

# Kluwer Patent Blog

## No in-house access to the PPD? No way!

William White (Bristows LLP) and Naomi Hazenberg (Bristows) · Monday, March 21st, 2022

## Meade J reaffirms the UK Courts' approach to disclosure of confidential information

How far should the Court go to protect a party's confidential information during disclosure? In a recent decision ([2022] EWHC 490 (Pat)) in two related patent infringement actions between Siemens Gamesa Renewable Energy ("SGRE") and General Electric ("GE"), Meade J confirmed that there are limits to the restrictions that the Court will impose, and that the UK Courts retain their own distinct approach to this question.

The hearing related to the confidentiality terms that were to apply to the Product or Process Description ("PPD") to be served by GE for use in the litigation. Although GE's PPD had not yet been drafted, SGRE made an early application to establish the applicable confidentiality regime and avoid any hold-up to the proceedings at a later date. The Judge endorsed this approach, stating that *"it is obvious that there is a major disagreement about the confidentiality club and leaving the argument until the PPD was served would have been impracticable and likely to cause delay."*

While this article will walk readers through the specific points in dispute, the takeaway message is that, although the balancing interests of the parties will be considered, in UK litigation it is still exceptionally rare (if not impossible) for important material to be withheld from all officers or employees of the receiving party.

## GE's proposed regime

GE sought a highly stringent regime owing, it said, to the nature of the wind turbine industry. In particular it argued:

- a) That there should be only one in-house member of confidentiality club (the "**Club**") rather than two;
- b) That any in-house member of the Club should not work in the field of wind turbines;
- c) That any in-house member of the Club should be subject to a "**Commercial Bar**", meaning that for a period they would be prevented from participating in wind turbine tenders; and
- d) That all members of the Club should also be subject to a "**Prosecution Bar**", meaning that for a period they would be prevented from prosecuting patents in the field of wind turbines.

Failing these provisions being put in place, GE argued that only an External Eyes Only (“**EEO**”) tier of confidentiality (which would be applicable to the whole PPD) would be sufficient to protect its confidential information.

## **The Court’s approach to confidentiality**

Meade J began his analysis with a reminder of the key principles identified by the Court of Appeal in *OnePlus v Mitsubishi* ([2020] EWCA 1562). The overriding requirement is to balance the competing interests of the parties (and those of third parties), taking into account the role of the documents in question in the litigation and the structure and organisation of the receiving party. Only exceptionally rarely, if ever, will the Court order a confidentiality regime that would prevent at least one employee of the receiving party from gaining access to important documents for trial.

### **a) Members of the confidentiality Club**

SGRE proposed that two of its employees should be admitted to the Club, both of whom worked in its Intellectual Property department. The Judge dealt with this point shortly – it was safer to start with just one and increase it if necessary than to possibly have to rectify the situation if access by two people imposed a difficulty.

### **b) Field of work restriction**

Referring again to *OnePlus*, the Judge noted that the PPD was likely to be a critical document in the case. This meant that SGRE had a great interest in understanding it, and therefore the balance of interests fell in favour of allowing access by an employee who was sufficiently conversant with the relevant technology. For SGRE to find such a person who did not work in the field of wind turbines would have required a significant rearrangement of its business that was not justified by the level of confidentiality of the information in question. Furthermore, the SGRE employee who would be admitted to the Club would have an important contribution to make including instructing legal representatives and reporting back to management on the prospects of success. It therefore followed that one in-house representative should be permitted access notwithstanding their field of expertise, and GE’s field of work restriction was rejected.

### **c) The Commercial Bar**

GE argued that while deals in the wind energy sector involve large amounts of money, there are relatively few market participants and “*every player in the field is bidding for every tender*”. Erring on the side of caution, the Judge felt that it was a minor imposition to impose on the in-house member of the Club to restrict their participation in tendering work.

### **d) The Prosecution Bar**

On this point, GE referred to numerous parallel proceedings and, in particular, to the prosecution bar included in the protective order governing the disclosure of documents from a 1782 application in the District Court of Massachusetts which was applicable to GE’s representatives. The Judge did not find much assistance from these foreign proceedings, on the basis that they were decided under different case law, in a different procedural context and in a different litigation culture. Even other cases where prosecution bars had been agreed in UK litigation were not useful to consider, at least without understanding the context. The main consideration was that a prosecution bar is not a normal step to take in UK litigation, especially in a “relatively generic” case such as this. Meade J

was keen not to set a precedent which would make prosecution bars more common in the UK.

## External Eyes Only

As to GE's alternative proposal that the whole PPD should be designated EEO: the Judge doubted whether this could be appropriate in the circumstances. Whilst the PPD was not yet drafted, it was likely that much of the final document would not be confidential at all. The onus was on GE to justify the need for an EEO designation and the Judge found it significant that it had failed to provide any real tangible detail to justify such strict protection. Absent such detail, Meade J held that correct approach was to assume that the information would be ordinary confidential information rather than the "Crown jewels". With that and *OnePlus* in mind, there would be no EEO tier of confidentiality.

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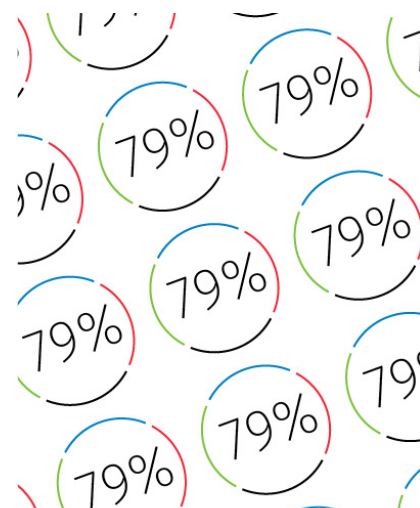
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