Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Hamburg - Local Division

UPC_CFI_278/2023

Final Order
of the Court of First Instance of the Unified Patent Court
delivered on 30/04/2025

HEADNOTES

1. Art. 32 (1) e) and 65 (1) UPCA allow to attack the patent in its entirety by means of a counterclaim, even though single claims are not a part of the infringement requests.

2. The definition of claimed features based on the principle that a patent may be used as its "own lexicon" is limited to those parts of the description that are related to the feature in question.

3. Specifications in the description that are not consistent with the granted claims cannot serve as a basis of a broad interpretation of a claim.

4. A counterclaimant cannot introduce new grounds of invalidity of the attacked patent or introduce new documents considered novelty destroying or convincing starting points for the assessment of lack of inventive step in the oral hearing for the first time.

KEYWORDS

Art. 32 (1) e) and 65 (1) UPCA; Claim interpretation; Late filed validity attack, Rule 25 RoP

CLAIMANT

AGFA NV (Claimant) - Septestraat 27 - 2640 - Mortsel - BE	Represented by Kai Rüting

DEFENDANTS

1.	**Guccio Gucci S.p.A.** (Defendant) - Via Tornabuoni 73/r - 50123 - Florence - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
2.	**Marbella Pellami S.p.A.** (Defendant) - Via Marco Polo 91 - 56031 - Bientina - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
3.	**G Commerce Europe S.p.A.** (Defendant) - Via Don Lorenzo Perosi 6 - 50018 - Scandicci - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
4.	**Gucci Logistica S.p.A.** (Defendant) - Via Don Lorenzo Perosi 6 - 50018 - Scandicci - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
5.	**GG Luxury Goods GmbH** (Defendant) - Unter den Linden 21 - 10117 - Berlin - DE	Statement of claim served on 09/09/2023 Represented by Dr. Benjamin Schröer
6.	**Gucci France SAS** (Defendant) - 7 Rue Leonce Reynaud - 75116 - Paris - FR	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
7.	**GG FRANCE SERVICES SAS** (Defendant) - 37 Rue de Bellechase - 75007 - Paris - FR	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
8.	**Gucci Belgium SA** (Defendant) - Boulevard de Waterloo 49 - 1000 - Bruxelles - BE	Statement of claim served on 13/09/2023 Represented by Dr. Benjamin Schröer

9.	**Gucci Sweden AB** (Defendant) - Birger Jarlsgatan 1 - 11145 - Stockholm - SE	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer

PATENT AT ISSUE

Patent no.	*Proprietor/s*
EP3388490	AGFA NV

LANGUAGE OF PROCEEDINGS
English

PANEL/DIVISION
Panel of the Local Division in Hamburg

DECIDING JUDGES
This decision is delivered by presiding judge Klepsch, the legally qualified judge and judge-rapporteur Dr. Schilling, the legally qualified judge Lignieres and the technically qualified judge Sarlin.

ORAL HEARING
13 February 2025

SHORT SUMMARY OF THE FACTS

The Claimant, AGFA NV (hereinafter "Agfa"), is a Belgium-based company that is specialized in i.a. the development and sale of industrial inkjet technology, such as inks and printers. Agfa is part of the Agfa-Gevaert Group.

The Defendants are nine different European companies belonging to the French conglomerate Kering, which is the parent company of several luxury brands including e.g. Gucci, Saint Laurent and Balenciaga (exhibit VB02). All defendants are hereinafter collectively referred to as "Defendants" or "Gucci".

The Claimant is the proprietor of the European Patent EP 3 388 490 B1 (following "the patent") with the title "Decorating Natural Leather" (Exhibit VB01). The patent was granted on 21 July 2021 and has an application date of 14 April 2017. No opposition has been filed against the patent and there are no prior or pending proceedings relating to the patent before the Unified Patent Court or any national court or authority.

The patent in suit is in force in Belgium, Germany, Spain, France, UK, Italy and Sweden. Agfa is the sole proprietor of the national designations of the patent (exhibit VB23).

The patent regards a manufacturing method for decorating natural leather with a decorative image and a decorated natural leather having a decorative image. It further regards the use of an achromatic colour different from black in a base coat that is on a crusted leather in combination

with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather.

The Patent has fifteen claims, of which claims 1, 3, 4, 5, 6, 7, 10, 12, 13 and 14 are deemed relevant to these proceedings by the Claimant.

Claim 1 relates to a manufacturing method for decorating natural leather with a decorative image.

Claim 1 reads as follows:

> A manufacturing method for decorating natural leather with a decorative image including the steps of:
> - applying on a crusted leather (45) a base coat (44) containing a pigment for providing an achromatic colour different from black;
> - inkjet printing a colour image (43) on the base coat (44)
>
> using one or more pigmented UV curable inkjet inks;
> - optionally applying a protective top coat (42) on the image (43); and
> - optionally applying a heat pressing or embossing step;
>
> wherein the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image.

Dependant claim 3 specifies that the pigment used for providing an achromatic colour is a white pigment. Dependant claim 4 relates to the base coat which includes a polymer or copolymer based on polyurethane. Dependant claim 5 specifies that 1-20 wt% of the total weight of the UV curable inkjet ink consists of polyfunctional monomers or oligomers. Dependant claim 6 specifies that 0-20% of the total weight of the UV curable inkjet ink consists of organic solvent or water. Dependant claim 7 specifies that a protective top coat is applied.

Independent claim 10 relates to the decorated leather having a decorative image.

Independent claim 10 reads as follows:

> A decorated natural leather having a decorative image and including, in order,
> a crusted leather (45);
> a base coat (44) containing a pigment for providing an achromatic colour different from black;
> a pigmented UV curable inkjet printed colour image (43);
> and a protective top coat (42),
> wherein the chromatic colour or the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image.

The parties agree that claim 10 contains an obvious error by reference to “the chromatic colour”. This feature was deleted during prosecution from claim 1 but accidentally not deleted in claim 10. It is undisputed that the skilled reader should only read “the achromatic colour different from black”.

Dependant claim 12 specifies that the surface of the pigment used for providing the achromatic colour is a white pigment. Dependant claim 13 relates to the base coat which includes a polymer or copolymer based on polyurethane.

Dependant claim 14 claims a leather article including the decorated natural leather according to any one of claims 10 to 13. The leather article must be selected from the group consisting of

footwear, furniture, upholstery, bags, luggage, gloves, belts, wallets, clothing, automotive leather seats, interior decoration, packaging, equestrian leather articles, books and stationary.

Independent claim 15 is a use-claim of an achromatic colour different from black in a base coat on a crusted leather.

Independent claim 15 reads as follows:

> Use of an achromatic colour different from black in a base coat on a crusted leather in combination with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather.

The Claimant saw several claims of the patent being infringed by Gucci's "Pikarar Collection". The Claimant had reached out to Gucci about a possible infringement of the patent in suit first in June 2022. An out-of-court solution could not be found.

With its statement of claim dated 15 August 2023, the Claimant sued the Defendants for patent infringement plus annex requests.

The Claimant relies on a direct infringement of claims 1, 3, 4, 5, 6, 7, 10, 12, 13 and 14 of the patent in suit. It considers the "Padlock Gucci animal print mini bag" (= Pikarar Padlock Bag) and the "Rhyton Sneaker with animal print" (= Pikarar Sneakers) infringing the patent. Further suspected infringement products are the "Gucci animal print zip card case" (= Pikarar Card Case), the "Gucci animal print mini tote bag" (= Pikarar Tote Bag) and the "Women's Gucci Jordaan animal print loafer" (= Pikarar loafers). These products are part of the "Pikarar Collection", a limited-edition collection designed by Gucci in collaboration with the US-based illustrator Angela Nguyen.

STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES

The Claimant requests with its Statement of Claim dated 15 August 2023:

> I. to order Gucci, under the forfeiture of a recurring penalty payment of EUR 250,000.00 to be imposed by the Court for each failure to comply with this order, immediately from the date of service of the judgment, to cease and desist from
>
> 1. making, offering, placing on the market, using, or importing or storing for those purposes in Belgium, Germany, France, Italy and/or Sweden
>
> decorated natural leathers obtained by a manufacturing method for decorating natural leather with a decorative image including the steps of:
>
> - applying on a crusted leather a base coat containing a pigment for providing an achromatic colour different from black;
> - inkjet printing a colour image on the base coat using one or more pigmented UV curable inkjet inks;
> - optionally applying a protective top coat on the image; and
> - optionally applying a heat pressing or embossing step;
>
> wherein the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image,
>
> *direct infringement of claim 1 of EP 3 388 490 B1*
>
> in particular, wherein the pigment used for providing the achromatic colour is a white pigment,

direct infringement of claim 3 of EP 3 388 490 B1

in particular, wherein the base coat includes a polymer or copolymer based on polyurethane,

direct infringement of claim 4 of EP 3 388 490 B1

in particular, wherein the one or more pigmented UV curable inkjet inks contain 1 to 20 wt% of polyfunctional monomers or oligomers based on the total weight of the pigmented UV curable inkjet ink,

direct infringement of claim 5 of EP 3 388 490 B1

in particular, wherein the one or more pigmented UV curable inkjet inks contain 0 to 20 wt% of organic solvent or water based on the total weight of the pigmented UV curable inkjet ink,

direct infringement of claim 6 of EP 3 388 490 B1

in particular, wherein a protective top coat is applied,

direct infringement of claim 7 of EP 3 388 490 B1

in particular the products “Padlock Gucci animal print mini bag” and “Rhyton Sneaker with animal print” as depicted below

as well as any other product with a decorated natural leather obtained by a manufacturing method with the above outlined steps;

2. making, offering, placing on the market, using or importing or storing for these purposes in Belgium, Germany, France, Italy and/or Sweden

decorated natural leathers having a decorative image and including, in order, a crusted leather; a base coat containing a pigment for providing an achromatic colour different from black; a pigmented UV curable inkjet printed colour image; and a protective top coat, wherein the chromatic colour or the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image,

direct infringement of claim 10 of EP 3 388 490 B1

in particular, wherein the surface of the pigment used for providing the achromatic colour is a white pigment,

direct infringement of claim 12 of EP 3 388 490 B1

in particular, wherein the base coat includes a polymer or copolymer based on polyurethane,

direct infringement of claim 13 of EP 3 388 490 B1

in particular the products “Padlock Gucci animal print mini bag” and “Rhyton Sneaker with animal print” as depicted below

as well as any other product with a decorated natural leather having a decorative image and fulfilling the above-mentioned characteristics;

3. making, offering, placing on the market, using or importing or storing for these purposes in Belgium, Germany, France, Italy and/or Sweden

leather articles including a decorated natural leather having a decorative image and including, in order, a crusted leather; a base coat containing a pigment for providing an achromatic colour different from black; a pigmented UV curable inkjet printed colour image; and a protective top coat, wherein the chromatic colour or the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image,

wherein the leather article is selected from the group consisting of footwear, furniture, upholstery, bags, luggage, gloves, belts, wallets, clothing, automotive leather seats, interior decoration, packaging, equestrian leather articles, books and/or stationary

direct infringement of claim 14 of EP 3 388 490 B1

in particular the products “Padlock Gucci animal print mini bag” and “Rhyton Sneaker with animal print” as depicted below

as well as any other footwear, furniture, upholstery, bags, luggage, gloves, belts, wallets, clothing, automotive leather seats, interior decoration, packaging, equestrian leather articles, books and/or stationary with a decorated natural leather having a decorative image according to the above characteristics;

II. to order Gucci, under the forfeiture of a recurring penalty payment of up to EUR 10,000 EUR to be imposed by the Court for each day of delay, within a period of 45 days from the date of service of the judgment referred to in Rule 118.8 of the Rules of Procedure, at their own expense, or a penalty of EUR 2,000 for each product with which this order is breached

1. to recall and permanently remove from the channels of distribution the products as specified in items I. 1.-3. above which have been placed on the market in Belgium, Germany, France, Italy and/or Sweden since 21 July 2021, to notify the third parties from whom the products are to be recalled that this Court has found that the respective product infringes the European patent EP 3 388 490 B1, with a binding undertaking by the respective Defendant to repay the purchase price already paid, if any, to reimburse the third parties for the costs incurred, to pay the transport, shipping and packaging costs incurred, to reimburse the customs and storage costs associated with the return of the products, and to take back the products;

2. to destroy the products as specified in items I. 1.-3. above and/or the materials and implements, in particular the decorated leather as specified in item I.1. and I.2, which are in Gucci's direct or indirect possession and/or ownership in Belgium, Germany, France, Italy and/or Sweden and to provide Agfa with proof of the destruction or, at their option, to hand them over to a bailiff to be appointed by Agfa for the purpose of destruction;

III. to order Gucci, under the forfeiture of a recurring penalty payment of up to EUR 2,000 EUR to be imposed by the Court for each day of delay, within a period of 45 days from the date of service of the judgment referred to in Rule 118.8 of the Rules of Procedure,

1. to provide Agfa in a list broken down by month of a calendar year and by infringing product and in an electronic form that can be analysed by a computer, with the relevant information on the infringing products as specified in items I.1.-3. above and the extent to which they (Gucci) have committed the acts specified in items I.1.-3. above, in order to be able to recall and destroy all infringing products on the market to identify their current or former owners and to calculate the damages, including Gucci's profit as from 21 July 2021, in particular by providing information on

a) the origin and distribution channels of the infringing products;

b) the quantities produced, manufactured, delivered, received or ordered, as well as the prices obtained for the infringing products; and

c) the identity of any third person involved in the production or distribution of the infringing products or in the use of the infringing process;

2. to lay open books to Agfa for proving the statements made according to item III. 1. by making them available for each month of a calendar year and for each infringing product and in an electronic form that can be analysed by a computer, in particular

a) evidence showing the numbers and dates of the products manufactured;

b) invoices - or, if unavailable, delivery bills - of each shipment, broken down by quantities offered, times offered, prices of goods offered, and type designations, and the names and addresses of the commercial recipients of the sales offers for all products sold or otherwise disposed of;

c) evidence of advertising carried out, broken down by advertising medium, its distribution, the distribution period and the distribution area; including evidence of such advertising activities;

d) the costs, broken down by individual cost factors and the profits made;

e) invoices - or, if unavailable, delivery bills - and corresponding statements of all costs expended upon which Gucci relies in calculating its profits;

the accuracy of which is verified and confirmed by a certified public accountant appointed by Agfa at the expense of Gucci, who shall be bound to secrecy vis-à-vis the Agfa with regard to the aforementioned information;

IV. to declare that Defendants individually and jointly have infringed the patent EP 3 388 490 B1 by committing the acts as specified in items I.1., 1.2 and I.3. above;

V. to declare that Defendants are individually and jointly liable to compensate Agfa for all damages that incurred and will incur due to the acts specified in item I.1., I.2 and I.3. above and committed since 21 July 2021, as to be specified separate damage proceedings;

VI. to order Gucci to pay the reasonable and proportionate legal costs of these proceedings and other expenses;

VII.to declare that

1. the orders according to item I.1, I.2. and I.3, and VI. are immediately enforceable notwithstanding any appeal,

2. the orders according to items II.1., II.2, II.3 and III.1. and III.2 are immediately enforceable after Agfa has notified the Court which part of these orders it intends to enforce, a certified translation of the orders in accordance with Rule 7.2, where applicable, into the official language of the Contracting Member State in which the enforcement shall take place has been provided by Agfa, and the said notice and, where applicable, the certified translation of the orders have been served on the respective Defendant by the Registry.

