



Order
of the Court of First Instance of the Unified Patent Court
issued on 30 January 2025
concerning EP 3 476 616

CLAIMANT:

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DEFENDANTS:

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

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2. Kodak Graphic Communications GmbH, Kesselstraße 19, 70327 Stuttgart, represented by
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3. Kodak Holding GmbH, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs, at the
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PATENT AT ISSUE:

European patent EP 3 476 616

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This order was issued by the legally qualified judge Böttcher acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

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

FOUNDATIONS FOR THE ORDER:

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 13, whereas subsidiary request B. I. – III. explicitly refers to the attacked embodiments “SONORA X and/or SONORA 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 107) 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? The discussion will also have to take into account the principles of European Union law on retroactivity (cf., e.g., ECJ, C-267/20 mn. 31 et seqq., C-412/10 mn. 42). 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 46 (“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 3 476 616 in any country where and while it has been and/or is still in force since May 1st, 2019 – for Germany since July 7th, 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 request 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. Prior use right alleged by defendants

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 parties may be invited to discuss the alleged (as the case may be implicit) confidentiality provisions contained in agreements concerning alleged deliveries.

2. Novelty in the light of 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?

3. Novelty in the light of US 952

- Similar to No. 1 supra, it will have to be addressed, if the reworking of Example 2 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. For instance, why should the skilled person choose undisclosed parameters such as the waiting time and the interaction between voltage and current density in the same way as they were chosen during the reworking?
- Why should the auxiliary request(s) 1 and 1a (if admissible) limit the subject-matter to DOP-plates as long as the explicitly added feature is fulfilled?

4. Inventive step starting from EP 452, JP 021 or EP 408 in combination with common general knowledge or with the documents referred to in this context

- With regard to the claim construction, it will have to be discussed, if there is any implicit restriction to the subject-matter of claim 1. Why should the subject-matter be restricted to DOP-plates or at least to certain requirements which make the precursor suitable for such plates? Does feature 1.3.6 represents a pure property or does it implicitly requires certain means by which the property is achieved?
- It will have to be addressed which specific knowledge the relevant skilled person has with respect to the lightness of the surface of the anodized film, in particular with respect to potential trade-offs with the adhesion of the image recording layer to the aluminum support and with other properties. What is the motivation to combine micropores as claimed with the claimed lightness of the surface of the anodized film? Does the skilled person needs a specific motivation or does the skilled person chooses the claimed lightness as a well-known general solution just by common general knowledge and would this preclude the assumption of an inventive step, as the case may be? Are there any obstacles which would prevent the skilled person from applying the claimed lightness to the subject-matter described by the other features of claim 1? Does it makes any difference, if there are certain means by which the claimed lightness has to be achieved? In this context, potential trade-offs may be relevant, which may occur when forming the aluminum surface before anodization and designing the micropores of the anodized layer(s).
- With regard to the subject-matter of the auxiliary requests 1/1a and 2, it will have to be discussed, why they would justify a different assessment. With regard to the auxiliary request 3 it could be questionable, whether it constitutes an independent defence of claim 6. If necessary, it will have to be discussed, whether the claimant defended the claims

independently from the outset, if there are requirements for the specificity of such a defence and whether they are met.

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) aluminum 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? What does “projected area” (cf. patent in suit para. [0034], [0223], [0336]) means in this context? Does it involve the projection of a 3-dimensional structure onto a 2-dimensional area with a horizontal orientation parallel to the (macroscopic) surface of the plate?
- 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.: 5 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.

ORDER DETAILS

Order no. ORD_598571/2023 in ACTION NUMBER: ACT_578818/2023

UPC number: UPC_CFI_359/2023

Action type: Infringement Action

Related proceeding no. Not provided Not provided

Not provided Not provided

Issued in Mannheim on 30 January 2025

NAME AND SIGNATURE

Böttcher

Judge-rapporteur