent as an optimised parameter.

14. Furthermore, the winding pitch is confidential. It has a direct influence on the sawing performance and durability of the sawing wire.
15. Finally, the supplier's bank details stated in the invoices should also be blacked out, as they are not necessary for assessing the infringement or the supply chain.
16. The applicant argues that the subclaims only limit the scope of the technical teaching of the main claim, so that there is no apparent reason to subject these findings to a confidentiality order.
17. The wires are available on the open market, so that the structure of the wires cannot constitute a trade secret of the first respondent. This also applies to the brass coating, which is also standard and common. This is also known from publicly available images.
18. The question of whether trade secrets could be an obstacle must be assessed at the time the expert opinion is issued.
19. Selective quantity information represents a non-meaningful excerpt only about the specific part of the saw wires in stock. Such excerpted information does not disadvantage the first respondent in competition, as no conclusions can be drawn about order volumes.
20. The same applies to the prices, which only refer to a selective range of wires or wire coils. They do not provide an overall picture of the prices. Furthermore, the prices are an unconditional part of the information provided within the framework of Art. 67(1)(b) EPGÜ.
b) UPC Agreement
21. The winding pitch is known in the market and can also be seen from the outside.
22. There is no apparent reason for restricting access to certain persons at the applicant's premises.

LEGAL ASSESSMENT

23. After the respondent in 1), who was affected by the inspection and preservation of evidence, asserted confidentiality interests with regard to the information contained in the expert opinion provided by the expert, the expert opinion is only to be disclosed to the applicant and her legal representatives in a partially redacted version (see UPC_CoA_177/2024, APL_20002/2024, order of 23 July 2024, guiding principles 1 and 2 – Progress Maschinen und Automation v AWM). Furthermore, the applicant and the legal representatives remain bound to secrecy vis-à-vis third parties (with the exception of the potential defendants in the main proceedings) with regard to certain disclosed parts of the expert opinion.

I. Application for a declaration of inadmissibility of use

24. It should first be noted that the application requires interpretation in order to declare the use of certain information and evidence inadmissible.
25. The respondent has apparently based its application on the wording of Art. 58 UPC Agreement. The wording of Art. 58 UPC Agreement must be interpreted in the light of the type of proceedings in question, in this case proceedings for inspection or preservation of evidence.
26. Article 58 UPC Agreement reads as follows:

The court may, in order to protect trade secrets, personal data or other confidential information of a party to the proceedings or a third party, or to prevent the misuse of evidence, issue an order that the collection and use of evidence in proceedings before it be restricted or declared inadmissible, or that access to such evidence be restricted to certain persons.

27. The provision serves to protect trade secrets, personal data or other confidential information of a party or a third party. The provision "in proceedings before it be declared inadmissible" ('the Court may order that[...] in proceedings before it be [...] prohibited') therefore means, at this stage of the proceedings, that certain information or evidence contained in the expert opinion/report shall not be disclosed to the applicant. This can be done by blacking out the relevant parts of the expert opinion/report.
28. In this respect, the first question is whether the information or evidence constitutes trade secrets or contains personal data of third parties or constitutes or contains other confidential information.
29. If this is the case, this information/evidence must be redacted if it is irrelevant to the question of infringement or possible acts of use within the meaning of Article 25 of the UPC Agreement, e.g. because it is not related to the case in any way. If secret or confidential information relates to the question of infringement and/or the scope of acts of use, a decision must be made in each individual case as to whether it should be disclosed to the applicant, but the applicant is obliged to maintain confidentiality vis-à-vis third parties, or whether the applicant's knowledge should be restricted to a specific group of persons.

II. For the present case, this means the following:

1. All prices that have been charged or paid for the saw wires

30. The first respondent has plausibly demonstrated that the prices for the saw wires constitute information that constitutes a trade secret. It is undisputed that the products are not traded via intermediaries or trading platforms, so that they are not known to (direct) competitors. The first respondent only makes this information available to a limited group of people in a software system protected by transaction codes, to which the second respondent also has only limited access. The first respondent has also credibly demonstrated that a confidentiality agreement was concluded between it and the second respondent

. The applicant's reference to the fact that this is merely isolated information from which no overall picture of pricing can be derived is irrelevant. Furthermore, this information is not relevant to the question of infringement. Following a successful main proceeding, the prices may be subject to disclosure measures. At present, however, the applicant does not require this knowledge. In this respect, the price information in the expert opinion/its annexes must be redacted accordingly.