The Defendants request with their Statement of Defence and Counterclaim for revocation dated 8 January 2024 in the version of the Reply to the Defence dated 28 June 2024:

I. The infringement action is dismissed.

II. The Claimant shall bear the costs of the infringement proceedings.

Counterclaiming:

III. The European Patent EP 3 388 490 is revoked in its entirety with effect to the territories of Belgium, France, Germany, Italy and Sweden.

IV. The Claimant shall bear the costs of the revocation proceedings.

Auxiliary requests:

V. by way of an auxiliary request, in case the Counterclaim for revocation is referred to the Central Division, to suspend the action for infringement until the final decision on the Counterclaim of revocation.

VI. in the event that the Claimant fails to take a step within the time limit foreseen in the Rules of Procedure or set by the Court or fails to appear at an oral hearing after having been duly summoned, to dismiss the action for infringement and revoke European Patent EP 3 388 490 in its entirety with effect to the territories of Contracting Member States in which EP 3 388 490 is in force by way of a decision by default (R. 355.1 RoP).

VII. dismiss the request for injunctive relief (item I.), the request for recall and removal from the channels of commerce and the request for destruction (item II.) and instead order the Defendants 1) to 9) to pay a compensation that is reasonable under the circumstances of the case and takes into account the economic value of a hypothetical license.

VIII. The orders requested by the Claimant, including, but not limited to, the requested injunction pursuant to item I., shall be enforceable only after a security has been given by the Claimant to the respective Defendant(s) as determined by the Court in accordance with R. 352 RoP.

The Claimant requests,

I. The Counterclaim for Revocation is dismissed.

II. The Counterclaimants and Defendants are to bear the legal costs of the Revocation Proceedings.

Auxiliary requests with its application to amend the patent dated 9 April 2024:

III. The European Patent EP3 388 490 B1 is upheld with effect to the territory of Belgium, France, Germany, Italy and Sweden according to any one of Auxiliary Requests 1 to 5 as considered valid by your court.

IV. For the rest, the counterclaim for revocation is dismissed.

V. The Counterclaimants and Defendants are to bear the legal costs of the Revocation Proceedings.

The Defendants request with their Defence to an application to amend a patent dated 28 June 2024:

I. The Application to Amend the Patent is inadmissible to the extent of auxiliary requests 2 and 5.

II. The European Patent EP 3 388 490 is revoked in its entirety also in view of the auxiliary requests 1 to 5 with effect to the territories of Belgium, France, Germany, Italy and Sweden.

III. In the alternative: The infringement action is dismissed to the extent that the claimant alleges infringement of the Patent-in-Suit as amended by the Auxiliary Requests.

IV. The Patentee shall bear the costs of the revocation proceedings.

POINTS AT ISSUE

The parties disagree on the interpretation of some terms of the feature “achromatic colour different from black of the base coat in the independent claims 1 and 10, and the question whether the claims allow an intermediate layer of (white) ink on the base coat. The Claimant clarified with its submission of 24 January 2025 regarding the interpretation of feature 1.1 that the claimed base coat must contain (not consist of) a pigment for providing an achromatic pigment different from black, which (in conjunction with feature 1.5.1) results in a base coat having an achromatic colour different from black. White, grey and black were achromatic colours and achromatic colours had no dominant hue, meaning that all wavelengths would be present in approximately equal amounts. Such a colour might be obtained, e.g., through the use of a white pigment such as titanium dioxide, but also by adding additional pigments for slightly altering the colour of the base coat.

The Claimant is of the opinion that adding a small amount of chromatic pigment to a large amount of achromatic pigment would generally still result in an achromatic base coat. It argues that the patent did not only seek protection for “perfect” achromatic colours or indistinguishable variants thereof. Rather, the patent also sought protection for base coats with a small amount of chromatic pigments, which include off-white or ivory white colour. The Claimant relies, in particular, on para [0029] and example 3 of the patent.

Para. [0021] of the patent reads as follows:

> A chromatic colour is any colour in which one particular wavelength or hue predominates. For example, blue and green are chromatic colours, while white, grey, and black are achromatic colours, as they have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours.

The Defendants interpret para [0021] of the patent in a way that it would teach that a colour is achromatic within the meaning of the patent if it had a flat spectral response or, if the spectral response was not perfectly flat, if the deviations from the perfectly flat spectrum were such that the difference between the colour in question and the nearest reference achromatic colour with a perfectly flat spectrum line would not be perceptible to the average observer. "Approximately equal amounts” meant according to the Defendants that a colour is achromatic, as long as the human eye could not perceive a difference to the nearest "perfect" achromatic colour. The nearest perfect achromatic colour was a colour where all wavelengths have the same reflection intensity.

They are of the opinion the ΔE94 metric could be used to determine how the human eye perceives colour differences. The skilled person understood that an objective and reproducible criterion was required based on which it could be determined whether all wavelengths were present in approximately equal amounts so that the colour difference was not perceptible to the average observer. This issue would lead the skilled person automatically to the option of using the ΔE94 metric.

The Defendants challenge the novelty and in parts the inventiveness of the inventions defined in the claims of the patent in suit, including claim 15, which is not asserted by the Claimant of being infringed.

The Defendants rely on their counterclaim for revocation on written pieces of prior art in exhibits HLAR 7, 8 and 9. They see these documents as being novelty destroying with respect to claim 1. They attack claim 10 on the grounds that the claimed process is not novel based on HLAR 9 and it is non-inventive based on a combination of documents HLAR 9 with HLAR 7 or of documents HLAR 9 with HLAR 8.

Furthermore, they raise the lack of novelty for independent claims 1, 10 and 15 based on the "Flora" products, which they claim to have marketed before the priority date. The Defendants also raise novelty or inventive step objections against all the dependent claims, based on the Flora products. They are of the opinion that all features of the claims 1, 3, 7, 8, 10 and 12-15 were disclosed by these products or that their features were available to the skilled person, by analysis. Regarding the method of claim 1 which is directed to applying at least two layers (base coat, colour image) to the leather in a specific order, the Defendants consider that the skilled person can deduce the order of the layers inter alia based on microscopy measurement and the skilled person can hence deduce the method steps from the measurements.

The Claimant considers the patent in suit to be novel and inventive. It contests the availability of the Flora products on the market before the priority date, and it contests that these products were successfully questioning the patentability of the patented claims and that, in addition, their features were detectable without the detailed own manufacturing knowledge of the Defendants.

The asserted patent infringement with the attacked embodiments of the "Pikarar collection" is disputed. As an auxiliary defence the Defendants rely on private prior use based on the Flora products.

GROUNDS FOR THE ORDER

The infringement action is admissible, but unfounded. The counterclaim for revocation is admissible, but not successful, either.

A. ADMISSIBILITY

Both, the infringement action and the counterclaim for revocation are admissible.

I.

The admissibility of the claim is formally undisputed. Even though the Defendants claim that Defendant 7) is completely unrelated to the present proceedings, they did not formally question the jurisdiction of the Court by means of a preliminary objection in this respect. According to R. 19.7 RoP, this shall be treated as a submission to the jurisdiction and competence of the Court and the competence of the Division chosen by the Claimant, namely the Local Division Hamburg.

II.

The counterclaim is admissible.

1.

The Defendants adjusted their counterclaim in their Reply to the Defence dated 28 June 2024 now citing the relevant countries, i.e. with effect to the territories of Belgium, France, Germany, Italy and Sweden.

2.

On request of the judge-rapporteur the parties exchanged arguments whether or not it is possible under the UPCA to attack an individual claim – here claim 15 – by means of a counterclaim even though it is not part of the infringement action and the Claimant does not seek an injunction on the basis of this individual claim of the patent at issue.

After considering the parties' arguments, the Court decides this question in favour of it being possible to attack the patent in its entirety by means of a counterclaim, even though single claims might not be a part of the infringement requests. The Defendants rightfully pointed out that in Art. 32(1)e) and 65(1) UPCA no distinction is made between asserted and unasserted patent claims,

but reference is made to the patent in its entirety. Therefore, already the wording of the relevant provisions clearly suggests that the revocation of the entire patent in dispute may be sought. In contrast, there is no provision in the UPC Rules of Procedure that limits the party bringing a counterclaim to the parts of the patent asserted against it by the Claimant in the infringement action, and no requirement that such party limits its action for revocation to what is asserted against it in the main infringement action (LD Paris, 04.07.2024 – UPC_CFI_230/2023, ACT_546446/2023, para. 9.2).

According to Art. 33(4) UPCA, a defendant of the infringement action is unable to bring a stand-alone revocation action against the same patent before the central division. Therefore, it must be possible for a Defendant to attack the patent in its entirety by way of a counterclaim for revocation, including those claims not asserted in the infringement action, since otherwise the non-asserted claims would be immune against a validity challenge by the Defendant.

It would also contradict the principle of procedural economy as well as of efficiency and cost-effectiveness in Article 41(3) UPCA would it not be possible to attack the patent in dispute in its entirety with the counterclaim for revocation.

3.

With auxiliary requests 1- 5 the Claimant seeks to limit the patent in suit. Auxiliary requests AR 1 – 5 are based on the claims as granted. Auxiliary request AR1 deletes an (apparent) mistake in claim 10 and deletes claim 15. Auxiliary requests AR2-AR5 further combine claim 1 with dependent claims. The admissibility of the auxiliary request is partly contested by the Defendants. As the condition for a decision on the auxiliary requests did not materialise (see below in sect. C.) this point does not need further elaboration.

By Order dated 19 December 2024, the Judge-Rapporteur concluded the written proceedings.

III.

The Panel admits the contested presentation of evidence by the Defendants with their Revocation Reply and the Amendment Defence dated 28 June 2024 (exhibits HLAR 29 to 44) and their Amendment Rejoinder dated 30 September 2024 (exhibits 47 and 48). The Panel, however, rejects all the pieces of evidence filed after the end of the written procedure: exhibits HLAR 47a, 49 – 51 filed by the Defendants and exhibit VB 51 (and its Appendixes 1 and 2) filed by the Claimant. The Panel executes its discretion, as indicated by the judge-rapporteur in the interim conference on 19 December 2024, to not dismiss the evidence presented by the Defendants in exhibits HLAR 29 to 48 as their presenation was a comprehensible reaction to the Claimant contesting facts. As the report HLAR 10 – submitted with the Counterclaim – already stated that there was evidence for the presence of parbenate, a typical photoinitiator, in the HP Ink used, but not in the final Flora product, the submission of exhibit HLAR 47 was also a reasonable reaction to the contesting by the Claimant. For the submissions of even further evidence HLAR 49 – 51 by the Defendants with their comments dated 24 January 2025 and of the corrected report HLAR 47a on 7 February 2025 after the interim conference on the other hand, the Defendants were lacking the necessary approval of the Court based on Rule 36 RoP. The judge-rapporteur did not invite the Defendants to provide even further evidence, thus HLAR 49 – 51 are rejected by the Panel as late filed. As an additional remark, HLAR 50a filed on 7 February 2025 has been filed to correct errors in HLAR 50 filed on 24 January 2025, even though HLAR 50 had been filed to fill the gap in HLAR 47. In addition, the Defendants have filed a corrected version HLAR47a of HLAR47 on 7 February 2025, therefore less than one week before the oral hearing and have admitted that its written brief of 24 January 2025 included an error.

B. THE PATENT IN SUIT

I.

The patent in suit relates to the manufacturing of decorated natural leather and leather articles therewith. The manufacturing of natural leather articles is well known and can generally be split up into five phases as shown by figure 1 of the patent. Natural leather has been decorated in the past by screen printing. However, screen printing is labour intensive and a large number of individual screens are required for each colour and for each size of print. This is costly and time-consuming, especially when personalization or customization is desired, para. [0003]. Digital printing technologies on finished leather have been investigated but many solutions on finished leather remain of inferior quality. Inkjet technologies from textile printing employing heat transfer paper have been explored for leather printing. However just like inkjet printing directly onto natural leather, it was found that a process of inkjet printing dye-based images onto a sheet of transfer paper and then transferring the images onto tanned leather by heat resulted in a quality unacceptable for many luxury leather products, para. [0004]. Light fading of dyes can be resolved by using pigmented inks, para. [0005]. Recently, high quality decorated leather has been obtained by a method of printing "into" tanned leather with pigmented inks, para. [0006]. A high image quality of printed leather is essential for luxury leather articles. In order to enhance colour brilliancy, often a white background is used, para. [0007]. One option is to use white leather, para. [0008]. However, the luxury appearance of a leather article is substantially decreased when a side of the printed white leather is viewable in the leather article or when perforations are present, for example for sewing leather pieces together or for providing aeration in e.g. leather car seats. Furthermore, the use of white leather generally does not help much to reduce colour inconsistencies or surface defects, para. [0009]. Another option for providing a white background is to use white inkjet inks. However, the application of white inkjet ink in amounts sufficient to mask surface defects and colour inconsistencies of the leather resulted in insufficient flexibility of the printed leather showing cracks in the printed image, para. [0010].

The patent describes as an objective that there is a need for manufacturing methods of decorated leather having high image quality and colour consistency, while not sacrificing inkjet printing reliability or physical properties like flexibility, para. [0011]. The above-mentioned problem is solved by a method according to claim 1. It is stated to have been surprisingly found that an inkjet printed leather exhibiting excellent flexibility, colour consistency and image quality could be obtained by using an achromatic colour different from black in a base coat (44) on a crusted leather (45) and combining it with a colour image (43) inkjet printed on the base coat for providing a decorative image to a natural leather. The word 'combining' is to be understood as that the colours in the decorative image are the result from the colours of the colour image and the colour of the base coat, para. [0013].

II. CLAIM CONSTRUCTION

Granted claim 1 of the patent in suit (EP 3 388 490 B1), can be divided into the following features (numbering following Defendants):

1.0	A manufacturing method for decorating natural leather with a decorative image including the steps of:
1.1	applying on a crusted leather (45) a base coat (44)

1.1.1 [the base coat (44)] containing a pigment for providing an achromatic colour different from black;

1.2 inkjet printing a colour image (43) on the base coat (44)

1.2.1 using one or more pigmented UV curable inkjet inks;

1.3 optionally applying a protective top coat (42) on the image (43); and

1.4 optionally applying a heat pressing or embossing step;

1.5 Wherein

1.5.1 the achromatic colour different from black of the base coat

1.5.2 and the inkjet printed colour image

1.5.3 are used in combination to provide the decorative image.

