

Neutral Citation Number: **[2022] EWHC 490 (Pat)**

IN THE HIGH COURT OF JUSTICE

**BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES**

**INTELLECTUAL PROPERTY LIST (ChD)**

**PATENTS COURT**

The Rolls Building

7 Rolls Buildings

Fetter Lane

London EC4A 1NL

Date: Friday, 25th February 2022

**Before**:

**MR. JUSTICE MEADE**

**Remotely via Microsoft Teams**

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**Between:**

Claim No: HP-2020-000051

|  |  |  |
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|  | **GENERAL ELECTRIC COMPANY**  **(a company incorporated under the laws of the State of New York, United States of America)** | Claimant |
|  | **- and -** |  |
|  | **SIEMENS GAMESA RENEWABLE ENERGY LIMITED** | Defendant  (the “GE Action”) |

**And between:**

Claim No HP-2021-0000011

|  |  |  |
| --- | --- | --- |
|  | **SIEMENS GAMESA RENEWABLE ENERGY A/S**  **(a company incorporated under the laws of the Kingdom of Denmark)** | Claimant |
|  | **- and -** |  |
|  | **(1) GE ENERGY (UK) LIMITED**  **(2) GE WIND FRANCE SAS**  **(a company incorporated under the laws of the French Republic)**  **(3) GENERAL ELECTRIC COMPANY**  **(a company incorporated under the laws of the State of New York, United States of America)** | Defendants  (the “SGRE Action”) |

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**DR. STUART BARAN** and **ALICE HART** (instructed by **Hogan Lovells International LLP**) appeared for the **Claimants**

**MR. JAMES WHYTE** (instructed by **Bristows LLP**) appeared for the **Defendants**

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APPROVED JUDGMENT

**MR. JUSTICE MEADE:**

1. I have to deal with an application concerning the confidentiality regime in relation to the forthcoming PPD in these proceedings which concern wind farms. The parties are agreed that the principles that I should apply can be identified from the decision of the Court of Appeal in *OnePlus v Mitsubishi* [2020] EWCA 1562 and, in particular, I was referred to paragraphs 25 and 26, where Lord Dyson’s dicta in *Al-Rawi* are set out, and to the drawing together by Floyd LJ of a non-exhaustive list of points of importance at paragraph 39:

“39. Drawing all this together, I would identify the following non-exhaustive list of points of importance from the authorities:

* 1. In managing the disclosure of highly confidential information in intellectual property litigation, the court must balance the interests of the receiving party in having the fullest possible access to relevant documents against the interests of the disclosing party, or third parties, in the preservation of their confidential commercial and technical information: *Warner Lambert* at page 356; *Roussel* at page 49.
  2. An arrangement under which an officer or employee of the receiving party gains no access at all to documents of importance at trial will be exceptionally rare, if indeed it can happen at all: *Warner Lambert* at page 360: *Al Rawi* at [64]. Judgment Approved by the court for handing down. *OnePlus and others v Mitsubishi and others*
  3. There is no universal form of order suitable for use in every case, or even at every stage of the same case: *Warner Lambert* at page 358; *Al-Rawi* at [64]; *IPCom* *1* at [31(ii)].
  4. The court must be alert to the fact that restricting disclosure to external eyes only at any stage is exceptional: *Roussel* at [49]; *Infederation* at [42].
  5. If an external eyes only tier is created for initial disclosure, the court should remember that the onus remains on the disclosing party throughout to justify that designation for the documents so designated: *TQ Delta* at [21] and [23];
  6. Different types of information may require different degrees of protection, according to their value and potential for misuse. The protection to be afforded to a secret process may be greater than the protection to be afforded to commercial licences where the potential for misuse is less obvious: compare *Warner Lambert* and *IPCom 1*; see IPCom 2 at [47].
  7. Difficulties of policing misuse are also relevant: *Warner Lambert* at 360; *Roussel* at pages 51-2.
  8. The extent to which a party may be expected to contribute to the case based on a document is relevant: *Warner Lambert* at page 360.
  9. The role which the documents will play in the action is also a material consideration: *Roussel* at page 49; *IPCom 1* at [31(ii)];
  10. The structure and organisation of the receiving party is a factor which feeds into the way the confidential information has to be handled: IPCom 1 at [33].”

