

Decision

of the Court of First Instance of the Unified Patent Court

Local Division Mannheim

delivered on 18 July 2025

concerning EP 3 476 616

HEADNOTES:

1. The UPC has jurisdiction to decide upon the infringement of the UK part of a European Patent. However, the UPC does not have jurisdiction to revoke the validated national part of a European Patent in relation to the United Kingdom with *erga omnes* effect (following ECJ, judgement of 25 February 2025, C-339/22, BSH Hausgeräte).
2. The defendant in an infringement action before the UPC which relates to the UK part of a European bundle patent is allowed to raise an invalidity defence without being obliged to file a national action for revocation in the UK. The UPC will then assess the validity as a mere prerequisite for infringement (following Local Division Dusseldorf, decision of 28 January 2025, UPC_CFI_355/2023). The outcome of the infringement action before the UPC has *inter partes* effect only.
3. In the absence of a pending national revocation proceeding in the UK, there neither is a reason to stay the infringement proceeding before the UPC nor to make the decision conditional upon the validity of the UK part of the European patent.
4. There is no legitimate interest of a defendant obtaining a declaration that the UK part of a European bundle patent is invalid, since such declaratory relief is not binding on the national authorities.

KEYNOTES:

Jurisdiction over a national part of a European bundle patent validated in the United Kingdom

CLAIMANT:

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

represented by: Tobias Hahn, HOYNG ROKH MONEGIER, Steinstraße 20,
40212 Düsseldorf, Germany

electronic address for service: tobias.hahn@hoyngrokh.com

DEFENDANTS:

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

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

electronic address for service: elena.hennecke@freshfields.com

2. **Kodak Graphic Communications GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by
its CEOs, at the same place,

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer
Rechtsanwälte Steuerberater PartG mbB, Maximiliansplatz
13, 80333 Munich, Germany

electronic address for service: elena.hennecke@freshfields.com

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

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer
Rechtsanwälte Steuerberater PartG mbB, Maximiliansplatz
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PATENT AT ISSUE:

European patent EP 3 476 616

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This decision is delivered by the presiding judge Tochtermann, the legally qualified judge Böttcher as judge-rapporteur, the legally qualified judge Agergaard and the technically qualified judge Wismeth.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement

DATE OF THE ORAL HEARING: 11 and 12 February 2025 and 6 June 2025

SUMMARY OF THE FACTS:

1. Claimant is suing Defendants for the alleged infringement of EP 3 476 616 B1 which relates to a lithographic printing plate precursor, a lithographic printing plate manufacturing method and a printing method. Claimant, a manufacturer of inter alia lithographic plates, is the registered proprietor of the patent-in-suit which is still in force in Germany and the United Kingdom (cf. SoC, mn. 206; Reply, mn. 496) but elapsed in all other designated EPC contracting member states before the entry into force of the UPCA on 1 June 2023. The mention of the grant of the patent-in-suit was published on 14 July 2021. It was filed on 31 May 2018, claiming the priority of two Japanese patent application of 31 August 2017 and 19 March 2018.
2. Claim 1, 13 and 14 of the patent-in-suit as granted read as follows in the language of the patent:

“1. A lithographic printing plate precursor comprising

- (i) an aluminum support including an aluminum plate and, formed thereon, an anodized film of aluminum, and
- (ii) an image recording layer,

wherein the anodized film

- is positioned closer to the image recording layer than the aluminum plate,
- has micropores extending in a depth direction of the anodized film from a surface of the anodized film on the image recording layer side,
the micropores have an average diameter of 15-100 nm at the surface of the anodized film, each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth of 10-1000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20-2,000 nm from a communication position between the small-diameter portion and the large-diameter portion, the aperture average diameter of the large-diameter portion at the surface of the anodized film is 15-100 nm, and that of the small-diameter portion at the communication position is ≤ 13 nm; and
- has a surface on the image recording layer side having a lightness L^* of 70-100 in a $L^*a^*b^*$ color system.

13. A method of manufacturing a lithographic printing plate, comprising the steps of:

- imagewise exposing the lithographic printing plate precursor of any of claims 1-12 to form exposed portions and unexposed portions; and
- removing the unexposed portions of the lithographic printing plate precursor having been imagewise exposed.

14. A printing method, comprising the steps of:

- imagewise exposing the lithographic printing plate precursor of any of claims 1-12 to form exposed portions and unexposed portions; and

- performing printing by supplying at least one of printing ink and fountain solution to remove the unexposed portions of the lithographic printing plate precursor having been imagewise exposed, on a printing press.”

3. The Defendants, companies incorporated under German law, belong to a multinational group of companies producing and distributing inter alia printing plates. Defendant 1 acts as the German sales company purchasing the products from a UK based company of the group. Defendant 2 and its legal predecessor respectively own and operate a manufacturing facility in Germany as contract manufacturer of printing plates for said UK entity. Defendant 1 is a wholly owned subsidiary of Defendant 2 which itself is a wholly owned subsidiary of Defendant 3 and subject to a control and profit and loss transfer agreement with Defendant 3.
4. In Claimant’s opinion, printing plates marketed by Defendants under the product names “SONORA X”, “SONORA XTRA-2” and “SONORA XTRA-3” (“contested embodiments”) are falling within the scope of claim 1 of the patent-in-suit and are means relating to an essential element of the subject-matter of claims 13 and 14 of the patent-in-suit. With regard to the technical design of the contested embodiments, reference is made to exhibit K11, K14 to K20 submitted by Claimant.
5. Defendants challenge the validity of the patent-in-suit on lack of novelty and inventive step. Additionally, they put forward that the patent-in-suit suffers from added matter as it extends beyond the disclosure of the application.
6. The Defendants filed a preliminary objection rejecting the international jurisdiction and competence with regard to United Kingdom (UK). The judge-rapporteur informed the parties that the Court will deal with the preliminary objection in the main proceedings in the light of the forthcoming opinion of the Advocate General in re ECJ C-339/22 (BSH Hausgeräte GmbH v. Aktiebolaget Electrolux).
7. By order of 2 April 2025, the panel separated the proceedings with regard to the UK because the decision of the ECJ in re C-339/22 (BSH Hausgeräte) had not been delivered until the end of the oral hearing but only thereafter on 25 February 2025. This separated proceeding is the subject-matter of the decision at hand, whereas the panel ruled on the other part of the action and on the counterclaim for revocation in its decision of 2 April 2025. According to this decision, the German part of the patent-in-suit was found invalid and the infringement action therefore was unsuccessful.