Granted claim 10 of the patent in suit (EP 3 388 490 B1), can be divided into the following features:

10.0 A decorated natural leather having a decorative image and including, in order,

10.1 a crusted leather (45);

10.2 a base coat (44) containing a pigment for providing an achromatic colour different from black;

10.3 a pigmented UV curable inkjet printed colour image (43);

10.4 and a protective top coat (42),

10.5 Wherein

10.5.1 the chromatic colour or the achromatic colour different from black of the base coat

10.5.2 and the inkjet printed colour image

10.5.3 are used in combination to provide the decorative image.

Granted claim 15 of the patent in suit (EP 3 388 490 B1), which is not part of the infringement action, can be divided into the following features:

15.0 Use of an achromatic colour different from black in a base coat on a crusted leather

15.1 in combination with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather.

III. PRINCIPLES OF INTERPRETATION

The Court relies on the following principles of interpretation of patent claims:

1.

The UPC Court of Appeal has adopted as standard for the interpretation of patent claims (decision dated 26.02.2024 – UPC_CoA_335/2023, App_576355/2023 - 10X Genomics and

Harvard/NanoString), that in accordance with Art. 69 of the Convention on the Grant of European Patents (EPC) and the Protocol on its Interpretation the patent claim is not only the starting point, but the decisive basis for determining the protective scope of the European patent. The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim. However, this does not mean that the patent claim serves only as a guideline and that its subject-matter may extend to what, from a consideration of the description and drawings, the patent proprietor has contemplated. The patent claim is to be interpreted from the point of view of a person skilled in the art. In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties. These principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent. This follows from the function of the patent claims, which under the EPC serve to define the scope of protection of the patent under Art. 69 EPC and thus the rights of the patent proprietor in the designated Contracting States under Art. 64 EPC, taking into account the conditions for patentability under Art. 52 to 57 EPC.

2.

Art. 69 EPC and its Protocol require that the terms used in the claims must govern claim construction, on their own or in their claimed combination. They are not just the "starting point" for claim construction but the authoritative basis for determining the scope of protection. The description and the drawings are nevertheless always to be considered, even with seemingly clear claims; thus, a patent may be used as its "own lexicon" (CoA, 26.02.2024 – UPC_CoA_335/2023, Headnote 2 – NanoString v 10x Genomics; CD Munich, 16.07.2024 – UPC_CFI_14/2024, Headnote 1 – Regeneron v Amgen). The features of a claim have to be read in combination, as they must always be interpreted in the light of the claims as a whole (CoA, 13.05.2024 – UPC_CoA_1/2024, mn 29 – VusionGroup v Hanshow).

3.

The Panel agrees with the parties' (almost) concordant definition that the skilled person is an engineer in the field of printing technology specialized in the preparation and the processing of decorated leather articles, and experienced in the application of printing methods available for printing on leather. The skilled person has knowledge of inkjet printing and the colouring involved.

IV. FEATURE ANALYSIS

Claim 1 regards a manufacturing method for decorating natural leather with a decorative image. In particular the feature 1.1.1 *[the base coat (44)] containing a pigment for providing an achromatic colour different from black* and feature 1.2.1 requiring *inkjet printing a colour image on the base coat* of the granted claim 1 requires interpretation in accordance with the above-mentioned standards.

1.

The claimed manufacturing method includes the steps of applying a base coat on a crusted leather (feature 1.1).

The composition of the base coat in terms of its material is not limited in the claim. However, the patent teaches in para. [0043] that the base coat preferably includes a polymer or copolymer based on polyurethane, as this has been found to improve flexibility to the printed leather. The base coat preferably further includes a polyamide polymer or copolymer, as polyamide has been found to improve the compatibility with the crust leather and to improve the strength of the base

coat. The comparative example 1 examines the use of a white inkjet printed on the layer that does not correspond to the base coat.

The term "crusted leather” or "crust leather" describes a leather that has been tanned and crusted, but not finished, para. [0016]. The manufacturing of natural leather articles is well known and is generally split up into five phases, para. [0002]: preparation, tanning, crusting, finishing and manufacturing of the leather article. According to claim 1, the base coat is applied on a crusted leather, which is achieved after the third step. The crusted leather has therefore generally undergone the following phases: During the preparation (1st phase), the skin was removed from the animal and pre-treated for the tanning (pre-treatment can involve processes such as unhairing). During the tanning (2nd phase), the protein of the rawhide or skin was converted into a stable material that will not putrefy; chrome is most frequently used as a tanning agent. The following crusting phase (3rd phase) often includes processes such as stripping, fat liquoring, dyeing, whitening, physical softening, and buffing.

2.

At the centre of the dispute is the interpretation of feature 1.1.1

> [the base coat (44)] containing a pigment for providing an achromatic colour different from black;

This feature defines the base coat as containing a pigment for providing an achromatic colour different from black.

a)

As a starting point it has to be interpreted whether the term “achromatic” refers to the pigment or the base coat as a whole, in other words, if it is sufficient that the base coat *contains* an achromatic pigment different from black or if it does require the base coat as a whole to have an achromatic colour different from black. The Court construes this feature in the sense of the latter meaning and the parties have finally agreed with this interpretation. The Patent explains in para. [0021] that a chromatic colour is any colour in which one particular wavelength or hue predominates. For example, blue and green are chromatic colours, while white, grey, and black are achromatic colours, as they have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours. Preferably a white pigment is used (see par. [0025]), such as titanium dioxide, zinc oxide, calcium carbonate (par. [0051]). According to para. [0025] a white basecoat not only masks colour inconsistencies and some surface defects in the surface of the crusted leather, but also increases the colour gamut. The colour gamut represents the number of different colours that can be produced with a certain inkjet ink set. An enlarged colour gamut enhances the luxury effect of leather as photographic image quality can be obtained, and also has economic benefits in that less complex inkjet printers can be used that are printing with an inkjet ink set containing fewer inkjet inks. Both parties interpret the feature correctly in a way that it requires that the final base coat colour is achromatic and different from black. Both parties rightfully acknowledge that the word “achromatic” refers to the result of the added pigment(s), which is to provide an achromatic colour to the base coat as a whole. Therefore, the basecoat as a whole has to have an achromatic colour.

This is supported by the meaning of claim 1 as a whole, including feature 1.5.1 of the patent in suit:

> “the achromatic colour different from black of the base coat”

As the features of a claim have to be read in combination and must always be interpreted in the light of the claims as a whole, feature 1.5.1 confirms the understanding that the base coat as a whole must have an achromatic colour different from black.

This is further supported by the fact, that during the granting proceedings, the Claimant deleted "chromatic colour" from the wording of original claim 1, and in particular in the part corresponding to feature 1.5.1:

Claim 1. A manufacturing method for decorating natural leather with a decorative image including the steps of:
– applying on a crusted leather (45) a base coat (44) containing a pigment for providing ~~a chromatic colour or~~ an achromatic colour different from black;
– inkjet printing a colour image (43) on the base coat (44) using one or more pigmented UV curable inkjet inks;
– optionally applying a protective top coat (42) on the image (43); and
– optionally applying a heat pressing or embossing step;
wherein ~~the chromatic colour or~~ the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image.

Figure 1: Excerpt from Claimant's submission of amended claims dated 24 September 2019, filed as Exhibit HL 15.

b)

Secondly, the term "achromatic" has to be defined. The Court construes the feature "achromatic" according to the definition given in the description in para. [0021] of the patent based on the principle that a patent may be used as its "own lexicon" (for instance, UPC_CFI_14/2023, 16.07. 2024, CD Munich, Regeneron v Amgen).

aa)

Para [0021] of the patent gives a definition of what it considers an achromatic base coat:

> [0021] A chromatic colour is any colour in which one particular wavelength or hue predominates. For example, blue and green are chromatic colours, while white, grey, and black are achromatic colours, as they have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours. [*Emphasis added by the Court]*

Hence, the patent defines achromatic colours as colours that have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours. Achromatic and chromatic colours are mutually exclusive as chromatic colours have a dominant hue, i.e. were one particular wavelength predominates. Black, though being considered achromatic, is explicitly excluded in the wording of the feature.

bb)

With regard to the dispute between the parties over the term "approximately" in the text section cited above, the Court finds that para. [0021] teaches that a colour was achromatic within the meaning of the patent if it had a more or less flat spectral response in the visible range. The teaching that all wavelengths being present in "approximately" equal amounts gives the user a tolerance related to the limited perception of the human eye to detect colour nuances, which is mentioned in para [0027]. Thus, a colour can be achromatic within the scope of the patent if the spectral response was not perfectly flat, but if the deviations from the perfectly flat spectrum were such that the difference between the colour in question and the reference achromatic colour – white or grey – with a perfectly flat spectrum line was not perceptible to the average observer.

cc)

The patent, however, does not link the tolerance given by the wording “approximately” to ΔE94 measurements.

The discussion of the ΔE94-measurement in the patent description relates to colour differences in general, and with regard to colour differences between the surface of the leather and the inkjet printed colour. Thus, the ΔE94 measurement is not part of the teaching of the patent regarding the definition of the term “achromatic”.

The ΔE94 measurement is discussed in the patent in para. [0027] and [0028]:

> [0027] ΔE94 is a metric for understanding how the human eye perceives colour differences. For a ΔE94 ≤ 1,0, no colour difference is perceptible by human eyes. For the present invention, two colours are considered to be similar if the ΔE94 is smaller than 10.0, preferably smaller than 5.0 and most preferably smaller than 2.0.
>
> [0028] The calculation of ΔE94 is well known to the skilled person and is, for example discussed in handbooks like Colour Engineering. Edited by GREEN, Phil, et al. John Wiley and Sons LTD, 2002. ISBN 0471486884. and BERNS, Roy S., Principles of Color Technology. 3rd edition. John Wiley and Sons LTD, 2000.

Para. [0027] defining ΔE94 value is to be understood in context with para. [0026]:

> [0026] Another advantage of including a white pigment in the basecoat is obtained in combination with a dyed crusted leather. The thickness of the white basecoat is generally less than 50 µm or even less than 30 or 20 µm and not viewable by the naked eye from the side of the inkjet printed leather as in Figure 2. If the crusted leather was dyed to have a certain background colour for the decorative image, then this background colour is no longer viewable as the white base coat is on top of the crusted leather. However, this can be easily restored by inkjet printing a similar colour as background colour on the white basecoat where necessary. Therefore, in a preferred embodiment of the manufacturing method, the surface of the crusted leather and a part of the colour image have a similar colour. A similar colour means that if the dyed crusted leather has a surface with, for example, a black, brown, red, green or blue colour that a part of the inkjet printed colour image also has a colour selected of respectively a black, brown, red, green and blue colour. In a preferred embodiment, the colour difference between the surface of the dyed crusted leather and the corresponding part in the inkjet printed colour image is minimized using ΔE94as metric. [*Emphasis added by the Court*]

The Court sees this matter indeed not being related to the definition of “achromatic” given in [0021]. ΔE94 is introduced when it is sought to restore the colour of the dyed crusted leather by inkjet printing a similar colour as background colour on the white basecoat where necessary. It is explained that in this embodiment, the colour difference between the surface of the dyed crusted leather and the corresponding part in the inkjet printed colour image is minimized using ΔE94 as metric. It is the reason why, in the following paragraph ΔE94 is defined, with the criteria applied for the notion of “similar”. In addition, the Court remarks that the difference between two colours and the borderline between achromatic and chromatic are completely different notions. Indeed, grey is a colour different from white, whereas both are achromatic. Therefore, there is no reason to deviate from the definition of “achromatic” given at para [0021] being colours that “have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours.” White is a typical example.

c)

According to this interpretation an *ivory* base coat is not within the scope of the patent. It is key to address this question within the claim construction as it is important for any assessment of the scope of the patent by the skilled person, in particular, where the patented method begins and where it ends.

aa)

Feature 1.1.1 refers to achromatic colours and not to a white colour, which is an important difference. Despite the fact, that the patent sees white, grey, and black as achromatic colours, it is clear to the person skilled in the art that not all white or grey tones fulfil the patent's definition of achromatic, which requires to "have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours" (para [0021]). This makes clear that not all whitish colours are within the scope of granted claim 1. Contrary to the Claimant's position, nothing hints in the patent description in the direction of the Hunter handbook and its broad interpretation of "white". The Claimant asserted based on Hunter that a white colour would be generally recognized when almost all wavelengths show 50% or more reflection, in approximately equal amounts, across the wavelengths of the visible spectrum. It claimed that this was common general knowledge of the skilled person, as e.g. explained in the colour handbook "The measurement of appearance" by R.S. Hunter from 1975 ("Hunter"; Exhibit VB37, p. 155):

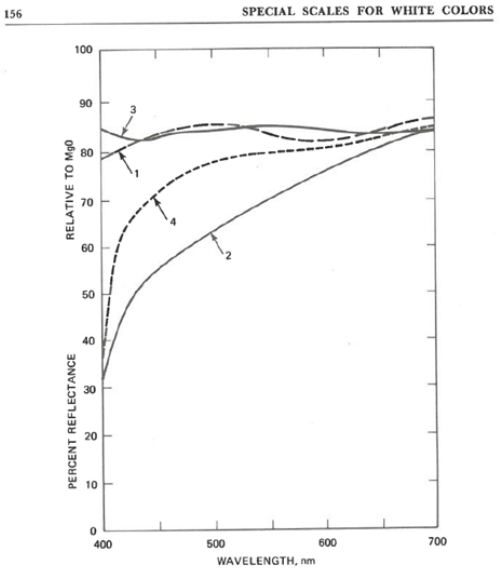
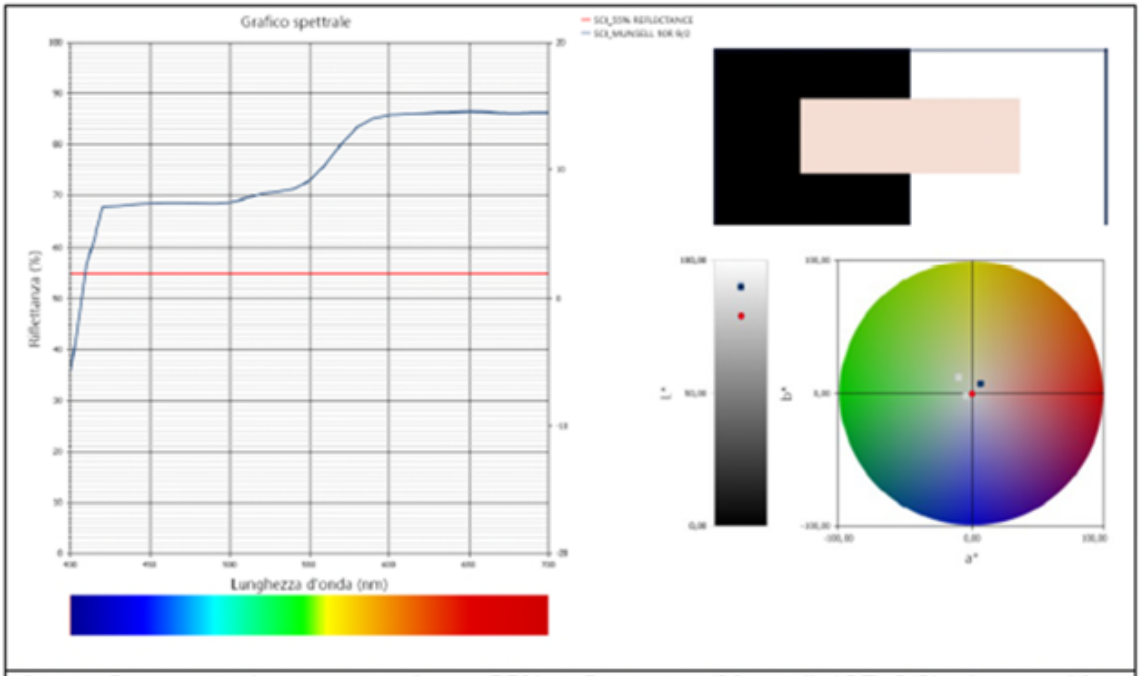


Figure 10.1. Spectrophotometric curves for four white surfaces: (1) cotton broadcloth; (2) newsprint paper; (3) porcelain enamel; (4) interior paint.

