



UPC Court of Appeal  
UPC\_CoA\_312/2025  
APL\_16141/2025  
UPC\_CoA\_325/2025  
App\_16648/2025  
App\_18388/2025

**ORDER**  
**of the Court of Appeal of the Unified Patent Court**  
**issued on 17 April 2025**  
**application for suspensive effect (R. 223 RoP)**

Headnote:

- Where there is an uncontested fact as meant in R. 171.2 RoP, this does not imply that the legal consequence for which this fact was submitted automatically follows. It still falls upon the Court to decide whether the facts advanced justify such a legal consequence.

Keywords:

- suspensive effect (R. 223 RoP); uncontested fact (R. 171.2 RoP)

APPELLANT (AND DEFENDANT BEFORE THE COURT OF FIRST INSTANCE)

1. **Kodak Holding GmbH**, Stuttgart, Germany
2. **Kodak GmbH**, Stuttgart, Germany
3. **Kodak Graphic Communications GmbH**, Stuttgart, Germany  
(hereinafter: Kodak)

all represented by Kilian Seidel, Freshfields, Munich, Germany

RESPONDENT (AND CLAIMANT BEFORE THE COURT OF FIRST INSTANCE)

**Fujifilm Corporation**, Tokyo, Japan  
(hereinafter: Fujifilm)

represented by Tobias Hahn, HOYNG ROKH MONEGIER, Düsseldorf, Germany

PATENT AT ISSUE

EP 3 511 174

PANEL AND DECIDING JUDGES

Panel 2:

Rian Kalden, presiding judge and judge-rapporteur

## IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

Mannheim Local Division, 2 April 2025, infringement action ACT\_579338/2023, UPC\_CFI\_365/2023

## LANGUAGE OF THE PROCEEDINGS

English

## FACTS AND PARTYS' REQUESTS

1. Fujifilm, as the registered proprietor of the patent at issue, brought an infringement action against Kodak before the Court of First Instance, Local Division Mannheim. Kodak brought a counterclaim for revocation.
2. In the impugned decision on the merits of 2 April 2025, the Local Division ordered a permanent injunction against Kodak coupled with penalties, held that Kodak shall pay damages to Fujifilm, ordered Kodak to communicate information to Fujifilm, ordered Kodak to destroy at their own expense certain products, material and/or implements and to recall certain products and remove them definitely from the channels of commerce at their own expense, and to pay Fujifilm the sum of € 300,000 as an interim award on the legal costs and other expenses. All further requests of Fujifilm were dismissed. The counterclaim for revocation was dismissed. Kodak was ordered to bear the costs of the litigation and the value of the dispute was set at € 15,000,000. The Local Division decided not to make the enforceability subject to the provision of a security by Fujifilm.
3. Kodak has appealed the impugned order and is requesting that the appeal shall have suspensive effect according to R. 223 RoP.
4. Fujifilm is objecting against the application.

## SUBMISSIONS OF THE PARTIES

7. Kodak is arguing as follows. The impugned decision is manifestly erroneous by considering the first priority of the patent in suit validly claimed. The Local Division has ignored or rejected substantive defenses, in particular with regard to public and private prior use rights. The decision is based on a manifest violation of Kodak's right to be heard, and the Local Division has disregarded significant arguments by Kodak when assessing the proportionality of the injunctive relief sought and the request for enforcement security. In addition, the Local Division's conclusion that Kodak shall bear all costs is manifestly wrong as well, considering that (i) Fujifilm had partly withdrawn its Statement of claim by introducing a new and unconditional main request and dropping two of the three originally attacked embodiments, and that (ii) the Local Division partly rejected claims for interim awards on damages.
8. Fujifilm is supporting the impugned decision and objecting against the allegations made by Kodak.

## REASONS

9. Kodak's application for suspensive effect is admissible but must be dismissed as unfounded for the following reasons.

10. Pursuant to Art. 74(1) of the Agreement on a Unified Patent Court (the UPCA), an appeal has no suspensive effect unless the Court of Appeal decides otherwise at the motivated request of one of the parties. The Court of Appeal can therefore grant the application only if the circumstances of the case justify an exception to the principle that the appeal has no suspensive effect. It must be examined whether, on the basis of these circumstances, the appellant's interest in maintaining the status quo until the decision on its appeal exceptionally outweighs the respondent's interest. An exception to the principle that an appeal has no suspensive effect may apply, for instance, if the appealed order or decision is manifestly wrong, or if the appeal without suspensive effect becomes devoid of purpose (CoA 19 June 2024, UPC\_CoA\_301/2024, APL\_33746/2024, App\_35055/2024 - ICPillar vs. ARM).
11. The merits of the Local Division's assessments with regard to priority and public and private prior use rights, on the proportionality of the injunctive relief sought and the request for enforcement security, its observance of the adversarial principle as well as its conclusion that Kodak shall bear all costs, will have to be reviewed and decided by the Court of Appeal in its decision in the main appeal proceedings. In any event, Kodak has failed to demonstrate that the Court of First Instance's findings and considerations constitute manifest errors, i.e. factual findings or legal considerations which prove to be untenable already on the basis of a summary assessment (CoA 29 October 2024, UPC\_CoA\_549/2024, APL\_51838/2024 App\_53031/2024 - Belkin vs. Philips).
12. In relation to Kodak's complaints about the Local Division's assessments with regard to priority, the Court of Appeal notes that Kodak proceeds from an incorrect understanding of the scope of R. 171.2 RoP, which states that a statement of fact that is not specifically contested by any party shall be held to be true as between the parties. Even if there is an uncontested fact, this does not imply that the legal consequence for which this fact was submitted automatically follows. It still falls upon the Court to decide whether the facts advanced justify such a legal consequence. As said, the Court of First Instance's assessment in that regard shall be reviewed and decided by the Court of Appeal in its decision in the main appeal proceedings.

ORDER

The application is rejected.

Issued on 17 April 2025

Rian Kalden, presiding judge and judge-rapporteur