



**Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 25 November 2024
concerning EP 3 594 009 B1**

CLAIMANT:

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

represented by: Lars Baum, HOYNG ROKH MONEGIER, Steinstraße 20, 40212 Düsseldorf, Germany

electronic address for service: lars.baum@hoyngrokh.com

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

electronic address for service: eva.acker@freshfields.com

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

electronic address for service: eva.acker@freshfields.com

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

electronic address for service: eva.acker@freshfields.com

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, legally qualified Judge Dr Thom, legally qualified Judge Lopes and technically qualified Judge Dr Parchmann.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Rule 333 RoP – Application to review

Background and Summary of Facts:

On 19 August 2024, Defendants filed the Rejoinder containing new factual allegations regarding the prior use defence. On 3 October 2024, the Claimant filed an application pursuant to Rule 36 RoP to submit a further written pleading in response to the Defendants' allegations. By Order of 30 October 2024, the Judge-Rapporteur rejected the Claimant's application.

In the Order under review, the Judge-Rapporteur held that having only one opportunity to submit written observations on the right of prior use is a consequence of the Rules of Procedure and of the time limits laid down therein. When assessing the prospects of success of a request pursuant to Rule 36 RoP, the Court must, on the one hand, take into account of the reasons put forward by the Claimant as to why, in its view, further pleadings are necessary. However, the Court must also take into account the impact of further pleadings on the further course of the proceedings and the associated risk of delay. In this respect, the Judge-Rapporteur concluded that the right to be heard is not unduly restricted, since the Claimant had the opportunity to file the request earlier, which could have led to a possible written statement in the infringement action within the remaining time limit in the counterclaim for revocation. At this stage of the proceedings, this is no longer possible and allowing a further submission will therefore lead to a delay. Furthermore, the Judge-Rapporteur pointed out that there still exists a possible opportunity to respond to the Defendants' new allegations at least at the oral hearing if the Court considers it necessary.

Indication of Parties' Requests:

The Claimant requests the Court,

- I. to review and set aside the Order dating 30 October 2024 and
- II. to allow the Claimant the submission of a further written pleading with respect to the Defendant's private prior use pleadings in their Rejoinder of August 19, 2024 (Section B).

Grounds of the Order:

The Claimant's request for review is admissible, but dismissed.

1.

The present request for review is admissible as the requirements of Rules 333.2 and .3 RoP have been met. Although Rule 333.2 RoP states that the other party shall be heard, the Panel may decide immediately if it is in favour of the other party and dismiss the request, as it did in the present case.

2.

According to the Panel, the Judge-Rapporteur applied the correct legal standard in dismissing the request for a further written submission.

a)

The Judge-Rapporteur has correctly pointed out that the risk of delay outweighs the Claimant's interest in presenting its arguments in writing. Reference is made to his correct findings and conclusions.

b)

The Claimant has not put forward any relevant arguments that would lead the Panel to reach a different conclusion with respect to the late filing of the request creating a risk of delay. The interpretation of "immediately" includes at least enough time not to create a risk of delay. This is particularly true in patent cases, where entire legal teams of lawyers and party's employees of the patent departments work on a case. Moreover, the time taken by the Court to decide on an application is by no means decisive. The risk of delay is borne solely by the parties who decide when to file their applications.

The notice given of the Claimant's preference for written submissions does not give reason to a revision of the Order under review. The Claimant's fear that it will not be able to present its arguments in the necessary detail is neither substantiated nor justified.

ORDER:

The Claimant's requests are dismissed.

DETAILS OF THE ORDER:

App_61143/2024 related to the main proceeding ACT_578607/2023

UPC-Number: UPC_CFI_355/2023

Subject of the Proceedings: Patent infringement action and counterclaim for revocation

Issued in Düsseldorf on 25 November 2024

Names and signatures

Presiding Judge Thomas	Ronny Thomas Digital unterschrieben von Ronny Thomas Datum: 2024.11.24 18:09:14 +01'00'
Legally Qualified Judge Dr Thom	Anna Bérénice Dr. THOM Digital unterschrieben von Anna Bérénice Dr. THOM Datum: 2024.11.25 11:10:21 +01'00'
Legally Qualified Judge Lopes	
Technically Qualified Judge Dr Parchmann	Stefanie Sabine Parchmann Digital signiert von Stefanie Sabine Parchmann Datum: 2024.11.25 11:31:37 +01'00'