

Court: **OLG Karlsruhe 6th Civil Senate**
Decision Date: **04 October 2023**
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Law applied: **Sec. 145a Patent Act, Sec. 16 (1) GeschGehG**

Summary

The admissibility (in particular the need for legal protection) of a request under Sec. 145a Patent Act in conjunction with Sec. § Sec. 16 (1) GeschGehG to classify information introduced into the proceedings as confidential is not precluded by the fact that the parties agree that this information is confidential and have agreed to keep it confidential.

Tenor

1. The information listed in the table below, including the Exhibits listed, is classified:

2. It is pointed out,
 - that the parties, their litigants, witnesses, experts, other representatives and any other persons involved in this litigation or having access to documents of this litigation shall keep confidential the information classified as confidential and shall 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 shall not apply if the court of the main action 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;
 - that in the event of culpable infringement, the court may impose a fine of up to €100,000 or imprisonment for up to six months on the obligor for each infringement and enforce this immediately.

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

Reasons

- 1 The confidentiality requests in the plaintiff's "Appeal Response (Part 2 - FRAND)" dated August 31, 2022, are to be partially granted.

- 2 (1) The decision, insofar as granted, is based on Sec. 145a Patent Act in conjunction with Sec. § Sec. 16 (1), Sec. 20 (5), first and second sentences in conjunction with Sec. 16 (2) and Sec. 17, 18 GeschGehG. § Sec. 16 (2) and Secs. 17, 18

GeschGehG. In this respect, it corresponds in content to the admissible and justified requests for secrecy under 1. and 3. in the plaintiff's "Response to Appeal (Part 2 - FRAND)" of August 31, 2022, with adaptation to the wording of the law ("hinweisen" instead of "belehren", "vertraulich" instead of "streng vertraulich").

- 3 a) The fact that the parties in any case agree that the contents of their license negotiations must be kept secret and have agreed to keep them secret does not prevent the admissibility of the request. The deviating opinion of the District Court Mannheim (GRUR-RR 2023, 285 et seq.; rejecting Hoppe, GRUR-RR 2023, 288; Drescher/Dilbaz, GRUR-Prax 2023, 407; Oldekop, GRUR Patent 2023, 130, 131; aA also evidently Kühnen, Handbuch der Patentverletzung, 15th ed., Chap. D para. 147 et seq.) contradicts the established practice of the Senate and is not shared by the Senate.
- 4 The need for legal protection cannot be denied, if only because the requested classification as a trade secret pursuant to Sec. 16 (1) GeschGehG has the consequence, among other things, that all persons involved in the dispute or having access to its documents are subject to the obligation to treat the information classified as secret confidentially, which is punishable by an order (Sec. 16 (2), Sec. 17 GeschGehG). 2, § 17 GeschGehG) and, in addition, third parties who have a right to inspect files may only be provided with file contents in which the statements containing business secrets have been made unrecognizable (§ 16 para. 3 GeschGehG; mandatory and in this respect beyond the requirement to take account of secrecy interests to be derived abstractly from § 299 para. 2 Code of Civil Procedure (ZPO); see Alexander in Köhler/Bomkamm/Feddersen, UWG, 41st ed, GeschGehG § 16 para. 36; Kühnen, *loc.cit.* para. 187). Contrary to the view of the District Court Mannheim (*loc. cit.*), these are not mere legal reflexes of the protection granted by law to the owner of the secret, which are not supported by a legitimate interest of the claimant. Irrespective of whether the law has "primarily" in mind the danger of disclosure by the opposing party, it is in any case (also) one of the legal consequences intended by the unambiguous statutory provision that the owner of the secret can achieve, by means of a classification to be applied for by him, that the danger of disclosure by other persons is reduced in the manner provided for in § 16 (2), (3), §§ 17, 18 GeschGehG. According to the explanatory memorandum to the Act, the comprehensive group of persons affected by the obligation to maintain secrecy is expressly intended to extend the protection of holders 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, unlike the decision under the Business Secrets Act, it is not possible, for example, to ensure that the board of the court, when deciding in the future on a request for inspection of files after the conclusion of the proceedings, will like. § Section 299 (2) of the Code of Civil Procedure (ZPO) is bound by the judicial classification of certain information as requiring secrecy, i.e. this classification - in the words of the explanatory memorandum to the Act - "filters through" to 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 in question here with regard to third parties pursuant to Sec. 16 (2), (3), Secs. 17, 18 GeschGehG are dispensable in view of a level of protection that can already be derived from other laws would inadmissibly disregard the will of the legislature expressed in the aforementioned provisions. In particular, a different assessment cannot be based on the fact that Section 20 (2) GeschGehG provides for a hearing only of the other party.
- 5 b) The substantive requirements under Sec. 145a Patent Law in conjunction with Sec. § Sec. 16 (1) GeschGehG are met. The information introduced into the proceedings by the plaintiff, the classification of which is requested, may constitute a trade secret within the meaning of these provisions.
- 6 c) From the wording of Section 16 (1) GeschGehG ("may") it is deduced that the decision on the classification lies within the discretion of the court (cf. only Düsseldorf Higher Regional Court, GRUR-RR 2023, 110, 111; Alexander in Köhler/Bomkamm/Feddersen, UWG, 41st ed., GeschGehG Section 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, in each case mwN). In the case in dispute, the requested (mere) classification as confidential (Sec. 16 (1) GeschGehG) is in any case required at the discretion of the Senate because it also protects the plaintiff from disclosure of the information by parties other than those already bound by the confidentiality agreement and to third parties (see above). Whether the content of a confidentiality agreement of the parties can speak against further access restrictions pursuant to Section 19 (1) GeschGehG (so Düsseldorf Higher Regional Court, GRUR-RR 2023, 110, 111 f) can be left open.

- 7 d) There was no need for the defendant to be requested to make a statement. In any case, according to the discretion of the Senate and its constant practice with regard to its power to annul and amend (Sec. 20 (2) Sentence 2 GeschGehG), it would be sufficient if the defendant will have the opportunity to comment after the present order of the measure (Sec. 20 (2) Sentence 1 GeschGehG). This is sufficient, especially since the parties are in any case in agreement that the contents of their license negotiations must be kept secret (exclusively) from third parties and have agreed to maintain secrecy. Apart from this, the defendant has had sufficient opportunity to comment on the requests submitted to it.
- 8 The request for confidentiality No. 2 in the same writ is unfounded. There is no statutory basis for the court order to treat the information subject to secrecy as confidential. The obligation to treat the information confidentially is a mandatory legal consequence pursuant to Section 16 (2) GeschGehG, to which the court is merely required to refer pursuant to Section 20 (5) sentence 2 GeschGehG.
- 9 3. There are no grounds for allowing the appeal under Section 574 (1) No. 2, (2), (3) Code of Civil Procedure (ZPO).