According to the Claimant there were many shades of white and grey as shown by the Hunter handbook. However, he definition in para. [0021] in fact rules out the Claimant's assertation based on Hunter, that a white colour would be generally recognized when almost all wavelengths showed 50% or more reflection. The starting point of the patent is a different one, in fact, as it discloses, as stated above, that the wavelengths have to be in "approximately equal amounts, across the wavelengths" of the visible spectrum. That means, a 50% threshold is not a relevant criterion. Still, the teaching of all wavelengths being present in "approximately" equal amounts gives the user a tolerance related to the limited perception of the human eye to detect colour nuances, which is mentioned in para [0027], cited above. The Defendants have additionally shown (comp. Rejoinder to the Reply to the Statement of Defense, p. 36) that a colour that reflects more than 50 % throughout the visible spectrum is not necessarily white:



A non-flat spectral response above 55% reflectance (Munsell 10R 9/2), the resulting colour on white and black contrast and its positioning in the CIELab diagram (see blue dot).

bb)

While it is true that [0029] describes an embodiment with achromatic *and* chromatic pigments in the base coat to provide an off-white or pale clay colour, this can no longer be considered being part of the scope of granted claim 1. Para. [0029] reads as follows:

> [0029] In a third aspect of the invention, the base coat (44) contains both a pigment for providing a chromatic colour and a pigment for providing an achromatic colour different from black. For example, one could compose a base coat containing a white pigment and one or more colour pigments to provide e.g. an off-white or a pale clay colour necessary in the decorative image. In doing so, a combination of the advantages of the first and second aspects of the invention is obtained to a certain degree, such as an improved flexibility and an enlarged colour gamut. [*Emphasis added by the Court*]

As the Defendants – and without the necessity of taking the prosecution history in all aspects into account – undisputedly stated that the Claimant deleted the term "chromatic colour" from claim 1 in order to distinguish it from US 2010/233441A1. As a consequence, the embodiment described in para. [0029] has fallen out of the granted claim 1, because it would have led to a chromatic colour in the sense of the patent. The same applies for example 3, which is clearly no longer a part of the invention as the base coat would be "pale yellow" and therefore cannot be achromatic, either. The unchanged remainder of para. [0029] apparently is a mistake like the similar one in claim 10. The inconsistency is also evident in other parts of the description. There are several passages mentioning "chromatic" in the specification of the patent that should have been deleted: page 3, line 56 in the first definition of the invention and page 6 lines 17 and 45. It is immediately apparent that the specification is not consistent with the granted claims. Comparing the clear wording of claim 1 and the description there is no basis for the skilled person to assume that ivory could be covered by the claim. This is because he or she clearly understands the teaching that the colour of the base coat cannot reach the point of having a dominant hue, like ivory, because then not all wavelengths would be present in approximately equal amounts. Chromatic and achromatic colours are mutually exclusive, and a colour only similar to achromatic is not achromatic. However,

regardless of para [0029] being outside the scope of the patent, even when considered otherwise para. [0029] could not (and does not) override the clear definition given in para. [0021] due to the necessity of legal certainty.

cc)

The Claimant's further argument that ivory would best transport the luxury look and feel of a leather product, is not supported by the description of the patent. The Claimant referred to para. [0003] which stated that leather was perceived as a luxury good. It is of the opinion that for this luxury look and feel, often 'warmer' shades of white were desirable. However, the latter is not supported by the patent. In fact, the patent in suit does not offer anything on the asserted luxury feel of an ivory coloured leather instead of a "cold" white leather. The purpose of the patent is to mask colour inconsistencies and surface defects in the surface of the crusted leather, and to increase the colour spectrum as taught in para. [0025] of the patent. According to para. [0013] it was "surprisingly" found that an inkjet printed leather exhibiting excellent flexibility, colour consistency and image quality could be obtained by using an achromatic colour different from black in a base coat (44) on a crusted leather (45). However, nothing in the description teaches something about warm or cold colours.

Serving the aim of decorated leather having high image quality and colour consistency, while not sacrificing inkjet printing reliability or physical properties like flexibility [0011], the person skilled in the art understands that the desired colour spectrum of the decorative image is the largest if the base coat is plain achromatic white as this provides for the largest colour range or scale (gamut) possible without using too much ink. The skilled person is led to this understanding by taking para. [0007] into consideration which refers to the known standards that in order to enhance colour brilliancy, often a white background is used. The patent discussed as one option to use white leather [0008]. But the patent wanted to offer an alternative to dyed white leather. It also wanted to offer an alternative to using white inkjet inks for providing a white background [0010]. The presented and claimed alternative is an achromatic base coat – at best in the achromatic white spectrum – and an achromatic grey base coat, even though that might be a less advantageous choice for the colour gamut.

This understanding by the person skilled in the art is confirmed by para. [0026] which deals with a preferred embodiment where the leather and the image have a similar colour, separated by a thin white base coat.

3.

Features 1.2 and 1.2.1

> inkjet printing a colour image (43) on the base coat (44)
>
> using one or more pigmented UV curable inkjet inks;

require the colour image being printed directly on the base coat using UV curable inks.

a)

The patent teaches in para [0041] that the colour image may comprise one or more colours:

> [0041] The decorative image may consist of a single colour or it may include multiple colours such as black, white, cyan, magenta, yellow, red, orange, violet, blue, green and brown.

On the one hand, this does not foresee an intermediate layer between the base coat and the colour image as this could prevent the base coat from participating into the creation of the coloured image according to features 1.5 – 1.5.3 (see below). It is convincing that the pigmented base coat

masking all defects allows that the image can be printed immediately on the base coat, thereby avoiding a disadvantageous inkjet printed underlayer. Para [0160] teaches that there is a trade-off between image quality and flexibility (comp. also para. [0138]) and an additional intermediate layer has disadvantages in terms of flexibility. On the other hand, the description shows that the coloured image itself can consist of multiple layers, thus including a white base layer within the colour image as the known printing technology using one or more print heads, para [0084], or a multi-pass printing mode is that the UV curable inkjet ink is cured in consecutive passes, para. [0090]. In this respect an intermediate white ink layer could be present as it could be defined being a part of the colour image forming the decorative image (together with the base coat) – and the colour image thus still being printed "on" the base coat. A distinction between the "white intermediate ink layer" and the "printed colour image" is not demanded, as both are applied consecutively in the same manufacturing step of applying the colour image. The "surprising" findings of the inventor cited in para [0013] refer to the fact that it is possible to use inkjet printing and to combine it with an achromatic colour different from black in a base coat (44), but not the dropping of any multiple-layer printing or the absence of a white ink layer. Improved flexibility is not claimed by itself.

b)

The one or more used inkjet ink(s) must be UV curable inks. The Patent explains in par. [0073] and [0074] that such inkjet inks contain polymerizable compounds (monomers or oligomers) as well as one or more photo initiators, which allow UV curing. Furthermore, the inks may contain a co-initiator and additives (par. [0080] and [0082]). This feature is clear.

4.

Features 1.3 and 1.4 are both optional features and regard further manufacturing steps of applying a top coat on the image (feature 1.3) and applying a heat pressing or embossing step (feature 1.4). The features are clear and undisputed.

5.

Features 1.5 – 1.5.3

1.5.1 the achromatic colour different from black of the base coat

1.5.2 and the inkjet printed colour image

1.5.3 are used in combination to provide the decorative image

teach that the colour of the base coat and the inkjet printed colour image are used in combination to provide the decorative image. The Patent defines that the word "combining" is to be understood as that the colours in the decorative image are the result of the colours of the colour image and the colour of the base coat (par. [0013]). This allows for two ways of colour combination: One option is that the colour of the base coat itself can be visible in the decorative image as part of the image. The other option is that the colour of the base coat influences the perceived colour of the printed colour image, and enhances the colour gamut of the decorative image (par. [0025]).

VI.

Claim 10 protects a decorated natural leather obtained by way of the manufacturing method of claim 1. It claims a decorated natural leather which is characterized by the same features, formulated as device or product features, with the presence of a protective top coat that is mandatory. Hence, the features of claim 10 are to be interpreted in the same way as the features of claim 1. The parties share this opinion. Nevertheless, the Court remarks that claim 10 does not specify that the pigmented UV curable inkjet printed colour image (43) is inkjet printed on the base coat.

VII.

Claim 15, of which an infringement is not asserted by the Claimant, constitutes an independent use-claim that regards the *use* of an achromatic colour different from black in a base coat on a crusted leather (feature 15.0). Reference can be made to the interpretation set out above as neither party has discussed the interpretation of claim 15 in detail. In particular, the Defendants consider that claim 15 has essentially the same features as claim 1 and that the features of claim 15 correspond to features 1.1/1.1.1, 1.2/1.2.1 and feature group 1.5.

It has to be noted, though, that claim 15 differs from 1 and 10 as the word "pigment" is not used, which, again, leads to the interpretation that the base coat as a whole must have an achromatic colour, because it reads as follows: "use of an achromatic colour different from black in a base coat". According to feature 15.1, the achromatic colour in the base coat is used in combination with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather. When compared to claims 1 and 10, claim feature 15.1 is furthermore missing the features "UV curable" and "pigmented", thus, any type of inkjet ink could fulfil feature 15.1.

As a reaction to the counterclaim the Claimant requested as an auxiliary request to delete claim 15 as a whole (exhibit VB-R04A).

C. Counterclaim for Revocation

In light of the construction of the features of the granted claims 1, 10 and 15 as established above, in particular of feature 1.1.1. (above sect. B. IV. 2.), none of the written pieces of prior art are novelty destroying (following under sect. C. I., II. and III.). To the extend the Defendants attacked the presence of an inventive step in their written submissions, granted claims 1 and 10 also prove to be inventive (following under sect. C. IV.).

Regardless of the disputed availability of the Flora products on the market before the priority date, and the detectability of their features, the Flora products are neither novelty destroying (following under sect. C. V.) nor cast doubts over the presence of an inventive step (following under sect. C. VI.).

I. Novelty of claim 1 over written prior art

1. General

In order to be considered part of the state of the art (Art. 54 (1) EPC), an invention must be found clearly integrally, directly and unambiguously in one single piece of prior art and in its existing form, it must be identical in its constitutive elements, in the same form, with the same arrangement and the same features (LD Munich, 31.07.2024 – UPC_CFI_233/2023, ACT_547520/2023, p. 21). For lack of novelty to be found, each and every feature of the claimed subject-matter must be derivable directly and unambiguously from one single prior art document. This question must be answered from the vantage point of the notional skilled person, taking into account this person´s common general knowledge at the publication date of the cited document in the case of prior art cited under Art. 54(2) EPC(LD Düsseldorf, 28.01.2025 – UPC_CFI_335/2023, ACT_578607/2023, p. 46).

For the purposes of assessing novelty it is not relevant which problem is solved by a prior art document as long as the problem is not a feature of the claim or construed as such. Relevant is a feature-by-feature comparison of a claim with the teaching of a document of the prior art showing that all features are disclosed in combination by said prior art document. The decisive point is whether a prior art document discloses a composition that contains all the ingredients required for falling within the ambit of the claim. If such composition is described, for example, in an

individualized form in an example of a prior art document, this is sufficient to deny novelty (LD Düsseldorf, 28.01.2025 – UPC_CFI_335/2023, ACT_578607/2023, p. 46; CD Munich, 17.10.2024 – UPC_CFI_252/2023, ACT_551180/2023, p. 33). Nevertheless, in assessing novelty, it is not possible to combine different passages or embodiments of a document, except if the corresponding combination is derivable directly and unambiguously by the skilled person reading this document.

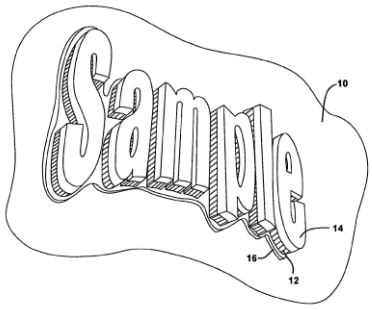
2. Lack of novelty of claim 1 based on Document HLAR 7 (US 7,891,799 B2)

Based on these requirements the Defendants' attack on the novelty of the patent in suit based on the US-patent US 7,891,799 B2 (HLAR7), published on 22 February 2011, remains unsuccessful.

a)

HLAR7 regards a multi-phase system for ink jet printing a metallic effect onto a substrate having any of a rough of uneven surface. Feature 1.0 - *A manufacturing method for decorating natural leather with a decorative image including the steps of* - can be generally seen as disclosed in the section cited by the Defendants (col. 4, lines 8 to 14) which teaches "leather" as one of many possible substrates (comp. also claim 13 of HLAR 7). This could mean artificial or natural leather. But as leather is cited as an example of rough, coarse or uneven surfaces, the natural reading of the skilled person of the term "leather" in this context would be leather in the sense of natural leather. Crusting a leather is an essential step before the application of a base coat onto leather and the skilled person therefore understands that the described processing must be applied to crusted leather (comp. HLAR 5, p. 5). The Court therefore concludes that for the skilled person reading HLAR7, "leather" implicitly means „crusted natural leather".

The document furthermore teaches the use of an undercoat layer that can optionally be printed on the substrate prior to applying the first ink jet ink in col. 1 lines 57ff. and shown in figure 2 of HLAR7, wherein first an undercoat layer (16) then a reflective coating layer (12) and then a protective coating layer (14) are applied to the substrate (10)



b)

The document discloses that "in various embodiments" the said undercoat layer may be substantially colourless, in other substantially opaque or comprise a pigment or dye (col. 1, lines 62 ff.). Finally, it discloses in order to enhance embodiments printing to a substrate having a dark colour it may be advantageous in some embodiments to provide an undercoat having a white or other light pigment (col. 1, lines 67 ff.). Also col. 4 refers to the undercoat, which is taught to be substantially colourless or may include one or more colorant, such as dyes, pigments, and mixtures thereof (col. 4, lines 50 ff.; see also. claim 11 and 12 of HLAR 7). The document discloses to increase the metallic effect by making the undercoat white such that transmitted light is scattered back through the metallic coating. This white undercoat might be obtained by titanium dioxide (col. 4, lines 60 ff.). Thus, the document shows the use of a white undercoat as one option (out of many).