8. In the event the Court should find any reason to stay the proceedings insofar as they relate to infringing acts carried out in the UK, or not to grant a permanent injunction for the UK until further conditions are fulfilled, the Claimant had requested that the Court grant a provisional injunction for the UK, pending the stay and/or so long as no permanent injunction is granted (cf. SoC, mn. 207). In its decision of 2 April 2025, the panel rejected this request (cf. mn. 208 of the decision of 2 April 2025 in the main proceedings).

REQUESTS OF THE PARTIES

9. For sake of clarity the requests submitted are once again reflected hereinafter in their entirety, highlighting in yellow the parts of interest to the separated proceedings concerning the UK. The Claimant requests (cf. amended requests from the brief of 5 February 2025, main workflow):

A. As main request,

- I. To hold that claimant has demonstrated that the contested printing plate precursors SONORA X, SONORA XTRA-2 and SONORA XTRA-3 reproduce OR implement claims No. 1, 2, 3, 4, 5, 6, 7, 9, 10, 13 and 14 of European patent No. 3 476 616;
- II consequently, to grant the claims made by claimants;
- III. subject to a penalty to be determined by the Court for each case of infringement to refrain from:
 1. making, offering, placing on the market or using within the territory of Germany and the United Kingdom, or storing it for this purpose
 - a. a lithographic printing plate precursor comprising an aluminum support including an aluminum plate and,

formed thereon, an anodized film of aluminum, and

an image recording layer,

wherein the anodized film

is positioned closer to the image recording layer than the aluminum plate,

has micropores extending in a depth direction of the anodized film from a surface of the anodized film on the image recording layer side,

the micropores have an average diameter of 15-100 nm at the surface of the anodized film,

each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth of 10-1000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20-2,000 nm from a communication position between the small-diameter portion and the large-diameter portion,

the aperture average diameter of the large-diameter portion at the surface of the anodized film is 15-100 nm, and that of the small-diameter portion at the communication position is ≤ 13 nm; and

has a surface on the image recording layer side having a lightness L^* of 70-100 in a $L^*a^*b^*$ color system,

- direct infringement of claim 1 EP 3 476 616 B1 -

- b. in particular, the lithographic printing plate precursor according to claim 1, wherein a steepness a_{45} representing an area ratio of portions having an inclination of at least 45° at the surface of the anodized film on the image recording layer side as determined by extracting components with a wavelength of 0.2 to 2 μm is not more than 30%,

- direct infringement of subclaim 2 EP 3 476 616 B1 -

and/or

- c. the lithographic printing plate precursor of claim 2, wherein the steepness a_{45} is $\leq 20\%$.

- direct infringement of subclaim 4 EP 3 476 616 B1 -

and/or

- d. the lithographic printing plate precursor according to any one of claims 1 to 3, wherein the average diameter is from 15 to 60 nm,

- direct infringement of subclaim 4 EP 3 476 616 B1 -

and/or

- e. the lithographic printing plate precursor according to any one of claims 1 to 4, wherein the lightness L^* is from 75 to 100,

- direct infringement of subclaim 5 EP 3 476 616 B1 -

and/or

- f. the lithographic printing plate precursor according to any one of claims 1 to 5, wherein a specific surface area ΔS is not less than 20%, the specific surface area ΔS being a value determined by Formula (i): $\Delta S = (S_x - S_o) / S_o \times 100 (\%)$ using an actual area S_x obtained, through three-point approximation, from three-dimensional data acquired by measurement at 512 x 512 points in 25 μm square of the surface of the anodized film on the image recording layer

side by means of an atomic force microscope and a geometrically measured area S_o ,

- direct infringement of subclaim 6 EP 3 476 616 B1 -

and/or

- g. the lithographic printing plate precursor according to claim 6, wherein the specific surface area ΔS is from 20% to 40%

- direct infringement of subclaim 7 EP 3 476 616 B1 -

and/or

- h. the lithographic printing plate precursor of any of claims 1-8, wherein the image recording layer further contains a borate compound

- direct infringement of subclaim 9 EP 3 476 616 B1 -

and/or

- i. the lithographic printing plate precursor of any of claims 1-9, wherein the image recording layer further contains an acid color former

- direct infringement of subclaim 10 EP 3 476 616 B1 -

2. supplying and/or offering to any person other than a party entitled within the territory of Germany and the United Kingdom with

lithographic printing plate precursors

which are suitable and intended to use with

- a. method of manufacturing a lithographic printing plate, comprising the steps of

imagewise exposing the lithographic printing plate precursor of any of claims 1 - 7 and 9 - 10 to form exposed portions and unexposed portions; and

removing the unexposed portions of the lithographic printing plate precursor having been imagewise exposed

- indirect infringement of claim 13 EP 3 476 616 B1 -

- b. a printing method, comprising the steps of:

imagewise exposing the lithographic printing plate precursor of any of claims 1 - 7 and 9 - 10 to form exposed portions and unexposed portions; and

performing printing by supplying at least one of printing ink and fountain solution to remove the unexposed portions of the lithographic printing plate precursor having been imagewise exposed, on a printing press.

