

Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 4 April 2024
concerning EP 3 594 009 B1

HEADNOTES:

1. R. 9.3 (a) of the Rules of Procedure authorises the Court to extend time periods. However, this possibility should only be used with caution and only in justified exceptional cases.
2. Such an exceptional case regularly exists if access to a pleading in the unredacted version was initially restricted to the representatives due to an application for protection of confidential information (R. 262A RoP). The only way to ensure that the party concerned can exchange information with its representatives, develop a strategy taking into account the arguments of the other party and, where necessary, provide technical and/or economic input, is to grant access to the information in question to the party's employees with the relevant knowledge.
3. The Rules of Procedure provide for a time period of two months for the filing of the Reply to the Statement of defence which includes a Counterclaim for revocation (R. 29 (a) RoP). This time period must be available to the claimant and its representatives in order to jointly develop a defence strategy based on all the facts and to file pleadings on the basis of that strategy. Therefore, an extension of the time period is, in principle, granted upon request.
4. The same applies to the Counterclaim for revocation. The principles of due process and the right to be heard require that a party must be able to reconcile its arguments on (non)-infringement with those on validity and possible amendment of the claims, in particular in its first submission on validity.

KEYWORDS:

Extension of a time period; R. 262A – Application; limited access

CLAIMANT:

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

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DEFENDANT:

1. Kodak GmbH, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs Sven Freyer and Manfred Stegmaier, at the same place,

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

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2. Kodak Graphic Communications GmbH, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs Sven Freyer and Manfred Stegmaier, at the same place,

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

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3. Kodak Holding GmbH, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs Sven Freyer and Manfred Stegmaier, at the same place,

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

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PATENT AT ISSUE:

European patent n° EP 3 594 009 B1

PANEL/DIVISION:

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This order was issued by Presiding Judge Thomas acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement action – Rule 9.3 (a) RoP Extension of a time period

SUMMARY OF THE FACTS:

On 6 February 2024, the defendants filed their Statement of defence, including related Counterclaims for revocation. Simultaneously, the defendants filed allegedly confidential information concerning the factual basis of the alleged private prior use, as well as business figures concerning their application for enforcement security.

The Local Division in Düsseldorf issued a final order on the confidentiality request (R. 262A RoP) on 27 March 2024 (ORD_7096/2024). In this order, three of the claimant's employees were granted immediate access to the confidential information, while the remaining six employees will only be granted access after the 15-day appeal period and one additional week has elapsed. Previously, access had been restricted to the claimant's representatives.

Accordingly, claimant requests

to extend the time period for the claimant's reply to the Statement of defence, the Counterclaims for revocation and an application to amend the patent until May 28, 2024.

GROUND FOR THE ORDER:

R. 9.3 (a) of the Rules of Procedure authorises the Court to extend time periods. However, this possibility should only be used with caution and only in justified exceptional cases (UPC_CFI_363/2023 (LD Düsseldorf), Order of 20 January 2024, GRUR-RS 2024, 5106).

Such an exceptional case is given here.

Pursuant to R. 29 (a) RoP, within two months of service of a Statement of defence which includes a Counterclaim for revocation, the claimant shall lodge a Defence to the Counterclaim for revocation together with any Reply to the Statement of defence and any Application to amend the patent pursuant to Rule 30, if applicable. This means that the time period will run from the date of service, even if an application for protection of confidential information (R. 262A RoP) has been made in respect of that Statement of defence, on which an order will be issued at a later date (different opinion: UPC_CFI_54/2023 (LD Hamburg), Order of 28 November 2023).

However, this does not mean that the party who is the subject of a request and/or order for confidentiality is without protection. On the contrary, its interests may be taken into account by extending the relevant time period upon request in cases where none of the claimant's employees had access to the pleadings in question.

As the Local Division has already explained in detail in its Order of 27 March 2024, R. 262A RoP establishes as a ground rule of paramount importance that at least one natural person from each party and their respective lawyers or other representatives must be granted access in order to ensure a fair trial (UPC_CFI_355/2024 (LD Düsseldorf), Order of 27 March 2024, p. 10). This is true in general, but even more so where, as here, the (allegedly) confidential information relates to the prior use as a key defence of the defendants which may be decisive for the outcome of the case. The only way to ensure that the party concerned can exchange information with its representatives, develop a strategy taking into account the arguments of the other party and, where necessary, provide technical and/or economic input, is to grant access to the information in question to the party's employees with the relevant knowledge. This was granted for the first time on 27 March

2024, initially on a limited basis. The Rules of Procedure provide for a time period of two months for the filing of the Reply to the Statement of defence which includes a Counterclaim for revocation (R. 29 (a) RoP). This time period must be available to the claimant and its representatives in order to jointly develop a defence strategy based on all the facts and to file pleadings on the basis of that strategy. It is therefore necessary to extend the time period, as requested.

The same applies to the Counterclaim for revocation. The claimant correctly points out that the principles of due process and the right to be heard require that a party must be able to reconcile its arguments on (non)-infringement with those on validity and possible amendment of the claims, in particular in its first submission on validity.

Such an extension of time will not unduly disadvantage the defendants. The R. 262A RoP order was issued at the request of the defendants in order to protect their confidential information. The initial restriction of access to the claimant's representatives also served this purpose. The downside of this is the extension that has now been granted. In responding to a R. 262A RoP request, the claimant must accept that it will only receive delayed and restricted access. Defendants must now accept that, as a result of this restriction and delay, the claimant will need more time to respond to the defendant's arguments. There is no indication that the claimant's request for an extension of the relevant time periods is unduly delaying the proceedings.

ORDER:

The time period for the claimant's reply to the Statement of defence, the Counterclaims for revocation and an amendment of the patent **is extended until 28 May 2024.**

DETAILS OF THE ORDER:

App_17472/2024, App_17479/2024, App_17481/2024, App_17581/2024 and App_17651/2024 related to the main proceeding ACT_578607/2023, CC_3088/2024, CC_3090/2024 and CC_3093/2024

UPC-Number: UPC_CFI_355/2023

Subject of the Proceedings: Patent infringement action

Issued in Düsseldorf on 4 April 2024

Presiding Judge Thomas