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Barcelona Courts approve Trade Secrets Protocol that may indirectly impact patent cases

Miquel Montaña (Clifford Chance) · Thursday, January 16th, 2020

Barcelona Commercial Courts have a well-deserved reputation for being dynamic and creative. Not surprisingly, it was Judge Ferrándiz, already retired from the Supreme Court, who back in 1993, when he was sitting at Section 15 of the Court of Appeal of Barcelona, had the idea of specializing that Section on a small number of commercial matters, including intellectual property matters. This was the seed of the specialization introduced across the country on 1 September 2004, the date when Commercial Courts, which have exclusive jurisdiction for patent matters, came into force. These little changes resulted in a modernization of the patent enforcement system that was further enhanced by the coming into force of the new Patents Act on 1 April 2017. Since then, the standards of patent litigation in Spain are approaching the benchmark set by the most experienced European patent courts.

Among the practical measures introduced by the Commercial Judges in Barcelona during the last few years, the Mobile World Congress Protocol, discussed in other blogs, stands out. Over Christmas, a few months after the coming into force of the 2019 Trade Secrets Act, they circulated a new Protocol that deals with trade secrets. The main aspects that may have a bearing on the way patent cases are conducted are summarized below:

- Courts will be able to adopt confidentiality measures either on their own motion, at the request of a party to the proceedings or even at the request of a third party ordered to disclose documents containing sensitive information.
- Prior to ordering any confidentiality measures, the Court will hear all parties involved, either in writing or at an ad hoc hearing. When necessary, the Court will order interim measures in order to provisionally guarantee confidentiality before making a final decision on the confidentiality safeguards.
- Spanish judges do not have a technical background. Therefore, they usually rely on expert opinions. In this case, experts may assist the Court in identifying the specific pieces of information affected by the confidentiality measures.
- The Protocol on Trade Secrets lists a “menu” of confidentiality measures; among others, it establishes the possibility of keeping sensitive documents under lock and key at the Court clerk’s office, of uploading those documents onto virtual data rooms (which need to be provided by the parties, since the Spanish judiciary lacks such tools) and, lastly, of establishing confidentiality clubs and publishing redacted versions of the judgments.
- Regarding confidentiality clubs, the Protocol allows for two different clubs to be implemented: a “central” club for the most sensitive information (which could be even limited to external

counsel, i.e. with exclusion of the party itself and its in-house counsel) and a second, wider group (which could also include in-house counsel, experts and some individuals from each party). Each club's member will be identified and must sign an NDA.

- The parties requesting confidentiality measures will need to sufficiently justify their petition. Recent precedents in patent proceedings show that the Spanish courts apply a flexible approach.

All in all, this new Protocol on Trade Secrets will introduce a level playing field that, hopefully, will result in a swifter application of the new Trade Secrets Act, which already provides a solid framework for both the protection of trade secrets and know-how as well as the safeguarding of confidentiality in patent proceedings and, more generally, in commercial litigation.

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