- indirect infringement of claim 14 EP 3 476 616 B1 -

B. As further requests,

- I. to hold that the defendants shall pay damages to the claimant compensating **all losses caused by infringing acts referred to in A.III. above** in
 - Albania, Austria, Cyprus, Czechia, Denmark, Estonia, Spain, Finland, Croatia, Italy, Lithuania, Latvia, Monaco, North Macedonia, Malta, The Netherlands, Poland, Romania, Serbia, Sweden, Slovenia, Slovakia, San Marino, since May 1st, 2019 and until 14th July 2021;
 - Bulgaria, Norway since May 1st 2019 until 14th October 2021;
 - Greece since May 1st 2019 until 15th October 2021;
 - Iceland since May 1st 2019 until 14th November 2021;
 - Portugal since May 1st 2019 until 15th November 2021;
 - Belgium, France, Luxembourg since May 1st 2019 until 31 May 2022;
 - Liechtenstein, Switzerland since May 1st 2019 until 23rd December 2022;
 - Ireland since 1st May 2019 until 27th February 2023;
 - **the UK since May 1st 2019;**
 - and in Germany since 14th July, 2021;
- II. to order the defendants to pay to the claimant EUR 200.000 (two hundred thousand euros) in compensation for the moral prejudice suffered;
- III. to inform the claimant to the extent of which the defendants have committed the infringing acts of EP 3 476 616 **referred to in C.I** – stating
 1. the origin and distribution channels;
 2. the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained;in particular
 - manufacturing quantities and times;
 - the individual deliveries, broken down by delivery quantities, times and prices and the respective product designations as well as the names and addresses of the customers;
 - the turnover, the gross margin and the contribution margin generated by the defendants with the sale of these products;
 - the individual offers, broken down by quantities, times and prices and product designations as well as the names and addresses of the commercial offer recipients;

- the advertising carried out, broken down by advertising media, their circulation, distribution period and distribution area, and in the case of Internet advertising, the domain, access figures and placement periods of each campaign;
- the identity of all third parties involved in the distribution, in particular the names and addresses of the commercial buyers and the sales outlets for which the products were intended;

whereby details requiring confidentiality may, at the discretion of the court, be redacted or made available only to certain persons;

within twenty-one days of the date of service of the decision, supported by evidence verified by an independent accountant, under a penalty of EUR 10.000 per delay day from the month following the date of service of the judgment to be handed down;

- IV. to order the defendants to pay the claimant interim awards on damages in the amount of EUR 10.000.000 (ten million euros) as provided under Rule 119 of the Rules of Procedure pending the communication of the requested accounting information, the claimant retaining the right to bring an action at a later date for the determination of the damages;
- V. to order the defendants to destroy at their own expense the products, material and/or implements referred to under A. III. which are in their possession and/or ownership within Germany and the United Kingdom, and to provide the claimant with proper evidence certified by an independent bailiff as to how and when the destruction was carried out;
- VI. to order the defendants to recall the products referred to under A. III. which have been placed on the market from the channels of commerce, with reference to the infringement determined by a court of law (judgement of [...] on [...]) and with the binding promise to reimburse any fees and to assume any necessary packaging and transport costs as well as customs and storage costs associated with the return and to take back the products,

whereby an exhaustive list of all recipients is to be provided to the claimants;

- VII. to order the defendants to definitively remove the products referred to under A. III. from the channels of commerce, specifically taking the following measures at their own expense:
 1. the defendants shall take all possible and reasonable measures to identify the locations and owners of the products referred to under A. III;
 2. to the extent that the defendants themselves have legal or actual control over the products referred to under A. III., such measures as are legally permissible and reasonable shall be taken to ensure that such products come into and remain in the defendants' immediate possession;
 3. to the extent that the defendants do not have legal or actual control over the products referred to under A. III., they shall take all legally permissible and

reasonable steps to induce the persons holding claims for restitution against the holders of the control of the products to assert such claims and/or to assist such persons in asserting such claims;

VIII. to order for each defendant

1. to place on its website, within seven days from the date of the decision and for a continuous period of at least two weeks, the following statement (or a statement as the Court deems appropriate), to be displayed in a manner visible directly on the website's home- or landing page, in a text box separate from the website's other content having a white background and black letters, set in typeface Arial and having at least 12pt size, and to provide the claimant with evidence when and how the statement was placed:

"On [date of decision], the Unified Patent Court has ruled that Kodak GmbH, Kodak Graphic Communications GmbH and Kodak Holding GmbH infringed European Patent No. 3 476 616 held by Fujifilm Corporation by manufacturing, selling, and offering for sale SONORA X, SONORA XTRA-2 and SONORA XTRA-3 printing plate precursors. As a consequence, Kodak GmbH, Kodak Graphic Communications GmbH and Kodak Holding GmbH were ordered to terminate all commercial activities related to these products in Germany and the United Kingdom immediately. We apologize for any inconvenience this may cause and will be reaching out directly to clients to offer an appropriate solution."

2. to send to its clients, within seven days from the date of the decision, in the national language of the client, a letter with the following contents only (or such contents as the Court deems appropriate) and without caption, and to provide the claimant with copies of all letters sent:

"Kodak GmbH, Kodak Graphic Communications GmbH and Kodak Holding GmbH have infringed Fujifilm's European Patent No. 3 476 616 with its products SONORA X, SONORA XTRA-2 and SONORA XTRA-3. Those products may no longer be offered for sale or sold in Germany and the United Kingdom, either on- or offline. We hereby request you to remove (images of) these products from your websites, from your shops and from other promotional and sales channels, to cease all sales and offers for sale of these products, and to return to us these products within seven days from the date of this letter. We will refund the purchase price and all costs associated with the return of the products to you."

- IX. In any case, to order the defendants to pay the claimant the sum of EUR 300.000 as an interim award on the legal costs and other expenses as provided under Article 69 of the Unified Patent Court Agreement and Rule 118(5), 119 and 150(2) of the Rules of Procedure.

