



Order
of the Court of First Instance of the Unified Patent Court
issued on 22 January 2025
concerning EP 3 511 174

CLAIMANT:

FUJIFILM Corporation, 26-30, Nishiazabu 2-chome, Minato-ku, Tokyo 106-8620, Japan,

represented by: Tobias Hahn, HOYNG ROKH MONEGIER, Steinstraße 20,
40212 Düsseldorf, Germany

electronic address for service: tobias.hahn@hoyngrokh.com

DEFENDANTS:

1. Kodak GmbH, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs, at the same place,

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer
Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz 1,
40545 Düsseldorf, Germany

electronic address for service: elena.hennecke@freshfields.com

2. Kodak Graphic Communications GmbH, Kesselstraße 19, 70327 Stuttgart, represented by
its CEOs, at the same place,

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer
Rechtsanwälte Steuerberater PartG mbB, Maximiliansplatz
13, 80333 Munich, Germany

electronic address for service: elena.hennecke@freshfields.com

3. Kodak Holding GmbH, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs, at the
same place,

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer
Rechtsanwälte Steuerberater PartG mbB, Maximiliansplatz
13, 80333 Munich, Germany

electronic address for service: elena.hennecke@freshfields.com

PATENT AT ISSUE:

European patent EP 3 511 174

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This order was issued by the presiding judge and judge-rapporteur Prof. Dr. Tochtermann.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement action – preparation of oral hearing

In order to ensure an efficient exchange in the course of the oral hearing, the following preliminary views and questions are submitted taking into account that the file extends to more than 4000 pages in total and approximately 800 pages of main submissions. Therefore the following points shall be highlighted. This is not to limit the right of the parties to address further points in the course of the oral hearing which they wish to discuss. Furthermore it is to be pointed out that the following views and questions are preliminary in nature and open to further discussion in the oral hearing.

I. Operative part of the SoC/Remedies sought

1. Permanent injunction also for UK

No final decision has been delivered in Case C-339/22 (BSH Hausgeräte) by the ECJ to date. In case no such guidance is available concerning a fundamental question of European Law until the oral hearing takes place, the panel is inclined to deal with the questions concerned in a separate proceeding after the separation of cases and stay such separate proceeding until a decision has been delivered by the ECJ.

2. Main request A I. – III. vs subsidiary request B I. – III.

The panel understands the main request A I.- III. to be oriented at the wording of patent claims 1 and 15, whereas subsidiary request B. I. – III. explicitly refers to the attacked embodiments “SONORA X and/or SONORAS XTRA-2 and or SONORA XTRA-3”. As B is submitted as a subsidiary request, the panel may not have to deal with the details of infringement of all attacked embodiments one by one under the main request as it may suffice to establish infringement by one embodiment only. As the parties however elaborate at length upon infringement by SONORA XTRA-3 precursor plates, Claimant will have to clarify, if its main request still aims at an infringement analysis for each attacked embodiments of the defendants.

3. Request C.I., II.; IV: Damages/Compensation

The parties discuss which law is to be applied to infringing acts which occurred prior to 1 June 2023. They submit that apparently at least embodiments SONORA X “is not available on the market anymore as it is no longer marketed and distributed” (SoC para 105) whereas the opposite appears to be true for SONORA XTRA-2 and -3. Accordingly, any alleged acts of infringement concerning SONORA X precursors deem to relate to a period, which exclusively resides before the entry into force of the UPCA (1 June 2023). Therefore, the question will have to be discussed in the oral hearing, if national law or the UPCA applies to such acts of infringement.

The question of a possible retroactive effect of the UPCA in the light of Art 28 Vienna Convention on the Law of Treaties (VCLT) will have to be discussed, in particular if the UPCA’s substantive provisions are also applicable to acts where commitment has begun before the entry into force of the UPCA but are ongoing (see the discussion in Tilmann/Plassmann, Einheitspatentgericht/Einheitliches Patentgericht Art 89 EPGÜ 27 et seqq and 37). Is there a sufficiently clear intention in the sense of Art 28 VCLT for any retroactive effect of the UPCA upon acts which took place before the entry into force of the UPCA? In the view of the JR it may be preferable to clearly differentiate questions of judicial competence and of applicable law.

Even for infringing acts being committed after 1 June 2023 it should be discussed, if national law applies to the bundle patent in question or the UPCA (see McGuire GRUR Patent 2024, 466) or if the UPCA applies, still allowing a party to point to deviating national rules of material law in case the application of the UPCA would lead to diverging and disadvantageous results compared to such national law.