Nevertheless, col. 4 lines 55-65 is advantageous for a dark coloured substrate. The Court shares the view of the Defendants that this teaching is not disclosed directly and unambiguously for the specific case of leather that has not as a general feature a particularly dark colour.

Moreover, the Defendants referred to col. 4 lines 37-39 teaching that "In various embodiments, the layer may be jetted onto the substrate as an inkjet formulation using a standard inkjet printing head." The Court considers that an inkjet printed layer does not correspond to a base coat according to the patent. Even though, col. 4 lines 31-33 specify that the undercoat composition may be deposited as a layer on a substrate by any suitable method that can apply a continuous layer, there is no clear and unambiguously teaching that the embodiment of col. 4 lines 60-65 applies i) to a natural leather and ii) to an undercoat which is not an inkjet printed layer. In fact the passage in col. 4 lines 60-65

> "The metallic effect may be increased in this regard by making the undercoat white such that transmitted light is scattered back through the metallic coating. This white undercoat may be obtained, for example, by using titanium dioxide dispersed with a suitable dispersion in a UV Matrix."

is the only one mentioning a white colour for the undercoat and is neither connected to a natural leather nor to an undercoat which is not an inkjet printed layer. In addition, as the Claimant rightfully pointed out, adding a small amount of any chromatic pigment or mixtures of pigments to an achromatic pigment might be crossing the boundaries of an achromatic base coat as defined in the patent. Without any further indication the skilled person has no reason to evaluate whether this composition in HLAR 7 would lead to an achromatic ("white") base coat, excluding chromatic whitish tones, and certainly would not lead to achromatic grey tones. The document does not disclose anything about the range of whites, the differentiation between chromatic and achromatic (white-)colours and their boundaries in terms of wavelengths.

It has to be born in mind that the use of a white background or material in general was already cited by the patent as being state of the art in order to enhance colour brilliancy, one option being to use white leather, para [0007] and 0008]. Against this background, the patent in suit wanted to offer an alternative to dyed white leather or to using white inkjet inks for providing a white background [0010]. Therefore, it remains doubtful whether the patented solution using an achromatic base coat (excluding black) is clearly and unambiguously disclosed in the cited sections of HLAR 7. In the end, the person skilled in the art would need the patent in suit and its description to come to the patented teaching and the presented idea to use an achromatic base coat, where all wavelengths are reflected in approximately equal amounts, within the vast range of achromatic and chromatic white colours in order to apply a base coat containing a pigment for providing an achromatic colour (different from black) onto leather.

c)

According to HLAR 7, the reflective coating layer is provided by powders and/or nanoparticles of a metallic material (cf.HLAR 7, col. 5, lines 25 to 33). Such a reflective coating layer, which is formed when the metallic material is deposited on a substrate, is a metal layer/metalliclayer. However, the skilled person is well aware that metallic materials can have a colour and thus would enable a colour image in the meaning of the patent in suit.

Additionally, UV curable ink is disclosed for the undercoat and one of the link layers like feature 1.2.1 - *using one or more pigmented UV curable inkjet ink*. A UV curable first inkjet ink is used to print the colour image colour image ("smooth reflective coating layer"), col. 7, lines 50 to 58 of HLAR 7. However, this disclosure is one that must be selected from a list of possible curing methods and is not the preferred curing method, as depending on the substrate thermal curing would be preferred.

d)

As a result, this document cannot be considered to contain a clear and unambiguous disclosure of all features of claim 1 in combination (and neither of claims 10 or 15), as regarding the other

features, the person skilled in the art still would have to make several selections to arrive at the subject matter of claim 1 of the patent in suit. HLAR 7 does not disclose a composition that contains all the ingredients required for falling within the ambit of the claim, neither as a preferred embodiment nor in an individualized form in an example.

3. Lack of novelty based on document HLAR 8 (JP 2010-185054 A 2010.8.26)

Claim 1 of the patent in suit is novel with regard to document HLAR 8, which is a Japanese patent application, published on 26 August 2010 (publication number 2010-185054A; translation available in HLAR8a). Despite addressing a whitish base coat, it does not disclose an achromatic base coat in the meaning of feature 1.1.1.

a)

HLAR 8 relates to printed leather objects according to feature 1.0 of claim 1 of the patent in suit. It describes as the problem that the known printed leather object has a configuration in which at least three layers of a base coat layer, an ink accommodating layer, and a top coat layer are provided on a leather surface which leads to the problem that the manufacturing process becomes complex and flexibility is insufficient due to an increase in the thickness of the entire laminate [0004]. It proposes as solution a base coat layer comprising leather and a cationic fatty acid condensate and a binder resin formed on the leather's surface and a top coat layer formed on the base coat layer such that an image based on ultraviolet curable ink is formed without providing an ink receiving layer on the base coat layer, para. [0005].

HLAR 8 discloses in para. [0007] the processing steps of leather and in particular re-tanning, dyeing and greasing of leather, which clearly includes crusted leather. HLAR 8 states that the tanning process irreversibly changes "skin" to "leather", hence, a natural leather must have at least undergone the tanning process.

b)

Against the background that feature 1.1.1. of claim 1 of the patent in suit requires that the final base coat colour is achromatic the document HLAR 8 is not novelty destroying. The fact that the document discloses a base coat composition containing a white pigment in the example in paragraph [0031], only leads the skilled person to the conclusion that the base coat *contains* an achromatic pigment:

> "[0031] (2) As shown in Table 2 in the preparation of the base coat layer forming composition,
>
> • a total of 877 parts of pigment (Clariant product Neosan 2000 White: 92.32 parts, Neosan 2000 Black: 0.82 parts, Neosan 2000 Yellow 01: 6.58 parts, Neosan 2000 Bordeaux: 0.25 parts, Neosan 2000 Blue: 0.03 parts) […]"

As the document does not make any statements on the overall colour of the base coat, the person skilled in the art does not draw the conclusion to the base coat resulting in an achromatic colour. On the contrary, the passage in para [0031] shows a yellow portion with 6,58 parts, resulting in a chromatic colour, thus feature 1.1.1 is not disclosed in HLAR8a and so is not features 1.5.1. to 1.5.3.

c)

Nothing else can be drawn from the coloured piece of leather presented by the Defendants first time in the oral hearing with the – contested – assertion that it was made in accordance with the passage in para [0031] of HLAR 8. The introduction of this physical evidence after the closure of the written procedure and the closure of the interim procedure only in the oral hearing, which was objected by the Claimant, was undoubtedly late filed and missed the necessary permission by the

Court according to R. 36 RoP. As the judge-rapporteur had explained to the parties in the interim conference the procedure to present physical evidence in the oral hearing demands that it is filed in advance and needs the observance of a special workflow in the CMS asking for permission (see ORD_64525/2024 in App 64523/2024, dated 20.12.2024). Whereas the Defendants put this procedure into practice with regard to pieces of the attacked embodiments and the Flora bags, they did nothing alike regarding said piece of leather. Hence, the panel dismissed the introduction of this evidence in the oral hearing.

4. Lack of novelty based on HLAR 9 (US 7,520,601 B2)

Claim 1 remains novel with regard to the US patent US 7,520,601 B2, that was granted on 21 April 2009.

a)

HLAR9 regards a printing process for ink-jet printing a radiation curable image on a substrate. It aims at a printing process wherein the resolution of an image can be accurately controlled on a wide variety of ink-receivers and whereby the image exhibits a high glossiness [col. 3, lines 6 ff].

Leather is disclosed as one of many possible substrates [col. 5 lines 47-52]. However, this can mean artificial or natural leather. Contrary to HLAR7, there is no mentioning of a rough or coarse surface. Thus, natural leather is not unambiguously and clearly disclosed, and the skilled person has no reason (and no incentive) to consider treatment procedures typically applied to leather being meant by HLAR 9, hence would not consider crusted leather being part of its teaching.

b)

HLAR 9 discloses in col. 7, lines 52 to 54, a "radiation-curable liquid layer [that] may further contain a colorant or a white pigment such as titanium oxide, although preferably the layer is a clear liquid layer" (see also claim 7: "*The printing process according to claim 1, wherein said radiation curable liquid layer is a white liquid layer*"; whereas claim 6 discloses a clear liquid layer). Apart from the fact, that a liquid layer cannot be seen as a base coat, HLAR 9 does not disclose feature 1.2 – *inkjet printing a colour image (43) on the base coat (44).* This isbecause the ink jet ink is not jetted onto but instead *into* the radiation curable liquid layer in step b) of the printing process of HLAR9 (see claim 1 "b) jetting a first radiation curable ink-jet ink droplet into said radiation curable liquid layer"). The next step c) consists in "curing said radiation curable liquid layer containing said radiation curable ink-jet ink droplet. This argument is further underlined by figures 1b and 1c of HLAR 9:

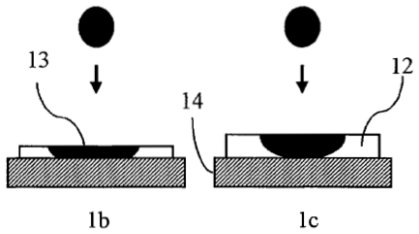


Figure 6: Figures 1b and 1c of HLAR9.

Claim 1 of HLAR 9 as well as the figures 1b and 1c describe and show that the ink is jetted into the liquid layer, therefore there is no step corresponding "inkjet printing a colour image on the base coat" (feature 1.2 of the patent). In addition, that means that the base coat and the ink printing do not in combination form the decorative image in the meaning of features 1.5.1 – 1.5.3 as the base coat and ink are no longer separate layers, but a single layer.

II. NOVELTY OF CLAIM 10 OVER WRITTEN PRIOR ART

Claim 10 of the patent in suit is a product claim comprising similar features as claim 1. Additionally, to the features of claim 1, the decorated natural leather of claim 10 requires a protective top coat as a mandatory feature. This means, the validity of claim 10 has to be evaluated in the same way as novelty of claim 1. Claim 10 is novel for the same reasons as claim 1. In order to avoid repetition reference can be made to the discussion of novelty regarding claim 1 stated above.

While the Defendants initially argued that with the Patentee's assumed broad claim construction, HLAR 9 disclosed all features of claim 1 and therefore would also disclose features 10.0 to 10.3 and 10.5 to 10.5.3 of claim 10, the Court does not follow this broad claim construction (see above under sect. B. IV. 2.), and the Claimant has clarified that it did not either. Therefore, HLAR 9 is not novelty destroying,

III. NOVELTY OF CLAIM 15

Regarding claim 15, the Defendants did not submit a specific reasoning and referred to their attacks of claims 1 and 10. The subject matter of claim 15 is novel over HLAR7, HLAR8 and HLAR9 for the same reasons and laid out regarding claim 1.

Claim 15 differs from the other independent claims 1 and 10 in that the word "pigment" is not used. Since the word "pigment" is missing in claim 15, it is clear that the term "achromatic" refers to the colour of the base coat as a whole. Furthermore, claim 15 does not require that the inkjet ink for printing the colour image is UV-curable and pigmented. Despite these missing features none of the documents disclose the combination of the achromatic base coat with the ink – even though not necessarily being UV-curable – in the formation of the decorative image. Reference can be made to the discussion regarding claim 1 above to avoid repetition.

IV. INVENTIVE STEP

According to Article 56 EPC, an invention is considered to involve an inventive step if it is not obvious to a person skilled in the art from the prior art. A possible starting point in prior art is realistic if its teaching would have been of interest to a skilled person who, at the priority date of the patent at issue, was seeking to develop a similar product or method to that disclosed in the prior art which thus has a similar underlying problem as the claimed invention (CD Munich, 17.10.2024 – UPC_CFI_252/2023, ACT_551180/2023). The assessment of the inventive step requires comparing the claimed subject-matter as interpreted with the prior art, whether it would have been obvious to a person skilled in the art, starting from a disclosure in the prior art that is considered to be a realistic starting point, to arrive at the claimed solution in view of the underlying problem (comp. LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024; LD Paris, 04.07.2024 – UPC_CFI_230/2023, ACT_546446/2023; CD Paris, 21.01.2025 - UPC_CFI 311/2023, ACT 571745/2023; CD Munich, 17.10.2024 – UPC_CFI_252/2023 , ACT_551180/2023). If it was not obvious to arrive at this solution, the claimed subject-matter fulfils the requirements of Article 56 EPC. This is the case here.

1. Claim 1

The Defendants had not raised the issue of a lack of inventive step for the independent claim 1 in their written submission with regard to written prior art, apart from the question whether HLAR 7 or HLAR 9 disclose the use of crusted leather.

a)

Only regarding this individual question, the Defendants referred to the general knowledge of the skilled person and/or that he or she would combine two documents. They consider that the crusting of leather was typical knowledge of the person skilled in the field of printing technology specialized in the preparation and the processing of decorated leather articles and he or she could take that knowledge from other documents, like HLAR 5 (Reply to the Defence to the Counterclaim, para 50) or HLAR 7 (Reply to the Defence to the Counterclaim, para 77). This means that apart from the individual question of "crusted leather" the Defendants did not attack claim 1 based on lacking inventive step in their written submissions. Even if one were to assume that using crusted leather would not be inventive with respect to HLAR 7 and HLAR 9, the skilled person would still not come to the patented solution with these two documents. As stated above, HLAR 7 lacks a disclosure to use a white colour for an undercoat to a natural leather and where the undercoat is not an inkjet printed layer. HLAR 9 would still not disclose feature 1.2 – *inkjet printing a colour image (43) on the base coat (44),* because the ink jet ink is not jetted onto but instead *into* the radiation curable liquid layer

b)

Any further inventive step attacks based on HLAR 7, HLAR 8 and/or HLAR 9 insinuated in the oral hearing were dismissed by the Court as it contradicted with the general principle that the parties are under an obligation to set out their full case as early as possible (Preamble 'RoP', para. 7, last sentence) and Rule 25 RoP. An inventive step attack brought up in the oral hearing for the first time is late-filed.

aa)

Rule 25 RoP states that a counterclaim statement for revocation shall contain i.a. (b) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the defendant's proposed claim construction; (c) an indication of the facts relied on; (d) the evidence relied on, where available, and an indication of any further evidence which will be offered in support. This legal framework introduces the so-called 'front loaded' procedural system whereby a party is required to concretely elaborate his arguments and evidence in his first written pleading. The rationale behind these provisions is to ensure that the other party is aware of the factual elements and grounds upon which the claim against it is based, as well as the evidence available, thereby enabling the other party to prepare an adequate defence, and, at the same time, to expedite the proceedings. This is one of the primary objectives of the Court, which would be undermined if a counterclaimant were permitted to gradually introduce new factual circumstances, new legal arguments, or new evidence into the proceeding (CD Paris, 21.01.2025 - UPC_CFI 311/2023, ACT 571745/2023 para. 21).

bb)

Consequently, a counterclaimant cannot introduce new grounds of invalidity of the attacked patent or introduce new documents considered novelty destroying or convincing starting points for the assessment of lack of inventive step in the oral hearing (LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024; even stricter. CD Paris, 27.11.2024 – UPC_CFI_308/2023, para 27). The formulation of a new inventive step attack in the oral hearing has to be seen as an amendment of the counterclaim pursuant to R. 263 RoP, which would require admission by the Court. This amendment has been rejected pursuant to R. 263 (2)(a), (b) RoP – or at least as late-filed in accordance with R. 9.2 RoP – as the Defendants should have raised this attack with due care in the counterclaim rejoinder at the latest (comp. LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024).