[For requests C. to F., see infra under "counterclaim for revocation"]

- G. As a **further subsidiary request**, insofar as the Court considers the evidence submitted by the defendants insufficient to hold Defendant 2) liable for infringement of the patent in suit in the UK, to **order** Defendant 2) to produce,

- I. the Manufacturing Toll Agreement of 1 January 2017 between Defendant 2) and Kodak Ltd. referred to on page 10 of Exhibit K 3;
 - II. only if this does not become clear from the Toll Manufacturing Agreement, other documents, including purchase orders, invoices, agreements, or terms and conditions, that clarify when title to the SONORA plates manufactured by Defendant 2) intended for the UK market passes, in the case of (a) supplies to Kodak's UK entity **and** in the case of (b) direct shipments to distributors such as Intuprint.
- H. As a further request,
- I. to dismiss the defendants' request for an enforcement security,
 - II. if the Court were to consider an enforcement security at all, to limit it to much lower proportions at the discretion of the Court.
10. In the event the Court should find any reason to stay the proceedings as they relate to infringing acts carried out **in the UK**, or not to grant a permanent injunction for the United **Kingdom (UK)** until further conditions are fulfilled, the Claimant further requests that the Court grant a provisional injunction for the UK, pending the stay and/or so long as no permanent injunction is granted (cf. SoC, mn. 207).
11. The Defendants request (with regard to the updated amount for the enforcement security, cf. brief of 12 February 2025, workflow App_6897/2025):
1. dismissal of the action (Rules 23, 24 lit. (g) RoP UPC);
 2. reimbursement of the Defendants' costs of the infringement action provisionally (Rule 150.2 RoP UPC);
- in the alternative,
3. to make the enforcement of the decision subject to the prior provision of security by the Plaintiff of at least [...] (Rules 352.1, 354.2 RoP UPC), which can be provided by a written, irrevocable, unconditional and unlimited guarantee from a credit institution authorized to do business in the territory of a member state of the UPC;
 4. to permit the Defendants to avert enforcement of the decision by providing security, which can be made by way of a written, irrevocable, unconditional, and indefinite guarantee of a financial institution in the territory of a member state of the UPC authorized to conduct business in the Federal Republic of Germany, irrespective of a provision of security by Plaintiff (Rule 9.1 RoP UPC).

COUNTERCLAIM FOR REVOCATION

12. With regard to their counterclaim for revocation (CC_3100/2024, CC_3096/2024, CC_3094/2024), the Defendants request:

5. revocation of the European patent EP 3 476 616 B1 in its entirety with effect in the territory of all Contracting Member States in which the patent has effect (Rule 25 RoP UPC);
 6. without prejudice to our primary position that the court either cannot or should not determine the claim **so far as it concerns the United Kingdom** for the reasons set out in our Preliminary Objections,

and on the basis that if the court were to assume jurisdiction for the EP 3 476 616 B1 (UK) **it should only do so if the Plaintiff first undertakes to consent before the UK Court and Intellectual Property Office to revocation or restriction of the EP 3 476 616 B1 (UK) in line with decision handed down by this court,**

a decision that the EP 3 476 616 B1 (UK) is also invalid in its entirety; and
 7. reimbursement of the Defendants' costs of the counterclaim provisionally (Rule 150.2 RoP UPC).
13. The Claimant having filed an Application to amend the patent (App_35674/2024) requests:
- C. As a further main request,

to **dismiss** the Counterclaim for Revocation of EP 3 476 616 B1 in its entirety;
 - D. As **a subsidiary request**, insofar as the Court considers the claims of EP 3 476 616 B1 to be anticipated by any of the prior art documents invoked in the Counterclaim for Revocation under Articles 54(2) or 54(3) EPC,
 - I. to **hold** that the Application to Amend EP 3 476 616 B1 submitted as Auxiliary Request 1 is admissible;
 - II. to **hold** that the claimant has demonstrated that the contested printing plate precursors SONORA X, SONORA XTRA-2 and SONORA XTRA-3 reproduce or implement claims No. 1, 2, 3, 4, 5, 6, 7, 9, 10, 13, and 14 of Auxiliary Request 1;
 - III. to consequently **order** the injunctive measures requested under request A.;
 - IV. to consequently **order** the corrective measures requested under request B.;
 - E. As **a further subsidiary request**, if the Court considers the claims of EP 3 476 616 B1 to be anticipated by any of the prior art documents invoked in the Counterclaim for Revocation under Articles 54(2) or 54(3) EPC,
 - I. to **hold** that the Application to Amend EP 3 476 616 B1 submitted as Auxiliary Request 2 is admissible;
 - II. to **hold** that the Claimant has demonstrated that the contested printing plate precursors SONORA X, SONORA XTRA-2 and SONORA XTRA-3 reproduce or implement claims 1, 2, 3, 4, 5, 6, 7, 9, 10, 13 and 14 of Auxiliary Request 2;
 - III. to consequently **order** the injunctive measures requested under request A.;

- IV. to consequently **order** the corrective measures requested under request B.;
- F. As **a further subsidiary request**, if the Court considers claim 6 of EP 3 476 616 B1 to be violating Article 123(2) EPC,
- I. to **hold** that the Application to Amend EP 3 476 616 B1 submitted as Auxiliary Request 3 is admissible;
 - II. to **hold** that the Claimant has demonstrated that the contested printing plate precursors SONORA X, SONORA XTRA-2 and SONORA XTRA-3 reproduce or implement claims No. 1, 2, 3, 4, 5, 6, 7, 9, 10, 13, and 14 of Auxiliary Request 3;
 - III. to consequently **order** the injunctive measures requested under request A.;
 - IV. to consequently **order** the corrective measures requested under request B.
14. With its brief of 30 October 2024 (containing the Rejoinder to the counterclaim for revocation and the Reply to the defence to the application to amend the patent), the Claimant, though being of the opinion that the term “ink” in its auxiliary request 1 has to be read as “printing ink”, filed an alternative auxiliary request 1 (exhibit K 53) containing explicitly the term “printing ink”.
15. The Defendants request to dismiss the Claimant’s requests to amend the patent.