In this context it will also have to be discussed, if a claimant has to put forward substantiated facts for all countries, for which he seeks remedies or if substantiation for one country alone is sufficient or is at least sufficient, if accompanied by an allegation that the same is true for the whole European market as it may be the case here by Claimant’s reference to defendants’ press release Exhibit K 40 (“can offer customers reliable supplies - not only in Germany and neighboring countries, but throughout Europe”). Is it then upon the defendants to sufficiently contest such acts in further jurisdictions?

In case of applicability of national laws for the different territories for which remedies are sought: Does the court have to be familiar with all laws of the CMS of the UPC or is there an obligation of the party concerned to set out the rules of such law? How about the law which applies to NON-UPC-CMS?

4. Clarification of countries for which remedies are sought

Under C.I, II. (?), III., IV. (?) the claimant seeks damages /compensation “by infringing acts of EP 3 511 174 in any country where and while it has been and/or is still in force since July 17th, 2019 – for Germany since May 15th 2021”.

The panel is of the opinion that it is upon the claimant to clarify the countries for which compensation and/or damages are sought. As it remains unclear for which countries the remedies are sought and if Claimant will have to elaborate further on applicable national laws (at least of NON-UPC-CMS) the respective questions may have to be addressed in a separated proceeding.

5. Request C. III. – Information

It will have to be discussed, if an order to provide information as requested will have to be limited to certain time periods with regard to possible restrictions under national law (which may be applicable or not, see supra) or if Art. 67 UPCA may serve as a basis for such information being sought so as to determine, if infringing acts are concerned, which were completely limited to periods before the entry into force of the UPCA or which extend to points of time after the entry into force so as to allow for a proper calculation of damages under the national law regime or the UPCA substantive regulations in a subsequent proceeding on damages according to R. 125 et seqq. RoP. Therefore it will have to be discussed, if the panel will have to clarify the relevant time periods (according to UPCA or national law) in the main proceeding “up front” or if such questions may be adequately dealt with in possible subsequent damages proceedings.

II. Value of the dispute

The value of the dispute indicated by Claimant (5 Mio €) appears to be largely underestimated in the light of prayer C. IV. alone (10 Mio € interim award on damages occurred with regard to the patent in suit). Therefore the value of the dispute is being set to at least 15 Million € on a preliminary basis.

III. Priority of the patent/prior use right alleged by defendants

- The priority of the patent in suit is only addressed in the context of the prior use rights brought forward by the defendants. Claimant does not counter the attack of the defendants. However, the line of arguments put forward by the defendants appears to be insufficient to challenge the priority, as the defendants limit their argument to the patent claims of JP 837 and do not elaborate at all on the disclosure of the document as a whole. This appears not to be sufficiently substantiated to put the priority of the patent in suit into question. In consequence all factual allegations of the defendants which concern points of time after the relevant priority date of the patent may on a preliminary basis appear to be of limited importance. The parties are consequently invited to focus on the acquisition of such alleged prior use right and its exercise before the relevant priority date.
- Insofar as a prior use right is referred to for the UK: Is it necessary to establish sufficient facts that such prior use has been established within the boundaries of the UK territory?

IV. Counterclaim for revocation

1. Public prior use

The same priority date will be decisive as mentioned supra at III. Parties may be invited to discuss the alleged confidentiality provisions contained in agreements concerning alleged deliveries.

2. Novelty in the light WO 379

The parties mutually accept that the document is relevant with regard to novelty only before the background of Art 54(3) EPC.

- It will have to be addressed, if the reworking of Example 7 by one of the inventors of WO 379 who knows about the process conditions at the time, can serve as a solid basis for determining the disclosure of the cited document to the average person skilled in the art.
- Does WO 379 disclose all relevant process conditions to the skilled person so that it is possible to rework the examples and arrive at predetermined constant results of the process?
- Are the parameters of the micropores according to features 1.5 and 1.7' expressly disclosed? Within the ratio of feature 1.7'? Is the "standard deviation argument" put forward by defendants acceptable, i.e. that 56% is well within the respective range?

3. Novelty in the light of EP 452

- Is it sufficient – for the sake of argument – that a document discloses certain geometric properties in certain examples or is it necessary that they are disclosed – in the eyes of a skilled person – as part of a coherent technical teaching?
- Is it permissible to combine separate items disclosed in different parts of the document – examples and general description - to one technical teaching? Or only if the document provides pointers so as to make such a combination within the disclosure?
- Does EP 452 clearly and unambiguously disclose the ratio of feature 1.7'? Is such a ratio – and in particular that such ratio is of technical relevance – disclosed, if defendants point to selected Examples in the Tables? What is the express disclosure of the Tables?
- Is it permissible to refer to three out of thirty examples (here Examples 3, 11 and 12) to establish such disclosure or does this approach amount to impermissible hindsight?
- Is a maximum diameter of large-diameter pores being disclosed or not as EP 452 shows different shapes of the pores (inversely tapered vs bottle-like shape)? Or do the geometric parameters only disclose certain properties at the "level of communication" between large-diameter and small-diameter parts of the pores which are not understood by the skilled person as the maximum diameter of the large-diameter pore?
- How is feature 1.9 of the patent in suit to be construed? How is its relation to DOP processing and printing?
- Is there a disclosure for a color switching agent triggered by an acid?
- As to the "first configuration" of EP 452: Is there a specific reference to acid color formers or rather to a broad list of print-out agents only comprising color formers based on radical reactions and others being based on acid reactions in JP 434? Does [0215] contain a sufficiently specific reference to JP 434 at all?
- As to the "second configuration" of EP 452: Is it sufficient that colorants are listed in [0224] and that they may have the properties to act as color switch systems under certain conditions?