Also, taking the circumstances of the present proceeding into account, there was no reason to wait with an inventive step attack against claim 1 based on HLAR 7 or HLAR 9 until the oral hearing, which was making it impossible for the other party (and the Court) to prepare.

2. Claim 10

The Defendants brought forward an inventive step attack in their written submissions based on document HLAR 9 (US 7,520,601 B2) against claim 10. This attack remains unsuccessful.

a)

Based on the claim construction of feature 1.2 the document HLAR 9 is no suitable basis to successfully question the inventive step of claim 10. This is regardless whether a skilled person would know protective top coats, for example from HLAR 7 (cf. col. 6, lines 58 to 63 of HLAR 7) or from HLAR 8 (cf. para. [0023] of HLAR 8a) and would according to the Defendants then apply a protective top coat on top of the colour image of HLAR 9. Still, as stated above, HLAR 9 does not disclose that the colour image is to be printed onto an (achromatic) base coat. The document does not lead to a base coat and the ink printing forming *in combination* the decorative image in the meaning of features 1.5.1 – 1.5.3 as base coat and ink are no longer separate layers. In this respect reference can be made to the discussion with respect to claim 1 in the light of HLAR 9, which shows that the colour image is jetted *into* the base coat (cf. claim 1 of HLAR9), not onto.

b)

Claim 10 is inventive in light of a combination of document HLAR 9 with HLAR 7 or of document HLAR 9 with HLAR 8.

aa)

The Defendants argue that the objective technical problem of feature 10.4 – and a protective top coat (42) – was that the top coat protects the underlying colour image. They are of the opinion that the documents HLAR 7 and HLAR 8 disclosed this feature. On the search to protect the colour image of HLAR 9, the skilled person would become aware of HLAR 7 and HLAR 8 as both documents were also directed to printing a colour image on a base coat. According to the Defendants HLAR 7 disclosed that a protective coating layer should be applied. As the name suggests, this layer protected the other layers against external influences. In addition, also HLAR 8 disclosed that the top coat protects the leather product from damage (wear) in para. [0019] of HLAR 8a.

bb)

This inventive step attack remains unsuccessful. Even by applying a top coat on the last layer of HLAR 9, the skilled person does not arrive to the claimed invention. Indeed, HLAR 9 does not describe inkjet printing a colour image on a base coat (feature 1.2 of the patent), nor that a base coat and the ink printing are used in combination to form the decorative image in the meaning of features 1.5.1 – 1.5.3 as the base coat and ink are no longer separate layers, but a single layer. The skilled person has no hint to change the solution proposed by HLAR9 that implements jetting a first radiation curable ink-jet ink droplet into said radiation curable liquid layer. Indeed, even a combination with HLAR 7 or HLAR 8 would not lead the skilled person clearly and unambiguously to utilize a UV curable inks to print an image on an achromatic base coat and to combine them together to form the decorative image according to the solution of the patent in suit.

The same applies for a combination with HLAR 8 as this would not give an incentive to separate the base coat and the ink layers. Furthermore, it does not lead to the idea to use an achromatic base coat, as HLAR 8 shows in para [0031] yellow with 6,58 parts, resulting in a chromatic colour.

3. Dependant claims

As the independent claims remain novel and inventive with respect to the attacks formulated by the Defendants the same applies to the dependent claims 2 to 8 and 11 to 14.

V. NOVELTY OVER PUBLIC PRIOR USE

The independent claims 1, 10 and 15 are novel also with respect of public prior use by the Flora products. The same applies to the dependant claims 2 to 8 and 11 to 14.

1.

As a measure of defence, the Defendants have the burden of proof that the Flora products were publicly available on the market in 2017 before the priority date of the patent.

a)

The Defendants met this requirement with their submissions of an excerpt of the worldwide direct sales data (HLAR21), receipts (HLAR14), a table showing the website traffic of the website with the Flora Bag (HLAR15) and other publications such as excerpts from an editorial and from fashion magazines (HLAR16), two witness statements, one regarding the sales data (HLAR17) and one regarding the manufacturing process (HLAR19). Already this evidence provided leaves little room for doubt that the Flora products were on sale prior to the filing of the patent in suit.

b)

The additional evidence provided by the Defendants with submission 28 June 2024 regarding a purchase of a Flora Wallet (with the original sales receipt) from a second-hand store (exhibits HLAR 37 – 41), which was admitted by the Court (see above in sct. A. III.), strengthens the position of the Defendants'. Regardless of the admittance of this evidence, it has to be pointed out that it is not relevant for a public prior use defence whether the pieces of prior art consisted of bags, wallets and loafers or one of them or all of them. Therefore, the Claimant's criticism is negligible that the physical and chemical analyses were carried out on *one* specific Flora Bag and *one* specific Flora Loafer. However, as discussed in the next section this question is not relevant for the outcome of the decision.

2.

The Court is convinced that all Flora products comprise a chromatic, ivory-coloured base coat, which means that the Flora products are not showing all features of claim 1, especially not feature 1.1.1.

a)

The Court sides with the Claimant's argumentation (comp. Revocation Rejoinder, para 94) that, all presented evidence relating to the Flora products taken into account, the Defendants' test reports failed to show the presence of an achromatic base coat in the meaning of the patent. Against the background of the definition provided by the patent in para [0021] a colour is achromatic if there is no dominant hue, which means that all wavelengths are present in approximately equal amounts. Therefore, it is neither sufficient to prove that the base coat is containing a white pigment, like titanium dioxide, nor to measure a chroma C*-value.

Added to this, the Claimant's assumption is correct due to the fact that the Claimant did not contest the Defendants' assertion in the Counterclaim for revocation in para 289 ff., that the resulting colour of the base coat is ivory (para 289). The Claimant criticized that the Defendants' analyses of the prior use products would not represent a technical teaching that the skilled person could derive from the Flora products without hindsight. But, the Defendants themselves showed

that the base coat of the Flora products, e.g. like the Flora Wallet, is *ivory* (comp. Position "3" of Sample C, cf. Figure 3 of HLAR 31). As the claim does not only require adding an achromatic pigment, it is not sufficient that the base coat is containing titanium dioxide. In fact, the Defendants proved that in the base coat of the Flora Wallet titanium dioxide TiO_2 was used to provide as they themselves claim (in combination with other pigments) an ivory colour of the base coat (cf. Figure 3 of HLAR 31). As defined above, ivory is a chromatic colour and thus not within the scope of feature 1.1.1., rendering the Flora products not be novelty destroying.

b)

The same applies to the Flora Loafer. Despite the fact, that the Defendants stated that the chroma C* of the base coat of the Flora Loafers amounts to 11.45, which was smaller than the chroma C*=13.65 of the base coat of the Pikarar Padlock Bag, for which the Patentee argued an alleged infringement of the patent, the Defendants have not proven that the Flora Loafer comprises an achromatic base coat. Also in this regard, the burden of proof lies with the Defendants. The Court sides with the Claimant that it is not sufficient to fulfil the burden of proof by referring to a particular deviation from the chroma C* value to establish whether a colour that is printed on leather is achromatic in the meaning of the patent (Revocation Rejoinder, para. 12). For the definition in the patent in suit in its para. [0021] the sole measurement are the wavelength and an assessment whether they are present in approximately equal amounts, like the Defendants did with the alleged infringing objects. Therefore, it is not decisive that the skilled person most likely would not assume that a colour with a chroma C* value that high is achromatic, anyway.

c)

According to the above, the Court can leave open the highly contested question whether or not the Flora products enabled the skilled person –or a team of experts to carry out the necessary analyses – to detect the use of UV curable ink and if this information could be considered to be available to the public (by reference to Article 54(2) EPC, defining the state of the art). As the base coats of the Flora products are not achromatic it is not decisive whether the Defendants have satisfied their obligations with regard to the burden of proof as they rely on in-house knowledge regarding the inks used as this might not be public knowledge and not necessarily in the domain of an engineer specialized in the preparation and the processing of decorated leather articles. The problem circles around the point that the skilled person probably did not know which inks were used and therefore did not know what to look for. As the Flora products consist of a chromatic base coat these questions can remain unanswered.

3.

For the same reasons laid out above the Flora products are not novelty destroying with respect to claims 10 and/or the dependent claims. This also applies to claim 15, which is not even requiring UV curable inks, thus any type of inkjet ink could fulfil feature 15.1, but requires the use of an achromatic colour in a base coat. The same applies to the inventive step attacks against the dependent claims 2, 5, 6, 9 and 11 (Counterclaim for Revocation, para. 300 ff.)

VI. INVENTIVE STEP OVER PUBLIC PRIOR USE

The independent claims 1, 10 and 15 are inventive with respect of public prior use as the Defendants did not challenge the inventive step with regard to the independent claims based on the Flora products.

1.

Even though the Defendants stated in para 363 of the Counterclaim for Revocation regarding the Flora Loafers that the "independent claims and the dependent claims lack novelty or an inventive

step over the Flora Loafers because the Flora Loafers were manufactured essentially the same way", they did not elaborate an inventive step attack against the independent claims based on the Flora products, and in particular did not address the (a)chromaticity question with respect to inventive step. The Defendants stated in order to "avoid unnecessary repetition" not go into all the individual features and claims in detail, but to refer to the argumentation for the Flora Bag, which could in their view be applied 1:1 to the Flora Loafers. The argumentation for the Flora Bag, however, did not content any inventive step attack against claim 1 – apart from the question whether crusted leather was disclosed in combination with HLAR 5 (para. 272 ff.) and the use of pigmented UV curable ink (para. 286), discussed above. It neither entailed an inventive step attack against claim 10 nor claim 15 based on these products. The questions of a non-inventive use of crusted leather and/or pigmented UV curable ink are not of relevance with regard to the non-disclosure of an achromatic base coat in the Flora products.

2.

Any possible further inventive step attacks based on the Flora products insinuated in the oral hearing were dismissed by the Court as it contradicted with the general principle that the parties are under an obligation to set out their full case as early as possible (Preamble 'RoP', para. 7, last sentence) and Rule 25 RoP. An inventive step attack brought up in the oral hearing for the first time is late-filed (comp. above under sect. C. IV. 1. b])

Also with respect of the circumstances of the present proceeding, there was no reason to wait with an inventive step attack against claim 1 based on the Flora products until the oral hearing, that was making it impossible for the other party (and the Court) to prepare. Therefore, the Panel cannot consider the Defendants' oral argument that the Flora products would render it obvious to the skilled person to use a white base coat based on the teaching of document HLAR 7. It can be left unanswered why and if the skilled person would have had an incentive to solve a (which?) problem going from the Flora products to combine it with a white (not necessarily achromatic) undercoat from HLAR 7. It does not need further elaboration by the Court if doing so would really obviously have lead the skilled person to the solution of an achromatic ("white") base coat, excluding chromatic whitish tones, but including achromatic grey tones (comp. above under C. sect. I. 2. b).

3.

With the outcome that the independent claims are inventive, the inventive step attacks based on the Flora products with regard to the dependent claims 2, 5, 6, 9 and 11 are lacking relevance to the decision.

VII. AUXILIARY REQUESTS

As the patent is found valid the condition for the Claimant's auxiliary requests did not materialise rendering it unnecessary to discuss the auxiliary requests.

D. INFRINGEMENT

The infringement action is not successful on the merits. The Court finds that the attacked embodiments do not make use of all features of claim 1, as their base coats are not achromatic and thus not fulfilling feature 1.1.1. (following under sect. D. I). While the Pikarar Loafers' chromatic base coat is the closest to achromatic, the Claimant did not prove that the Defendants used UV curable ink for them (following under sect. D. II). Therefore, the Court does not need to answer the question whether feature 1.2 can be seen as utilized as some of the attacked embodiments comprise an intermediate white ink layer (following under sect. III.). The same

applies for the other claims the Claimant sees as infringed (following under sect. IV.). The private prior use defence is therefore not of importance to the outcome of the decision

I.

The Claimant relies on an infringement of claims 1, 3, 4, 5, 6, 7, 10, 12, 13 and 14 of the patent in suit. Infringement of the granted claims 2, 8, 9, 11 and 15 is not claimed. It considers the "Padlock Gucci animal print mini bag" (=Pikarar Padlock Bag) and the "Rhyton Sneaker with animal print" (=Pikarar Sneakers) infringing the patent. Further suspected infringement products are the "Gucci animal print zip card case" (=Pikarar Card Case), the "Gucci animal print mini tote bag" (=Pikarar Tote Bag) and the "Women's Gucci Jordaan animal print loafer" (=Pikarar loafers).

The Claimant did not prove that the attacked embodiments comprise an achromatic base coat.

1.

Whereas it is undisputed that the claimant showed the presence of titanium in the base coat of the Pikarar Bag and Sneakers and concluded that titanium dioxide, a white pigment, is present in their base coats, it is disputed that their base coats are achromatic. The Claimant cannot be supported in its argument that as these products were also marketed/offered by the Defendants as "white printed leather" and "ivory printed leather" – which in the Claimant's view is a shade of white – the wording in the Defendants' offering would establish infringement already as offering was an independent infringing act under Art. 25 UPCA. The Claimant neglects in this respect that the mentioning of "white printed leather" and "ivory printed leather" are commercial descriptions and do not correspond to a technical feature of the products (VB 32). It goes without saying, that for establishing a patent infringement the actual attacked embodiments have to be patent infringing, which is making use of the patented solution, which requires the examination of the product itself.

2.