POINTS AT ISSUE

16. The parties are in dispute about different aspects of the case at hand.

JURISDICTION

17. The Claimant is of the opinion that the UPC has jurisdiction over the UK part of the patent-in-suit, as confirmed by the ECJ’s ruling in re C-339/22 (BSH Hausgeräte). Claimant disputes that Defendants’ arguments in their counterclaim of revocation are to be understood as an invalidity defence against the infringement of the UK part of the patent-in-suit.
18. Defendants deny the UPC’s jurisdiction, taking into account principles of international law and the scope of application of the UPCA. In addition, Claimant had not observed the requirements established by UK law for the defence of a patent in a limited version. At least, the UPC had to stay the proceedings. Defendants are of the opinion that their arguments against the validity of the patent-in-suit also constitute an invalidity defence against an infringement of the UK part.

INFRINGEMENT

19. According to Defendants, Sonora XTRA-3 has no micropores in the meaning of the patent-in-suit. In their view its anodized film has a three-layer structure due to corresponding anodization steps instead of a two-layer-structure as required by the patent-in-suit. Moreover, Defendants consider Sonora XTRA-3 not to have continuous boundaries on the top-most layer of the anodized film, but spikes, thus not allowing to find pores having a certain diameter at the film's surface in accordance with the patent-in-suit. Furthermore, they regard Claimant's infringement allegation relating to subclaims 2 and 3 to be inconclusive insofar as Claimant relies on Atomic Force Microscope (AFM) measurements.
20. Claimant opines that Defendants infringe the UK part of the patent-in-suit under the applicable substantive UK law by direct deliveries of Defendant 2 to Kodak Ltd., Watford, and to UK-based distributors like Intuprint as suggested by the "Mintz report" and retaining title to the plates until they reach the distributors' premises. (cf. Reply mn. 455 et seq.; Exhibit K 45 - EXHIBIT PMJ-1 TO THE STATEMENT OF PETER MYLES JELF, page 6 and page 8 et seqq. sub point 4, here 4.13 cited as follows "When asked about the transfer of the title of the plates, Mark said that the title of the plates is shifted to a customer once the plates have reached the physical premises of that client."). It alleges a transfer of title in the UK only, thus constituting a direct infringement by importing according to Section 60(1)(a) Patents Act 1977 (Reply, mn. 458 et seq.). In the event that Defendant 2 did not retain title in the UK, the Defendants, at least, were liable as joint tortfeasors under UK law. Furthermore as to defendant 2 claimant relied on a test purchase of printing plates displayed in its SoC mn. 109 et seqq. establishing in its eyes that defendant 2 is the producer of the plates and pointing to defendant no 1's involvement in the production process as well as the control of business of defendant 2 by defendant 3, those facts being submitted uniformly to all alleged acts of infringement, i.e. also with respect to acts on UK territory.
21. Defendants argue that neither the requirements for importing nor for a joint tortfeasorship are met. They refer to the annual report according to Exhibit K3 (Rejoinder mn. 562) which states that the title to all material and products including intermediate products constantly lies with Kodak Limited, Watford with regard to products produced under the toll manufacturing agreement between Defendant 2 and Kodak Ltd., Watford.

22. Moreover, the Defendants allege a private prior use right pursuant to Sec. 12 German Patent Act (PatG) in conjunction with Art. 28 UPCA allowing them to manufacture and distribute the contested embodiments in Germany. The German prior use right would also extend to acts in the territory of the UK due to principles of EU law. They also allege an additional separate prior use right in the UK under Section 64 UK Patents Act 1977.
23. Claimant seeks a permanent injunction, a right to prevent the indirect use of the invention, corrective measures, an order to communicate information and to pay damages as well as an interim award of damages and costs.
24. For further details on the points at issue, reference is made to the briefs and the accompanying exhibits.

COUNTERCLAIM FOR REVOCATION

25. The Defendants base their identical counterclaims for revocation on the following grounds of Art. 138 EPC in conjunction with Art. 65 (2) UPCA:
- lack of novelty (Art. 138(1)a) in conjunction with Art. 54(1), (2) and (3) EPC), and
 - lack of inventive step (Art. 138(1)a) in conjunction with Art. 56 EPC),
 - added matter with regard to claim 6 (Art. 138(1)c EPC).
26. Defendants challenge the validity of the patent-in-suit by relying on lack of novelty in relation to public prior use, WO 2018-160379 A1 (WO'379; T9) and US 4 566 952 A (US'952; T22). The alleged public prior use is based on products being also relevant for the alleged private prior use right. With regard to WO'379 and US'952, in each case, Defendants rely on an alleged reworking of one of the examples described therein.
27. Inventive step is challenged by EP 2 878 452 A1 (EP'452; T41) in combination with general common knowledge or with EP 1 614 541 A2 (EP'541; T37), JP H08-144090 A (JP'090; T38) or EP 2 839 968 A1 (EP'968; T39), in the alternative starting with JP 2015-189021 A (JP'021; T42) or EP 2 594 408 A1 (EP'408; T2).
28. Additionally, Defendants put forward, that the patent-in-suit suffers from added matter in claim 6.

29. For further details on the points at issue, reference is made to the briefs and the accompanying exhibits.

GROUND FOR THE DECISION

30. The infringement action being subject to the separate proceeding at hand is admissible, as far as it is based on the national part of the patent-in-suit in the UK as granted, but unfounded because the UK part lacks patentability. As far as Claimant wishes to separately base its infringement action in the alternative on dependent claims or combinations thereof, the infringement action is inadmissible due to the lack of specificity. Defendants' separate request with regard to the validity of the UK part in their counterclaim for revocation, which extends beyond assessing the validity of the UK part as a mere prerequisite for infringement within the infringement proceeding, is inadmissible.