1. Of particular importance to the application today, to my mind, are that what I must do is balance competing interests (point (i)); that an arrangement where an officer or employee of the receiving party gains no access to documents of importance would be exceptionally rare if it can happen at all (point (ii)); that an EEO external eyes only provision is extremely rare and exceptional (point (iv)); that if there is an EEO for initial disclosure, which I interpret as meaning at an early stage, the court should remember that the onus remains on the disclosing party throughout to justify it (point (v)), which, to my mind, indicates the need for ongoing review of any such provision; that the extent to which a party can be expected to contribute is relevant ((point viii)), that the role of the documents is material ((point ix)); and that the structure and organisation of the receiving party is a factor which feeds into the way the confidential information is to be handled (point (x)).
2. The persons to whom provision of the PPD is sought by SGRE, that is Mr. Whyte’s clients, are Mr. Plett and Mr. Aspacher, whose function within the company are described by Mr. Bowler in his two witness statements on their behalf. They are both patent attorneys and they work in the IP department and also on patent prosecution, and other matters to which I will come.
3. The PPD has not been drafted at the moment. If drafting has begun, I infer that it is at a very early stage, and I am dealing with this matter on the basis that it will be provided in the next few weeks probably in April. I therefore have to be careful to bear in mind that I do not know at the moment how much of the material in it will be confidential and how much will not, and I do not know the appropriate level of confidentiality.
4. This application has been brought on by SGRE because they want to make sure that there is no hold up to the proceedings if the discussion about the confidentiality club only begins once the PPD is served, and I endorse that approach by them. 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.
5. The basic pattern of the dispute is as follows, as explained by Dr. Baran who appears today for GE. GE’s contention is that there may need to be an EEO tier of confidentiality, but only if it fails in securing a number of restrictions of a still stringent but of a somewhat lesser kind for which it contends.
6. The points of dispute over the nature of the club are as follows. First of all, should there be one or two people in that club. Second, should the people in that club be restricted as to the field in which they work and in particular should SGRE be compelled to put forward somebody who does not work on wind turbines, but only on a related field. Third, there is what is called a commercial bar, which for practical purposes means whether the people in the confidentiality club should be allowed to participate in tenders for making sales of this kind of product. And fourthly, whether there should be what is called a prosecution bar, i.e., should the members of the club be restricted from prosecuting patents in this field.
7. As I say, Dr. Baran’s position is that if those provisions are put in place, then EEO protection is not necessary, but if they are not, then it is.
8. Dr. Baran emphasises the following aspects of this industry. He emphasises that it is a small industry. He emphasises that the amounts of money are large. And he emphasises that in practical terms every player in the field is bidding for every tender. He submits this makes it especially important that there should be protection against misuse of confidential information. He makes it clear, after some discussion through the evidence and before me in oral submissions today, that it is not GE’s case that there will be any deliberate misuse or that there is a risk of deliberate misuse. What I am considering, as so often in these cases, is the risk of accidental misuse.
9. I have said already that the PPD has not been prepared yet. I make no criticism of that, because the time for its provision has not yet rolled around. But Dr. Baran makes clear that if necessary, and if I do have to impose an EEO protection, if I am persuaded to do that, then GE’s intention is to designate the whole of the PPD as confidential to that level initially.
10. I find that regrettable. It is obvious to me that in this case there will be large amounts of information about GE’s products that are not confidential at all, and while Dr. Baran is right to submit that it is easier to remove confidentiality restrictions than to increase them once they have been put in place, I have to say that I think that aspect of GE’s position indicates a general sense of over-engineering the confidentiality to which they refer.
11. I take Dr. Baran’s points that there are some slightly unusual facets of this industry; in particular his point that every player is bidding for every tender is a little bit unusual. But there is not much to that, in my view, and, in substance, I think what I am dealing with here is a fairly generic situation where the two parties to patent litigation are competitors and information about one party’s product enjoys some degree of technical or commercial confidentiality.
12. Although the PPD has not been drafted yet, I do not think that need have stood in the way of GE putting forward real tangible details which I could have assessed about whether there really was something of the very highest importance that was likely to go into the PPD and which justified an EEO level of protection. I think it is significant that they have not done that. I think I should proceed on the basis that I am dealing with a situation of the not uncommon kind where facets of the disclosing party’s products are unknown to the receiving party, but not as it were the Crown jewels.
13. I have mentioned briefly so far the two gentlemen who are put forward to receive the information. That is Mr. Plett and Mr. Aspacher.
14. There is a complicated background to the dispute before me because there are a number of other proceedings between the parties in other jurisdictions. There are multiple proceedings in the United States. There are proceedings in Germany, in Spain, and in France. The US proceedings include ITC proceedings, proceedings in the District Court in Massachusetts and applications for 1782 orders as well.