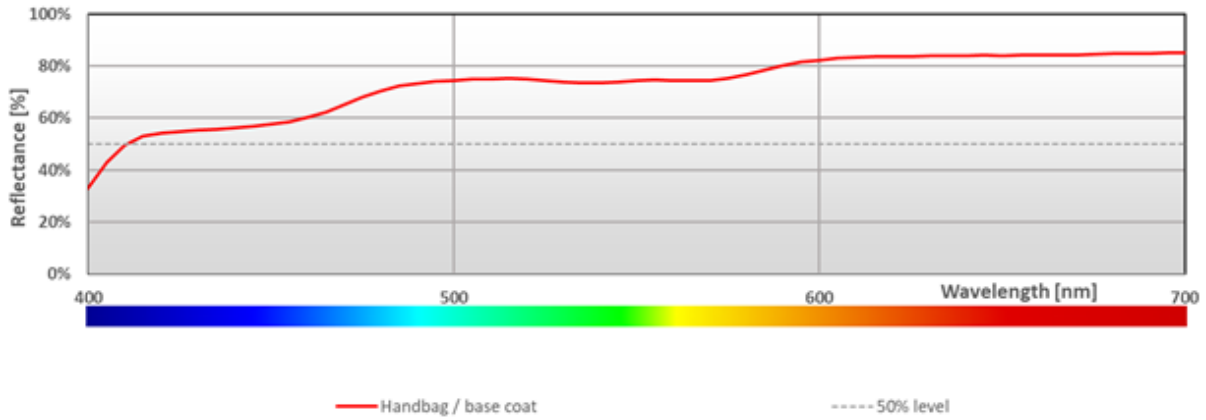
Neither the Claimant's own measurements nor the ones provided by the Defendants that the Claimant adopted prove that the attacked embodiments have an achromatic base coat.

a)

Feature 1.1.1. (in conjunction with feature 1.5.1) requires an achromatic base coat (excluding black), which demands according to the definition in para. [0021] that the colour of the base coat has no dominant colour or spectrum areas (hue), meaning that all wavelengths are present in approximately equal amounts. Contrary to the Claimant's assertion the approximal equal presence of all wavelengths cannot be decided by simply looking at the colour of the attacked embodiments. In fact, this has to be assessed by means of a spectral response. Based on the definition of the patent, a colour is achromatic if a spectral response shows approximately equal reflectance throughout the spectral response, and not, as the Claimant asserted to show an overall reflectance of above 50% throughout the spectral response (see above B. IV. 2.). Even though under real life conditions, perfectly flat spectra will rarely be observed, the teaching of approximately equal amounts gives the user a tolerance relating to the limited perception of the human eye to detect colour nuances, which is mentioned in para. [0027]. This definition is met if the colour features a perfectly flat spectrum or, if the spectrum is not perfectly flat, if the deviations from the perfectly flat spectrum are such that the difference between the colour in question and the nearest reference achromatic colour with a perfectly flat spectrum line is not perceptible to the average human observer.

b)

The Claimant, who bears the burden of proof for the infringement provided own wavelength measurements solely for the Pikarar Padlock Bag, and claims the other diagrams to be similar:



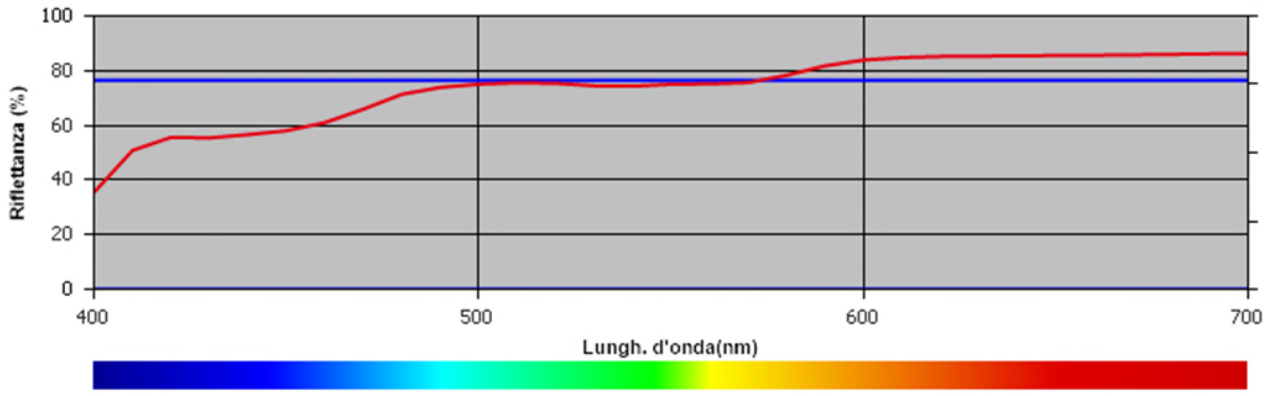
Spectral response of the base coat of the Pikarar Bags, Claimants Reply to the SoD, para 57ff.

aa)

The spectral responses provided by the Claimant regarding the Pikarar Bags however show that not all wavelengths are present in approximately equal amounts. In fact, there is a clear emphasis in the yellow-red spectrum. The spectral response of the base coat of the Pikarar Bags – even neglecting the slope near 400 nm as it is undisputed a typical spectral feature of coloured materials, especially when using organic and/or TiO_2 pigments in a polymeric binder – range from below 60% in the blue area above 420 nm to more than 80% in the orange/red area. A difference of 20 percentage points cannot be considered approximately equal in the meaning of the patent. It shows that the deviations from a perfectly flat spectrum are significant and that the wavelengths are not present in approximately equal amounts. The fact that the reflectance is throughout the full spectra above 50% is not a relevant criterion as the starting point of the patent is a different one, and a colour that reflects more than 50 % throughout the visible spectrum is neither necessarily white, nor achromatic.

bb)

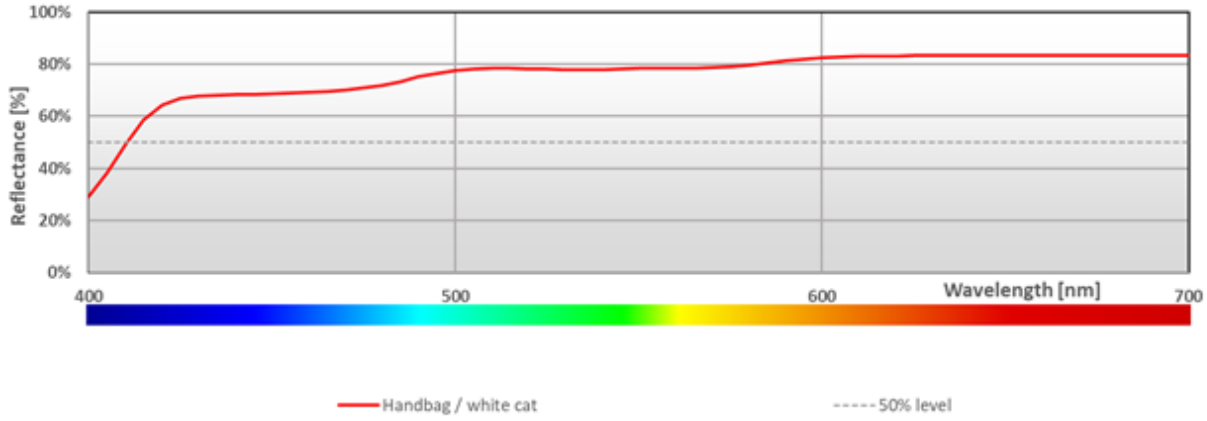
The spectral responses provided by the Claimant are in line with the Defendants' spectral response in exhibit HL20 for the Pikarar Padlog Bag confirming significant deviations from a perfectly flat curve:



c)

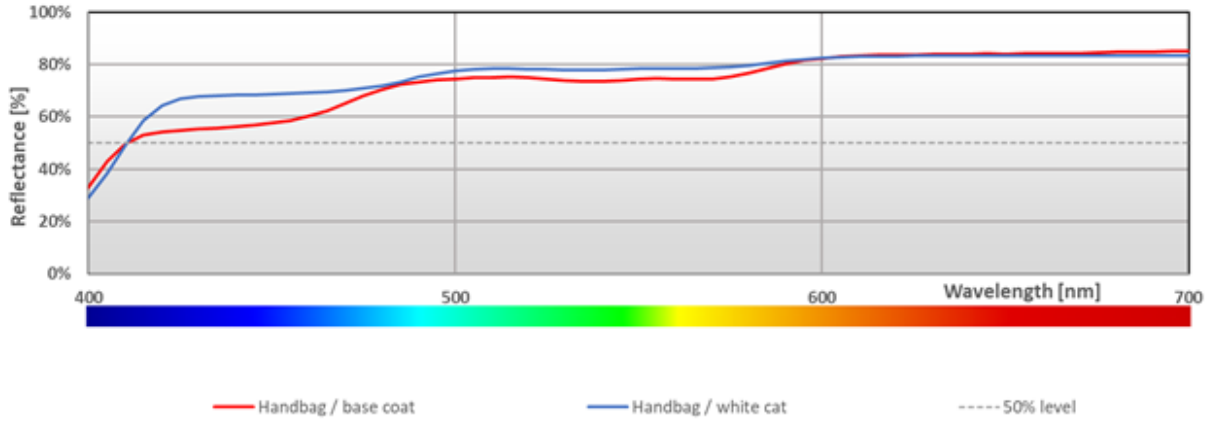
The comparison of this spectral response with the one of an inkjet-printed white part of the colour image provided by the Claimant is unsuitable to prove the opposite.

Firstly, there are significant differences between both responses looking at the spectral response of the white inkjet-part:



(Spectral response of white inkjet ink Claimants Reply to the SoD, para 60)

The spectral response of the white inkjet-part still deviates from a perfectly flat spectrum as it ranges from almost 70% in the blue area above 420 nm to just below 80% in the green-yellow area to slightly more than 80% in the orange/red area, despite the fact that the difference is significantly smaller as of around 10 percentage points. This can be clearly seen in the Claimant's own overlay of the spectral responses (the red line being the base coat and the blue line being the white inkjet-part):



(Overlay of the spectral responses in Claimants Reply to the SoD, para 62)

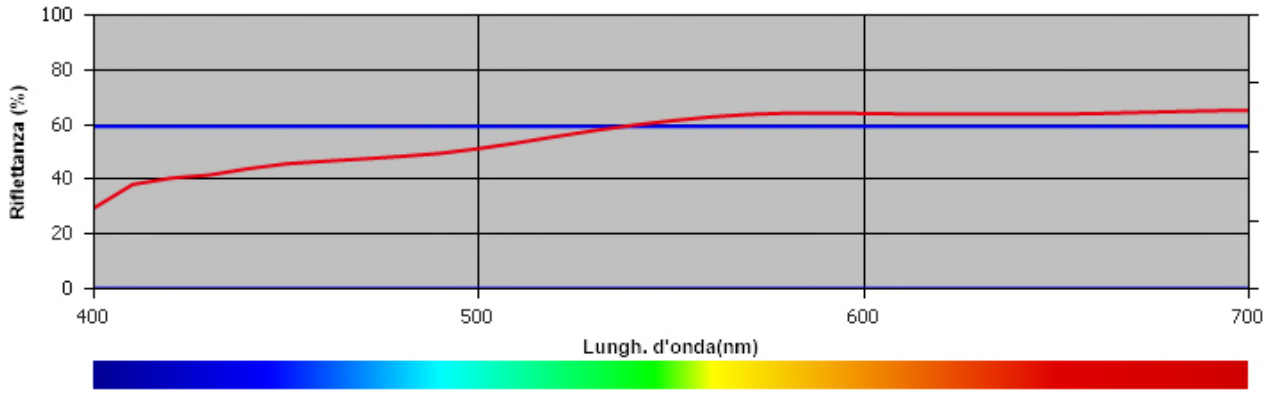
Secondly, this spectral response does not provide a pure white inkjet printing, but consists of a layer of white pigmented inkjet ink that was printed *on top* of the pigmented base coat. The Claimant concedes that the white ink layer does not fully mask the colour of the underlying achromatic base coat due to the limited opacity of white inkjet ink in combination with its thickness, so that the bright perception of the white ink in terms of its reflection is achieved in combination with the achromatic base coat that lies below it (see also [redacted] Declaration, para. 6.9). This means that as the ivory-coloured base coat still contributes to the spectral response, this comparison is unsuitable to prove an achromaticity of the base coat.

d)

Regarding the other attacked embodiments, the Claimant referred to the spectral responses carried out on behalf of the Defendants (exhibits HL21 and HL22), no infringement can be established, either.

aa)

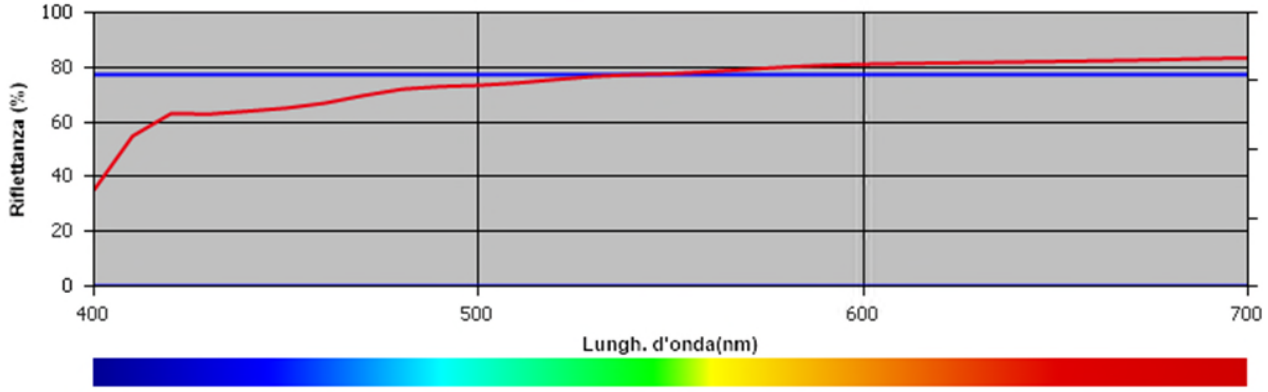
In the present case, the spectral responses of the Pikarar Sneakers show similar significant deviations from a perfectly flat spectrum and their base coat can thus not be considered achromatic:



Comp. para. 7.2 of Exhibit HL21 for the Pikarar Sneakers

bb)

When it comes to the Pikarar Loafers the curve is flatter, but still nowhere near a perfectly flat spectrum, with the spectrum in the light blue area reflecting around 70% and in the red area the spectrum above 80%:



Comp. para. 7.2 of Exhibit HL22 for the Pikarar Loafers

3.

The Court does not support the Claimant's position that in addition to the objective assessment, a subjective assessment of the colour by a trained expert could support the conclusion that a colour is perceived by the human observer as achromatic and that this would exactly be what Dr. [redacted] did with the attacked products, making it irrelevant to linger on the precise cut-off point of achromaticity. On the contrary, the Court sides with the Defendants that to the human eye the Pikarar products have a yellowish, ivory-coloured base coat (like the leather pieces shown in the Defendants' SoD, para 155 ff.). In this regard the Claimant's employee Dr. [redacted] does not provide more than his personal view. Furthermore, Dr. [redacted] apparently relied on a criterion – the 50% threshold – that is not part of the teaching of the patent itself.

4.