A. ADMISSIBILITY OF THE INFRINGEMENT ACTION AND OF THE COUNTERCLAIM FOR REVOCATION

31. The infringement action is admissible in principle with regard to the UK part of the patent-in-suit.

I. RELEVANT REQUESTS CONCERNING THE INFRINGEMENT ACTION

32. Claimant's amendments to the infringement action are admissible in principle.

Amendments by Claimant's reply

33. By its brief containing its reply to the statement of defence and to the counterclaim for revocation and its application to amend the patent, Claimant submitted auxiliary requests with regard to the infringement proceedings taking into account a potential partly revocation of the patent-in-suit. Such consequential adjustments to the infringement action are admissible in principle for the reasons detailed in the decision of 2 April 2025 (para. 28). With respect to the UK part of the infringement action, no other result is justified. Any procedural requirement as to the notification of the UK patent office by the Claimant (or even, if applicable by the court) according to UK procedural law are not applicable in the case at hand. First, the infringement action at hand is exclusively governed by procedural law of the forum at hand in accordance with fundamental principles of international procedural law. Apart from that, as discussed in the oral hearing, non-observance of an obligation to notify the UK patent office would not affect the course of the infringement action

before UK courts anyway, in particular it would not affect the course of an infringement proceeding in the UK, in particular not result in a stay of the proceedings until the notification of the UK patent office had taken place. Second, the notification of the UK patent office, at least according to the understanding of the panel, is linked to the limitation of the patent-in-suit with erga omnes effect alone. In the proceedings at hand, such limitation is not at issue as the dispute will only be decided upon with inter-partes effect between the parties in accordance with the ECJ's decision (cf. judgment of 25 February 2025, C-339/2022, para. 75 – BSH Hausgeräte).

Amendments by Claimant's brief of 5 February 2025

34. As far as Claimant has amended its requests for the infringement action by its brief of 5 February 2025, the panel has no concerns under R. 263 RoP either. It is referred to the decision of 2 April 2025 (paras. 29 et seq.).

II. JURISDICTION FOR INFRINGEMENT IN THE UK

35. The UPC has jurisdiction to decide upon the infringement action as far as it relates to acts infringing the UK national part of the patent-in-suit.
36. According to the ECJ's ruling in re BSH Hausgeräte, the court of the Member State of the European Union in which the defendant is domiciled (Article 4(1) of the Brussels Ia Regulation) does have jurisdiction to rule on an infringement action based on a patent granted or validated in a Non-EU member state even if the invalidity of this patent is raised as a defence. This is true save for the restrictions referred to in paragraphs 63 to 65 of the judgment (Lugano Convention or applicable bilateral convention as the case may be or a situation under Art. 33 or 34 Brussels Ia Reg). Still, there is no jurisdiction for a defence which seeks to affect the existence or content of that patent in that third state, or to cause its national register to be amended (cf. ECJ, judgement of 25 February 2025, C-399/22, para. 74 et seq.).
37. In the case at hand, none of these restriction apply. The United Kingdom is not a contracting member state to the Lugano Convention. The parties to the infringement action at hand did not bring forward any bilateral convention between a member state to the UPCA and the United Kingdom stipulating that the courts or other authorities in the United Kingdom

have exclusive jurisdiction over disputes relating to the validity of patents granted or validated in the United Kingdom. Thus, it can be left open whether such bilateral convention with only one or several but not all member states to the UPCA would suffice. In the absence of any proceedings in the United Kingdom which relates to the infringement or validity of the patent-in-suit in the United Kingdom, there is no situation which falls into the scope of Art. 33 or Art. 34 Brussels Ia Reg. either so that there is no reason to stay or dismiss the proceedings according to these provisions. Since the decision at hand, as detailed *infra*, assesses the validity of the patent-in-suit in relation to the United Kingdom as a mere prerequisite for the question of infringement with *inter partes* effect only, it does neither affect the existence or content of the part of the patent-in-suit, nor does it cause the national register in the UK to be amended. Contrary to Defendants, the ECJ's ruling in *re BSH Hausgeräte* deals with the principles of international law, in particular with the principles of non-interference, forum inconvenience and comity, exhaustively so that there is no room for denying jurisdiction on these grounds in deviation from the ECJ's ruling.

38. Art. 71b Brussels Ia Regulation and Art. 34 UPCA do not lead to another result. Contrary to Defendants, the term “matter governed by that instrument” in Art. 71b (1) Brussels Ia Reg. does not relate to the territorial scope of jurisdiction but to the substantive legal matter for which the EU member states that are parties to the instrument have transferred the jurisdiction from their national courts to the common court. Rather Art. 71b (1) Brussels Ia Reg. clarifies that the common court has international jurisdiction when the national courts of the participating EU member states would have jurisdiction in the absence of the instrument establishing the common court. Since (leaving aside the transition period and opt-outs) the national courts of the UPCA member states would have jurisdiction over infringement actions in relation to the UK national part in accordance with ECJ's ruling in *re BSH Hausgeräte*, so does the UPC (cf. for further details LD Dusseldorf, decision of 28 January 2025, UPC_CFI_355/2023, p. 22/23). No different results follows from the UPCA, in particular not from Art. 34 UPCA. This provision does not deal with the international jurisdiction in the first place (which, within the UPCA, is governed by Art. 31 UPCA). The provision does not exclude the UPC's jurisdiction over national parts of European patents in relation to Non-UPC member states. There is no indication that the UPCA member states intended to transfer jurisdiction to the UPC with regard to their national parts of a European patent only, thereby reserving jurisdiction with regard to other national parts to their national courts. For further details, reference is made to LD Dusseldorf, decision of 28 January 2025,

39. Since there is no proceeding in the United Kingdom pending relating to the infringement or validity of the patent-in-suit in the United Kingdom, there is no reason to stay the proceeding at hand pursuant to R. 295 (a) or (m) RoP either.