15. It was particularly stressed by Dr. Baran before me today that in the 1782 proceedings, at the request of SGRE, a prosecution bar was imposed on and accepted by representatives of GE, including Mr. Bennett, a partner in Hogan Lovells.
16. I do not think that I can get much assistance from the foreign proceedings. They arise under different case law, they arise in a different procedural context and they arise in a different, if I can put it this way, litigation culture, where it may be more common, for example in the United States, for companies involved in litigation to engage two quite separate firms of advisers, some of whom are subject to a prosecution bar and some of whom are not.
17. That is not a common approach in the United Kingdom at the moment. No doubt there are cases where prosecution bars have been agreed between parties. Indeed, Dr. Baran referred me to one that he was aware of. I do not get much out of that either. For all I know, in that case, it was easy to agree a prosecution bar because the party sought to be restricted by it just did not object. I do not know.
18. In any case, I do not think that a prosecution bar is, in any sense, a normal step to take in the UK, and I do not think it is the default position, certainly, and because the situation before me is a relatively generic one, as I have said already, I would be concerned that if I acceded to that part of GE’s submission in particular, it would be a step on the road to making prosecution bars more common or even very common in the UK, and that would require a good deal of thought before it should happen.
19. Against that background, I will deal with the four types of restriction that have been discussed. First of all, should there be one or two people? It is much safer, in my view, to start with one and increase it to two, if necessary, than to start with two and find that it imposes a difficulty. I found SGRE’s explanation as to why they needed two people unconvincing. I will start with one person and I will leave it to SGRE to choose who that should be.
20. In a sense, the decision between one and two is the easy one because the greater question that arises out of the other restrictions, i.e., field of work and commercial bar and prosecution bar, are more fundamental ones.
21. On that front, I think that the following matters are important in terms of the points made by Floyd LJ in *OnePlus* that I referred to earlier. It is unknown what will be in the PPDs, but it would be surprising if they did not turn out to be critical documents in the case, and SGRE, therefore, has a very high interest in understanding them. That is a major factor in SGRE’s favour in relation to points (i) and (ix) of paragraph 39 of *OnePlus*.
22. Secondly, an arrangement under which an officer of the receiving party never gains access will be exceptionally rare, if it can happen at all. I have referred to that already by reference to point (ii) in *OnePlus*. In my view, there is nothing in this case to get anywhere near to that level. This is a fairly normal sort of case where I am satisfied given that there is no allegation of any risk of deliberate misuse, that whichever gentleman it is, Mr. Plett or Mr. Aspacher, he is an experienced and professional person with professional obligations who will seek to honour them.
23. Point (iv) is for practical purposes very similar and is whether this is an exceptional case. I have just said it is not. Point (v), under which I could make it the regime EEO subject to review later, does not arise because I have not reached a conclusion that external eyes only is appropriate.
24. If I consider the extent to which a party may be expected to contribute to the case (point (viii)), I think it is obvious that Mr. Plett or Mr. Aspacher, as the case may be, will have an important contribution to make, both in terms of giving instructions to Bristows for SGRE, and indeed, in reporting back to their management what they think the prospects of success or failure in the case are.
25. I have already dealt with point (ix), these are important documents in the case and bound to be referred to extensively at trial.
26. Point (x), I think, bears a little more scrutiny, which is the structure and organisation of the receiving party. Based on the evidence of Mr. Bowler, and bearing in mind the attacks and criticisms on and of it made by Ms. Fulton in her evidence, I am satisfied that for entirely genuine and longstanding reasons, SGRE is organised in a way such that it has an IP department which handles this kind of litigation for the company, and who handle patent prosecution, and provide a modest amount of input on commercial matters.
27. There has been some discussion about exactly who was or was not put forward at different stages to be in the club which the French court is considering setting up. I did not feel that that took the dispute before me forward very much at all. But, in my view, the field of work restriction, i.e., finding somebody who does not work in wind turbines to fulfil the function intended for Mr. Plett or Mr. Aspacher, and the prosecution bar, would require a significant, possibly entirely impractical, rearrangement of SGRE’s business which is not justified by the level of confidentiality that has been suggested in GE’s evidence.
28. All of those factors, I think militate, against a restriction. I am unsatisfied that there should be a field of work restriction or a prosecution bar.
29. That leaves the commercial bar, which, as I have said already, is essentially a restriction on either Mr. Plett or Mr. Aspacher, as the case may be, participating in tendering work.
30. The position about this, I have to say, is somewhat unclear, and some of the information about it was only put to me on instructions by Mr. Whyte during the course of the hearing. I make no criticism about that, but bearing in mind that it is always easier to reduce restrictions rather than increase them, and given that only one out of Mr. Plett and Mr. Aspacher is to be allowed into the confidentiality club, I think it is a very minor imposition on that gentleman (which can be reviewed if it turns out to be a problem) that he should not take part in tender processes for the duration suggested by GE.
31. So, with that minor point and with the limitation to one person, I am broadly in favour of SGRE’s position and there will be, for reasons I have given already, no EEO tier of confidentiality.

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