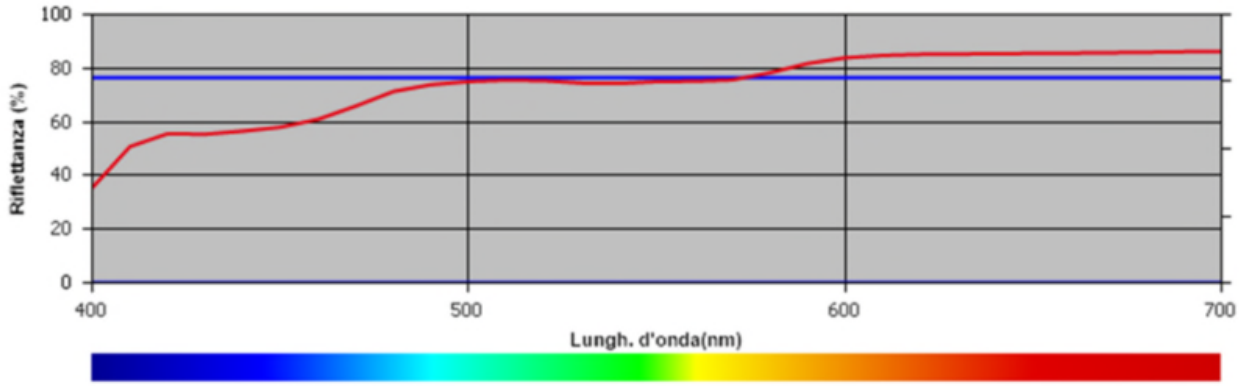
As an additional countercheck, regardless of the fact that the C*-value is not part of the patent's definition of the term achromatic, the Court sides with the Defendants that a person skilled in the art would not likely consider colours with (chroma) C*-values as high as those of the attacked

products to be achromatic. The Defendants have proven that the higher the C*-value, the more chromatic is the colour (comp. expert opinion [redacted] exhibit HL56, p. 4). Despite the Claimant's criticism that the chroma C* is a colour coordinate which is measured from a theoretical point and despite the Claimant having opposed the calculation, this can as a countercheck further confirm that the wavelengths in the Flora products are not present in approximately equal amounts.

a)

The Defendants claim that according to the Test Report Pikarar Padlock Bag (Exhibit HL 20), the base coat of the Pikarar Padlock Bag's leather showed a marked chromaticity (C* = 13.65) with a yellow dominant wavelength (576.40 nm), as reproduced here below (red spectrum). Compared to the nearest achromatic colour (blue spectrum), i.e., the achromatic colour with the same L* value but with the a* and b* set to zero, the colour difference of the sample, expressed as ΔE94, is as high as 13.65:

7.2 Spectral response

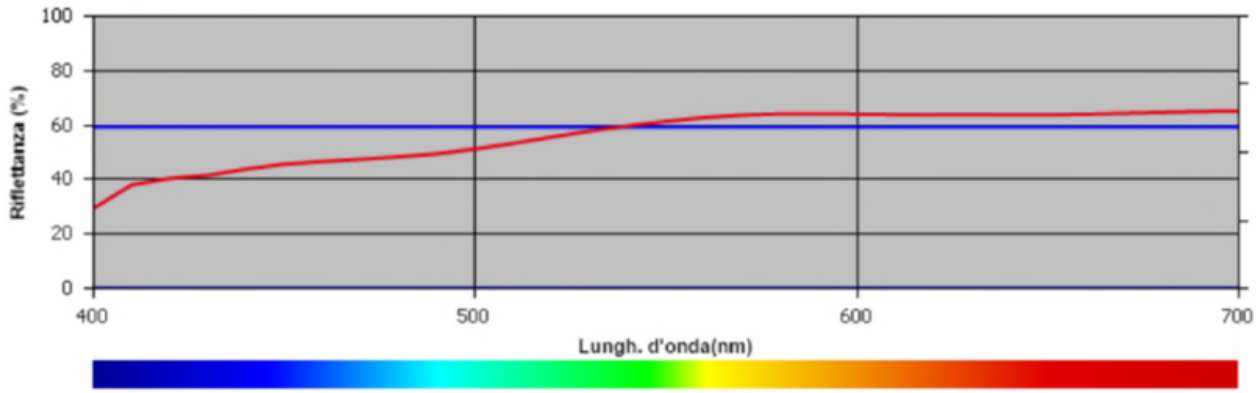


7.4.2 Chromaticity values

Absolute measurements (sample)		*Colour difference calculation*			
L*	90,12	*Theorethical achromatic reference*		*Colour difference*	
a*	0,00	L*	90,12	ΔL*	0
b*	13,65	a*	0	Δa*	0,00
C*	13,65	b*	0	Δb*	13,65
h*	90,02°	C*	0	ΔC*	13,65
Dominant λ	576,40 nm	h*	0	Δh*	90,02°
				ΔE_{94} (1)	13,65 (*)

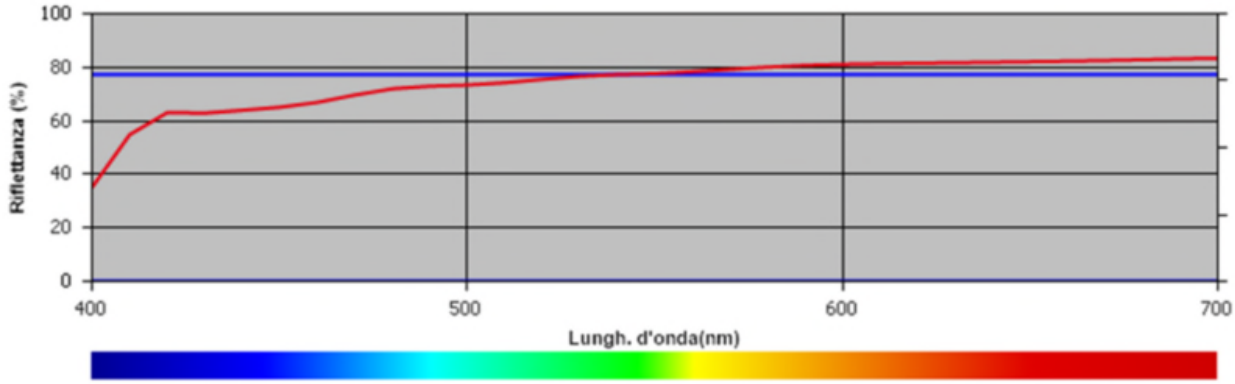
They claim that according to the Test Report Pikarar Sneakers (Exhibit HL 21), the base coat of the Pikarar Sneakers' leather showed a marked chromaticity (C* = 14.51) with a reddish-yellow dominant wavelength (575,95 nm), as reproduced here below (red spectrum). Compared to the nearest achromatic colour (blue spectrum), the colour difference of the sample, expressed as ΔE94, is as high as 14.51.

7.2 Spectral response



They further claim that according to the Test Report Pikarar Loafers (Exhibit HL 22), the base coat of the Pikarar Loafers' leather showed a marked chromaticity (C* = 9.46) with a reddish-yellow dominant wavelength (575,42 nm), as reproduced below. Compared to the nearest achromatic colour, the colour difference of the sample, expressed as ΔE94, is as high as 9,.46:

7.2 Spectral response



7.4.2 Chromaticity values

Absolute measurements (sample)		*Colour difference calculation*			
L*	90,50	*Theorethical achromatic reference*		*Colour difference*	
a*	-0,19	L*	90,50	ΔL*	0
b*	9,46	a*	0	Δa*	-0,19
C*	9,46	b*	0	Δb*	9,46
h*	91,17°	C*	0	ΔC*	9,46
Dominant λ	575,42 nm	h*	0	Δh*	91,17°
				ΔE_{94} (1)	9,46 (*)

Finally, they claim that according to the Test Report Pikarar Tote Bag (Exhibit HL 60), the base coat of the Pikarar Tote Bag's leather showed a chroma value (C*) of 13.70. Compared to the nearest achromatic colour (red spectrum), i.e., the achromatic colour with the same L* value but with the a* and b* set to zero, the colour difference of the sample, expressed as ΔE 94, is as high as 13.70.

b)

Despite the reservations stated above these measurements further confirm the already established finding that the wavelengths in the Flora products are not present in approximately equal amounts and their base coats thus not achromatic.

II.

The Claimant did not prove that the Pikarar Loafers were made using UV curable inks according to feature 1.2.1. Therefore, regardless of the categorization of the Loafers' base coat, their offering by the Defendants on the relevant markets does not justify the requested injunction.

As a general rule the burden of proof regarding infringement lies with the Claimant. In the Statement of Claim, the Claimant analysed the Pikarar Padlock Bag and Sneakers via FTIR. The claimant argues that the FTIR analysis of the black ink shows signals that can be assigned to a polyacrylic material, typically obtained via UV curing. Furthermore, pyrolysis GC-MS results show the presence of photoinitiators and (UV curable) monomers such as tetrahydrofurfuryl acrylate (THFFA) and N-vinyl caprolactam (VCL), which were specifically mentioned in paragraphs [0110] and [0111] of the patent in suit. However, the Claimant did not examine the Pikarar Loafers.

Regarding the Pikarar Loafers the Defendants have denied that the leather skins used to manufacture them have been printed *using one or more pigmented UV curable inkjet inks* within the meaning of feature 1.2.1. In fact, they have stated to have used a different technology than the rest of the attacked embodiments, namely the so called "latex inks", here having used the HP Latex R2000 Printer. Latex inks would not cure, harden or "freeze" under the influence of UV light (exhibit HL 35). The Defendants have substantiated this assertion with a written testimony and an expert report (exhibits HL 34/34a and HL 36). As the Claimant refrained from presenting further, if not to say: any, evidence regarding the asserted use of UV curable inks in the Loafers the Court inevitably has to side with the Defendants regarding this matter. Contrary to the Claimant's position, the fact that all the evidence might probably be in the Defendants' domain, this does by no means limit or reverse the burden of proof. In fact, the Claimant would have been able to counterevidence the Defendants' substantiated assertion as the Claimant itself had been able to show the use of UV curable inks for the Pikarar Padlock Bag and Sneakers via FTIR.

III.

Based on the previous findings the Court can leave open the largely debated question, whether feature 1.2 and feature group 1.5 can be seen as utilized as some of the attacked embodiments comprise an intermediate white ink layer.

1.

As far as the Claimant did not dispute that the Pikarar Padlock Bag, Pikarar Tote Bag and Pikarar Card Case all have an intermediate white ink layer on top of the base coat, apart from certain areas of the Pikarar Padlock Bag, it is disputed whether feature 1.2 – inkjet printing a colour image (43) on the base coat (44) – is realized. As explained above, feature 1.2 generally does not foresee an intermediate layer between base coat and the colour image, where and if this would prevent the base coat from participating in the creation of the coloured image according to features 1.5 – 1.5.3. Therefore, any step in the manufacturing method which results in an intermediate layer between the base coat and the colour image in these cases is consequently out of the scope of claim 1. However, in cases where and if the base coat still is able to influence the colour perception of the final decorative image – as the Claimant indicated in its comparison of this spectral response with the one of an inkjet-printed white part of the colour image (see above sect. D. I. 2. c) – such a manufacturing process would still be covered by claim 1. The Claimant has stated with the afore

mentioned comparison that the white ink layer does not fully mask the colour of the underlying achromatic base coat due to the limited opacity of white inkjet ink in combination with its thickness, so that the bright perception of the white ink in terms of its reflection is achieved in combination with the achromatic base coat that lies below it (see also [redacted] Declaration, para. 6.9). This would mean that as the ivory-coloured base coat still contributes to the spectral response, thus fulfilling feature 1.2. As said before, this point is not decisive and therefore does not need more elaboration by the Court.

2.

The same applies regarding features 1.5 to 1.5.3 – the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image. These features are fulfilled in those products, where the base coat itself is visible throughout the decorative image, i.e. in the green and pink bears on the Pikarar Padlock Bag, where the intermediate white ink layer is missing, as the whole image in combination with the base coat form the decorative image. Again, there is no necessity of elaborating this question and the evidence provided, including partly confidential declarations, by the parties.

IV.

The same applies to the asserted infringement of claim 10. Claim 10 protects a decorated natural leather obtained by way of the manufacturing method of claim 1. Hence, any infringement of claim 10 requires the same findings as an infringement of claim 1. As feature 1.1.1 is not fulfilled by the Pikarar products, because the base coat colour is ivory and not a perfect achromatic colour, the same applies to feature 10.2. Regarding the Loafers the Court cannot find the use of feature 10.3. As the independent claims 1 and 10 are not infringed an infringement of the dependant claims is ruled out.

The private prior use defence as an auxiliary defence is not relevant, when infringement is not established in the first place.

E. Conclusion

In light of the above, the infringement action and its annex requests are to be dismissed without further consideration regarding proportionality under Article 63(1) of the UPCA.

Nevertheless, a decision on the invalidity counterclaim must be issued.

In the context of the decision on costs, the Local Division has considered that the Claimant has been fully unsuccessful with regard to the claims in the infringement action, but that the Defendants have been equally unsuccessful with their counterclaim for revocation. The Claimant has stated the amount in dispute of the infringement action to be EUR 1 million. The Defendants did not object to this. The amount in dispute of the invalidity counterclaim is increased by up to 50 per cent in accordance with item I. 2. b) (2) (ii) of the 'Guidelines of the Administrative Committee for Determining Court Fees and the Ceiling for Recoverable Costs of 24 April 2023' (see Art. 36(3) UPCA, R. 370.6 RoP). Thus, the counterclaim is to be valued at 1.5 million euros and the proceedings as a whole at 2.5 million euros.

DECISION

I. The infringement action is dismissed.

II. The counterclaim for revocation is dismissed.

III. The Claimant shall bear 40% and the Defendants shall bear 60% of the costs of the proceedings.

IV. The value of the proceedings is set in total at € 2.500.000, of which € 1 Mio is attributable to the infringement action and € 1.5 Mio to the counterclaim for revocation.

DETAILS OF THE DECISION

Action Number: ACT 561734/2024
UPC number: UPC_CFI_278/2023
Action type: Infringement Action
Related proceedings: CC 309, 313, 315, 316, 319, 320, 321, 323/2024
Related proceedings type: Counterclaim for revocation
Related proceedings: APP_19083/2024
Related proceedings type: Application to amend a patent

SIGNATURES

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Presiding judge Klepsch

Stefan Schilling
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Legally qualified judge and judge-rapporteur Dr. Schilling

Camille Lignières
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Legally qualified judge Lignieres

Laure, Véronique Sarlin
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Technically qualified judge Sarlin

Carolin Bauch
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Datum: 2025.04.29 15:51:22 +02'00'

for the Registry

INFORMATION ON APPEAL

An appeal against the present decision may be filed by any party which has been unsuccessful, in whole or in part, with its requests, within two months of notification of the decision at the Court of Appeal (Art. 73 (1) UPCA, R. 220.1 (a), 224.1 (a) RoP).

INFORMATION ON ENFORCEMENT

A certified copy of the enforceable decision will be issued by the Assistant Registrar at the request of the enforcing party (Art. 82 UPCA, Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP).

INSTRUCTION TO THE SUB-REGISTRY

Based on the final value of the case (see IV. of the operational part of the Decision) the Counterclaimant has to be asked to increase its cost deposit to the Court.

This decision was announced in public session on 30 April 2025

Stefan Schilling

Digital unterschrieben von Stefan Schilling
Datum: 2025.04.30 11:12:51 +02'00'

Legally qualified judge Dr. Schilling