

Decision

of the Court of First Instance of the Unified Patent Court

Local Division Mannheim

delivered on 18 July 2025

concerning EP 3 511 174 B1

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 13, 80333 Munich, Germany

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PATENT AT ISSUE:

European patent EP 3 511 174

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This decision is delivered by the presiding judge Tochtermann as judge-rapporteur, the legally qualified judge Böttcher, 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 the EP 3 511 174 B1 which relates to a planographic printing plate original plate, a method for manufacturing, 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. 208; Reply, mn. 510) but elapsed in all other designated 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 26 May 2021. It was filed on 31 May 2018, claiming the priority of two Japanese patent application of 29 September 2017 and 30 March 2018.
2. Claim 1, 15 and 16 of the patent-in-suit as granted read as follows in the language of the patent:

“1. A lithographic printing plate precursor comprising

an aluminum support; and

an image recording layer on the aluminum support,

wherein the aluminum support includes an anodized film on a surface of the image recording layer side,

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

the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01 μm to 0.30 μm , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,

an average pore diameter of the micropores in the surface of the anodized film is 90% or less of the maximum diameter of the micropores inside the anodized film,

a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

the image recording layer contains an acid color former.

15. A method of preparing a lithographic printing plate, comprising:

a step of imagewise-exposing the lithographic printing plate precursor of any of claims 1-14; and

a step of supplying at least any of printing ink or dampening water and removing an image recording layer in a non-image area on a printing press.

16. A lithographic printing method comprising:

a step of imagewise-exposing the lithographic printing plate precursor according to any one of claims 1 to 4;

a step of supplying at least any of printing ink or dampening water and removing a non-image area of an image recording layer on a printing press to prepare a lithographic printing plate; and

a step of performing printing using the obtained lithographic printing plate.”

3. Claimant unconditionally amended claim 1 of the patent-in suit in accordance with its new Main request under R. 30.1 RoP (Exhibit K 34) as follows (with changes highlighted in yellow):

“1. A lithographic printing plate precursor comprising

an aluminum support; and

an image recording layer on the aluminum support,

wherein the aluminum support includes an anodized film on a surface of the image recording layer side,

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

the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01 μm to 0.30 μm , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,

an average pore diameter of the micropores in the surface of the anodized film is 90% or less in a range of 10% to 50% of the maximum diameter of the micropores inside the anodized film,

a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

the image recording layer contains an acid color former.”

4. The court holds admissible to align the claims accordingly to the defense to the counterclaim for revocation by way of amendment acc. to R. 30.1. RoP (see infra).
5. 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.
6. In Claimant’s opinion, printing plates marketed by Defendants under the product name “SONORA XTRA-3” (the claim having been limited to that “contested embodiment” in response to procedural order of 22 January 2025, ORD_598567/2023, by brief of 4 February 2025) 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 15 and 16 of the patent-in-suit. With regard to the technical design of the contested embodiment, reference is made to exhibit K12, K13, K15, K18 to K21 submitted by Claimant.
7. Defendants challenge the validity of the patent-in-suit by relying on a public prior use right, on lack of novelty in relation to by EP 2 878 452 A1 (EP’452; T34) and WO 2018-160379 A1 (WO’379; T12). Inventive step is challenged by EP 2 878 452 A1 (EP’452; T34) in combination with common knowledge or EP 2 839 968 A1 (EP’968; T36) or US 2009/0047599 A1 (US’599, T40), in the alternative starting with EP 2 839 968 A1 (EP’968; T36). Additionally they put forward, that the patent-in-suit suffers from added matter as it extends beyond the disclosure of the application.

8. 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).
9. 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 proceedings 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 valid in the version defended in the main request and the infringement action was successful.
10. 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. 209). In its decision of 2 April 2025, the panel rejected this request (cf. mn. 157 of the decision of 2 April 2025 in the main proceedings).

REQUESTS OF THE PARTIES

11. 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 22 January 2025, main workflow,):

A. As main request,

- I. To hold that Claimant has demonstrated that the contested printing plate precursor SONORA XTRA-3 reproduces OR implements claims No. 1, 2, 3, 4, 5, 6, 7, 8, 9, 14, 15 and 16 of new Main Request (Exhibit K 34);
- 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, using or storing it for those purposes a lithographic printing plate precursor within Germany and the United Kingdom, that has the following features:

a. A lithographic printing plate precursor comprising:

an aluminum support; and

an image recording layer on the aluminum support,

wherein the aluminum support includes an anodized film on a surface of the image recording layer side,