4. Inventive step over EP 452/EP968

In addition to point 3 supra:

- What is the focus of EP 452 with respect to on-press development? Is there a difference for the first and the second configuration? Which relevance do acid color formers have for on-press development?
- The addressed topics of "dotted scumming" on the one hand side and "appearance failure" will have to be discussed, esp. since it appears to be the mutual view of the parties that the one aspect relates to undesired dots caused by electrons being disseminated within the precursor due to corrosion and resulting in dots on the printed image whereas the appearance failure is deemed to be caused by H⁺, ie an acid reaction, the reason for

the acid reaction apparently being the diffusion of halogen anions into the aluminium substrate causing a reaction which sets free H⁺ and that H⁺ then causing the color former to react with such H⁺ leading to color dots on the “print-out” image.

- Is there an incentive for the skilled person to combine the Examples 3, 11 and 12 on which defendants focus their argument with the use of an acid color former (not being explicitly addressed in those examples as agreed by defendants)?
- The parties are invited to focus their extensive discussion being based on the EPO approach allegedly demanding for a precise determination of a closest prior art document on a train of thoughts which rather deals with the question if there is an incentive for a skilled person to think in a certain direction being confronted with the technical problem conceptually avoiding hindsight argumentation.

5. Added matter

- Is the range of 100 nm to 1500 nm sufficiently disclosed in the application?
- In this context: Are small-diameter pores disclosed as a mere option?
- Does the thickness “D” in [0123] and Figure 3 refer to the depth of the large-diameter pores only? What does the thickness F refer to?
- Does the skilled person know that small-diameter portions result from a distinct anodization step which may or may not be carried out – depending on the desired properties of the precursor?

V. Infringement by SONORA XTRA-3

- What exactly is the difference to SONORA X and XTRA-2?
- The defendants are invited to elaborate on the “spike argument”.
- Why is there no measurable pore diameter in the surface opening of the pores in case of spikes exactly?
- To which extent are spikes on the surface a result of the surface of the (not yet oxidized) aluminium support material being used before the anodization steps take place?
- How is the “surface” of the pores being defined? Does the presence of spike-like structures exclude it to address a certain portion of a layer to be its surface?
- The defendants are invited to elaborate on their argument that due to the three step anodization process being applied layers “A” and “B” cannot be understood as a layer containing large diameter pores.

VI. Confirmation of hearing dates

The hearing dates as agreed between all sides are again confirmed. The panel is motivated to **limit the oral hearing to three consecutive days**, ie 11 to 13 February 2025 (without being able to guarantee).

It is suggested to discuss questions, which relate to aspects playing a role in both cases ie UPC_CFI 359/2023 and 365/2023, together on one day, ie remedies sought, infringement by SONORA XTRA-3, prior use and reserve one day for the validity of each patent and further questions which only concern the one or the other patent.

VII. Upload of documents

If the Claimant wishes to amend its motions on the basis of the above remarks, it is requested to upload its amended motions to the CMS.

The parties are requested to upload to the CMS any sketches or documents which they may wish to refer to at the oral hearing for the purpose of explanation, but which have not yet been submitted to the file. It is strongly suggested to limit such documents to excerpts of documents which had already been submitted without altering their content (eg snap shots of drawings or pictures already contained in the written submissions without further comments or graphic highlighting).

VIII. Estimate of costs

The parties are requested to submit a provisional estimate of the costs of the dispute that they intend to claim (R. 104(k) RoP).

Time limit for VII. and VIII.: 4 February 2025.

The upload shall be carried out using the upload possibility provided for with this procedural order.

Finally the parties are informed that the panel does not intend to react to any of the multiple submissions putting forward that certain allegations shall be regarded or disregarded. In case of need a decision according to Rule 114 RoP will be considered by the panel after the exchange in the oral hearing.

Issued in Mannheim on 22 January 2025

NAME AND SIGNATURE

Prof. Dr. Tochtermann
Presiding judge