III. DEFENDANTS' REQUEST ON VALIDITY IN UK

40. It can remain open whether Defendants' request on the validity of the UK part of the patent-in-suit is to be interpreted as meaning that Defendants seeks revocation of this part by the UPC or as a mere declaratory relief establishing that the UK part is invalid. However, the fact that the Defendants' requests regarding the validity of the patent-in-suit differentiate between revocation in relation to parts of UPCA member states and a mere decision in relation to the UK part (a decision which, in Defendants' view, in order to affect the UK part, would require in addition Claimant's consent before the UK Court and Intellectual Property Office to a revocation or restriction in line with that decision), suggests that no decision with constitutive effect is sought for the UK part that, by its very virtue, would affect the existence or content of that part. Similarly, it can be left open, whether pursuant to the principles set out by the ECJ in re BSH Hausgeräte the courts in the European Union have jurisdiction for the aforementioned declaratory relief. In any event, Defendants' request is inadmissible. The UPC has no jurisdiction to revoke the national part of an European bundle patent for states other than UPCA contracting member states (cf. ECJ, judgment of 25 February 2025, C-339/2022, para. 73 – BSH Hausgeräte).
41. The Defendants furthermore do not have a relevant interest in a declaration that the UK part is invalid. A declaration would not be binding on the authorities in the UK which are solely responsible for revocation of the UK part, or on the Claimant in revocation proceedings in the UK. Otherwise, the UPC would indirectly decide on the validity of the UK part, which would be counter to the principles established by the ECJ.

IV. FURTHER ASPECTS OF ADMISSIBILITY

42. In all other respects, the infringement action is admissible in principle.

B. SCOPE OF THE PATENT-IN-SUIT

43. The patent-in-suit relates to a lithographic printing plate precursor. For a detailed description of its scope, it is referred to the decision of 2 April 2025 (paras. 45 et seq.).

44. As a solution, the patent-in-suit proposes in claim 1 a lithographic printing plate precursor, the features of which can be structured as follows:

- 1** A lithographic printing plate precursor comprising
 - 1.1** an aluminum support including an aluminum plate and,
 - 1.1.1** formed thereon, an anodized film of aluminum, and
 - 1.2** an image recording layer.
 - 1.3** The anodized film
 - 1.3.1** is positioned closer to the image recording layer than the aluminum plate;
 - 1.3.2** has micropores extending in a depth direction of the anodized film from a surface of the anodized film on the image recording layer side,
 - 1.3.3** the micropores have an average diameter of 15-100 nm at the surface of the anodized film,
 - 1.3.4** each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth (D) of 10-1000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20-2000 nm from a communication position between the small-diameter portion and the large-diameter portion,
 - 1.3.5** the aperture average diameter of the large-diameter portion at the surface of the anodized film is 15-100 nm, and that of the small-diameter portion at the communication position is ≤ 13 nm; and
 - 1.3.6** has a surface on the image recording layer side having a lightness L^* of 70-100 in a $L^*a^*b^*$ color system.

45. The independent procedural claims protect corresponding methods of manufacturing a lithographic printing plate (claim 13) and for printing with that plate (claim 14), with a specification indicating the printing plate being of an on-press development type, which feature

is not subject of claim 1.

CONSTRUCTION OF CLAIM 1

46. For the construction of claim 1 it is referred to the decision of 2 April 2025 (paras. 50 et seqq.).

C. LACK OF VALIDITY OF THE UK PART OF THE PATENT-IN-SUIT

47. The counterclaim for revocation, as far as being solely directed against the remaining German part of the patent-in-suit (see *supra* admissibility), is founded as detailed in the decision of 2 April 2025. The subject-matter of the independent claims 1, 13 and 14 as granted (main request) is novel but lacks an inventive step. The same is true for the subject-matter of the respective auxiliary request 1 and 2. The panel has not to adjudicate on auxiliary request 3 because the relevant condition is not fulfilled. Contrary to Claimant, its separate defence of dependent claims as granted or as amended by auxiliary request 1 and 2 is not admissible. The same applies as far as Claimant wishes to defend the patent-in-suit in the version of all combinations of auxiliary requests 1 to 3. For further details, reference is made to the decision of 2 April 2025 (cf. paras. 73 – 201).

48. The assessment of the validity of the UK part does not lead to a different result.

49. Even though the UPC has no jurisdiction to rule on the UK part of the patent-in-suit (cf. *supra*) and, at least at the time of the conclusion of the oral hearing, no revocation action had been filed in the UK, the validity of the patent-in-suit is a prerequisite for an injunction and further orders based on a finding of infringement. Although the UPC (as any other court of an EU member state) has no jurisdiction to rule on the validity of the UK part of the patent-in-suit as detailed in the ECJ's ruling in *re BSH-Hausgeräte* (cf. *supra*), the defendant against an infringement action before the UPC (or any other court of EU member states) based on the national part regarding the UK, for which the UPC has jurisdiction in accordance with ECJ's ruling in *re BSH-Hausgeräte* (cf. *supra*), is allowed to raise an invalidity defence against this infringement action by, within the infringement proceeding, alleging the invalidity of that national part without being obliged to file an action for revocation with the authorities responsible for revocation in the United Kingdom. In consequence, that invalidity defence has the sole effect, that, within the infringement proceeding, the court assesses the validity of such national part as a mere prerequisite of any claim based on the

alleged infringement thereof and, if the court finds it invalid, dismisses the infringement action (cf. Local Division Dusseldorf, decision of 28 January 2025, UPC_CFI_355/2023, p. 60 et seq.). The decision is not such as to affect the existence or content of that patent in the UK , or to cause its national register to be amended as regards the existence or content of that national part (cf. ECJ judgement of 25 February 2025, C-339/2022, para. 74 – BSH Hausgeräte).

50. Contrary to Claimant, Defendants raised such invalidity defence in relation to the UK part of the patent-in-suit within their counterclaim for revocation. Interpreted properly, the request for a declaration that the UK part is also invalid in its entirety has to be interpreted as encompassing, that, in any event, the infringement action in relation to the UK is to be dismissed on the grounds of invalidity of the UK part. Similarly, in relation to the UK part, Claimant's application to amend the patent has to be interpreted so as to meaning that Claimant wishes to base its infringement action in this regard on limited versions in the alternative by asserting a substantive scope that is narrower than the scope as granted in the event that the court considers the UK part as granted to be invalid.