2. Bank details of customers

31. Even if the bank details stated in the invoices may not constitute a trade secret, they are in any case confidential information, the disclosure of which is decided by the suppliers themselves within the framework of their business relationships. Since this information is irrelevant to the question of infringement and the scope of the acts of use, the supplier's bank details stated in the invoices must also be redacted.

3. Quantities of saw wires ordered or delivered

32. The same rules apply to quantity information as to price information. Quantity information must therefore be blacked out.

4. Information on the winding pitch of the saw wire on the longitudinal axis, specified as "Pitch: xx mm", and on the metal coating of the saw wire

33. The information on the brass coating does not constitute confidential information. The coating is a property of the product that is already indicated on the packaging of the saw wires. The expert also points out that this is common practice. In this respect, the written witness statement (Exhibit HE 4) submitted by the first respondent remains vague and general.
34. The same applies to the winding pitch. This information is available for the products in question. The written witness statement (Exhibit HE 4) does not even refer to the winding pitch.
35. With regard to this information, the applicant's expert opinion must be disclosed.

5. Expert's comments on sub-claims

36. The expert's comments on sub-claims 2 to 19 must also be disclosed to the applicant.
37. It is questionable whether the examination of the subclaims (2-14) and the subordinate process claims (15-19) actually exceeds the scope of the expert's reporting obligation. In particular, with regard to subclaims (2-14), the applicant's argument carries some weight that these are only more limited versions of the main claim, which is included in the report assignment as a kind of minus without an explicit application/order. However, this can be left open because the respondent was unable to demonstrate any specific confidentiality interests in this regard.
38. The disclosure of the statements on the subordinate procedural claims also does not give rise to any concerns because they are limited to the fact that it is impossible to determine whether the features are realised

realisation of the features is impossible and the expert is therefore unable to make any statement on this matter.

III. Other orders

39. The setting of the time limit for bringing an action is based on Art. 60(8) UPC Agreement in conjunction with R. 198(1) RoP and R. 199(2) RoP.
40. Pursuant to Rule 196(2) of the Rules of Procedure in conjunction with Rule 199(2) of the Rules of Procedure, an order for inspection and preservation of evidence must, unless the Court orders otherwise, contain a note that the results of these measures may only be used in the relevant proceedings on the merits. This is taken into account in Section V of the present order.

ORDER:

- I. The first respondent is ordered to blacken the expert opinion of Dr. Ing. Johannes Michael Zeiner dated 11 February 2025, together with all annexes, with regard to
- all prices that were charged or paid for the saw wires and
 - the supplier's bank details stated in the invoices
- and to upload it to the CMS within one week of this order being issued.
- II. The redacted expert opinion of Dr. Ing. Johannes Michael Zeiner dated 11 February 2025, together with all attachments, shall be disclosed to the applicant.
- III. The confidentiality order to be found under section IV of the order of 18 October 2024, as amended on 22 October 2024, October 2024, is lifted with regard to the facts contained in the expert opinion of Dr. Ing. Johannes Michael Zeiner dated 11 February 2025, including the annexes, to the extent of the unredacted parts in relation to the applicant.
- IV. The applicant is advised that the measures for inspection and preservation of evidence pursuant to the order of 18 October 2024, as amended on 22 October 2024, will be revoked or otherwise cease to have effect if the applicant does not, within a period of no more than 31 calendar days or 20 working days, whichever is longer, after the applicant's expert opinion has been disclosed, has brought an action against the respondents and/or the third parties named in section X of the order of 18 October 2024, as amended on 22 October 2024. This period shall commence upon the posting of the version of the expert opinion to be posted on the CMS in accordance with Section I.
- V. The expert opinion prepared by the expert and all other results of the inspection and preservation of evidence may only be used in main proceedings against

the respondents and/or the third parties named in section X of the order of 18 October 2024, as amended on 22 October 2024.

Düsseldorf, 19 November 2025 NAMES

AND SIGNATURES

Legally qualified judge Dr Thom	Anna Bérénice Dr.THOM Digitally signed by Anna Bérénice Dr. THOM Date: 19 November 2025 10:52:09 +01'00'
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