51. In their statement of defence comprising the counterclaim for revocation and their arguments on the alleged invalidity of the patent-in-suit, Defendants stated that the position on invalidity under UK law is no different to that under German law and that the UK part is invalid for the same reasons as the German part (SoD, mn. 562). Against this backdrop, it would have been for the Claimant to contest and state any circumstances, if any, that would lead to a different result in relation to the assessment of the validity of the UK part. In the absence of deviating arguments of the Claimant defending the validity of the patent-in-suit when UK patent law or the EPC as applied by UK courts is concerned, reference is made to the decision of 2 April 2025 for the reasons why the subject-matter of the UK part as granted and in the versions of the auxiliary requests 1 and 2 is invalid and why the subject-matter of claim 6 does not extend beyond the content of the relevant patent application as originally filed so that the condition for auxiliary request 3 is not met (cf. paras. 73 – 158, 172, 182-201)

52. Against this backdrop, it can be left open whether, before the UPC, the claimant of an infringement proceeding regarding a national part of a European bundle patent validated in a non-UPC member state can successfully rely on limited versions thereof by way of auxiliary requests or whether he unconditionally has to state the relevant version if he wishes

to assert that part in a limited substantive scope for the purpose of the infringement proceeding. Similarly, it can remain open under which conditions the respective UK part could be defended before the competent UK authorities by auxiliary requests, in particular whether it could be defended by relying separately on dependent claims or combinations thereof without unambiguously specifying the subject-matter and the order of priority in which the patent is defended in limited versions.

53. In any case, if the Claimant wishes to base its infringement action at hand on limited versions of the UK part in the alternative, the subject-matter of the alternatively alleged limited new independent patent claims and the order of their priority have to be specified unambiguously. Naturally, the Claimant has not to file an Application to amend the patent pursuant to R. 30 RoP with regard to the UK part, because the proceeding at hand does not concern and will not affect the existence or the content of the UK part as granted (cf. *supra*). However, the underlying principles with regard to the effectiveness of the proceedings and the protection of defendant's right to an effective defence as laid down in the decision of 2 April 2025 with regard to R. 30 RoP (mn. 165, 168) apply *mutatis mutandis*. Therefore, the Claimant had to specify the relevant subject-matters and the order of their priority when asserting the UK part of the patent-in-suit in several limited versions thereof in the alternative. Otherwise, the effectiveness of the defence against the infringement action and, ultimately, Defendants' right to be heard would be inappropriately hampered if Defendants were obliged to prepare themselves to refute each possible separately valid dependent claim without the Claimant having to make unambiguously clear the subject-matters it bases its infringement action on and their relevant order of priority. Since the subject-matter of the patent builds the basis of the infringement action, alternative subject-matters without an unambiguous specification of their order of priority result in the lack of specificity of the infringement action. In addition, similar to the situation regarding an Application to amend the patent, the effectiveness of the court procedures would be negatively affected as well if, when assessing the validity as a prerequisite for an infringement regarding the national part of a Non-UPC member state, the court had to scrutinize separately any dependent claim for independent validity without the claimant specifying which subject-matter in which order of priority it wishes to rely on.

54. As detailed in the decision of 2 April 2025 (mn. 173-179), the order of priority of the different alternative patent claims with narrower substantive scopes compared to the patent-in-

suit as granted is not sufficiently clear. Thus, Claimant cannot successfully base its infringement action regarding the UK part thereon.

55. If one considered the separate assertion of dependant claims as granted admissible in the case at hand, in any case the additional arguments by which Defendants challenge the validity of such dependent claims in their Rejoinder to the Application to amend the patent would have to be regarded as admissible as well. At the earliest after the Rejoinder to the counterclaim for revocation and the Reply to the defence to the Application to amend the patent, Defendants had reason to deeper elaborate on the dependant claims as discussed by Claimant therein.

D. LEGAL CONSEQUENCES

56. Consequently, the infringement action regarding the UK part of the patent-in-suit as granted is unfounded and inadmissible with regard to the different limited substantive scopes of the patent-in-suit the Claimant wishes to base its infringement action upon in the alternative.

57. A decision according to R. 118.2 RoP on the condition that the UK authorities that are responsible for the revocation of the UK part (which are not seized yet) maintain the UK part of the patent-in-suit is out of question. As detailed supra, the UPC is allowed to assess the validity of the UK part as mere prerequisite within the infringement proceeding at hand with inter-partes effect. Its requirements not being met, R. 118.2 RoP is not applicable (neither directly nor accordingly, cf. LD Dusseldorf, decision of 28 January 2025, UPC_CFI_355/2023, p. 61).

58. The Defendants filed a request for interim award of costs. The request has already been decided on in the decision of 2 April 2025.

E. COSTS

59. The decision on the (recoverable) costs with regard to both the infringement action and the counterclaim in relation to the national part of the patent-in-suit validated in the UK is based on Art. 69 (1) UPCA, R. 118.5 RoP. Since the invalidity defence was successful in substance, the failure of the Defendants' request for a decision that the UK part of the patent-in-suit is also invalid in its entirety is not economically significant.

60. Claimant clarified in the first oral hearing (11 and 12 February 2025) that it did not intend to apply to increase the ceilings set forth in the Administrative Committee's decision on scale of ceilings under para 3. of its brief of 4 February 2025. Defendants did not apply for an increase of the ceilings in that stage of the proceedings either.

F. VALUE IN DISPUTE

61. The value of the whole dispute (including this part and the part decided on in the decision of 2 April 2025) had already been set to EUR 15.000.000 after having heard the parties in the oral hearing.

DECISION:

- A. The infringement action is dismissed.
- B. The Claimant has to bear the costs of the litigation.

Delivered in Mannheim on 18 July 2025

NAMES AND SIGNATURES

Presiding judge Tochtermann	
Legally qualified judge Böttcher	
Legally qualified judge Agergaard	
Technically qualified judge Wismeth	
For the Sub-Registrar: Kranz, Clerk LD Mannheim	

Information about appeal

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

Information about enforcement (Art. 82 UPCA, Art. Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP)

The decision has no enforceable content.