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

the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01 μm to 0.30 μm , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,

an average pore diameter of the micropores in the surface of the anodized film is in a range of 10% to 50% of the maximum diameter of the micropores inside the anodized film,

a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

the image recording layer contains an acid color former,

- direct infringement of claim 1 EP 3 511 174 B1 -

b. in particular, the lithographic printing plate precursor according to claim 1, wherein the micropores are micropores which further include small diameter pores communicating with a bottom of the large-diameter pores, extending in the depth direction from a communication position, and having an average pore diameter of 0.01 μm or less and in which the pore diameters of the small-diameter pores in the communication position are smaller than the pore diameters of the large-diameter pores in the communication position

- direct infringement of subclaim 2 EP 3 511 174 B1 -

and/or,

c. the lithographic printing plate precursor according to any one of claims 1 to 2, wherein the acid color former is a leuco dye

- direct infringement of subclaim 3 EP 3 511 174 B1 -

and/or

d. the lithographic printing plate precursor according to any one of claims 1 to 3, wherein the image recording layer further contains an acid generator

- direct infringement of subclaim 4 EP 3 511 174 B1 -

and/or

e. the lithographic printing plate precursor according to claim 4, wherein the acid generator contains an organic borate compound

- direct infringement of subclaim 5 EP 3 511 174 B1 -

and/or

f. the lithographic printing plate precursor according to any one of claims 1 to 5, wherein a value of a brightness L^* in an $L^*a^*b^*$ color system of the surface of the anodized film on the image recording layer side is in a range of 70 to 100

- direct infringement of subclaim 6 EP 3 511 174 B1 -

and/or

g. the lithographic printing plate precursor according to any one of claims 1 to 5, wherein a value of a brightness L^* in an $L^*a^*b^*$ color system of the surface of the anodized film on the image recording layer side is in a range of 72 to 90

- direct infringement of subclaim 7 EP 3 511 174 B1 -

and/or

h. the lithographic printing plate precursor according to any one of claims 1 to 7, wherein a steepness a_{45} representing an area ratio of a portion having an inclining degree of 45° or greater obtained by extracting a component with a wavelength of $0.2\ \mu\text{m}$ to $2\ \mu\text{m}$ in the surface of the anodized film on the image recording layer side in a frequency distribution based on fast Fourier transformation of three-dimensional data obtained by performing measurement using an atomic force microscope is 30% or less

- direct infringement of subclaim 8 EP 3 511 174 B1 -

and/or

i. the lithographic printing plate precursor according to any one of claims 1 to 8, wherein an amount of the image recording layer is in a range of $0.5\ \text{g/m}^2$ to $2.5\ \text{g/m}^2$

- direct infringement of subclaim 9 EP 3 511 174 B1 -

and/or

j. the lithographic printing plate precursor according to any one of claims 1 to 13, which is a lithographic printing plate precursor for on-press development.

- direct infringement of subclaim 14 EP 3 511 174 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 preparing a lithographic printing plate, comprising

a step of imagewise-exposing the lithographic printing plate precursor of any of claims 1-14; and

a step of supplying at least any of printing ink or dampening water and

removing an image recording layer in a non-image area on a printing press.

- indirect infringement of claim 15 EP 3 511 174 B1 -

b. a printing method, comprising:

a step of imagewise-exposing the lithographic printing plate precursor according to any one of claims 1 to 4;

a step of supplying at least any of printing ink or dampening water and removing a non-image area of an image recording layer on a printing press to prepare a lithographic printing plate; and

a step of performing printing using the obtained lithographic printing plate.

- indirect infringement of claim 16 EP 3 511 174 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, Finland, Italy, Lithuania, Latvia, Malta, Monaco, The Netherlands, North Macedonia, Poland, Romania, San Marino, Serbia, Slovenia, Spain, Sweden, Türkiye since July 17th, 2019 until May 26th, 2021;

- Belgium, Ireland, Liechtenstein, Luxembourg, Switzerland since July 17th, 2019 until May 31st, 2021,
 - France since July 17th, 2019 until July 26th, 2021,
 - Bulgaria, Norway since July 17th, 2019 until August 26th, 2021,
 - Greece since July 17th, 2019 until August 27th, 2021,
 - Iceland since July 17th, 2019 until September 26th, 2021,
 - Portugal since July 17th, 2019 until September 27th, 2021,
 - the United Kingdom since July 17th, 2019 and while EP 3 511 174 is in force,
 - and in Germany since July 17th, 2019;
- 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 3 511 174 referred to in B.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. 3 511 174 held by Fujifilm Corporation by manufacturing, selling, and offering for sale 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 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.

12. 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. 209).

13. The Defendants request (with regard to the updated amount for the enforcement security, cf. brief of 12 February 2025, workflow App_6928/2025):

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);

14. With regard to their counterclaim for revocation (CC_3097/2024, CC_3099/2024, CC_8809/2024), the Defendants request:

5. revocation of the European patent EP 3 511 174 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 3 511 174 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 3 511 174 B1 (UK) is also invalid in its entirety; and

7. reimbursement of the Defendants' costs of the counterclaim provisionally (Rule 150.2 RoP UPC).

15. The Claimant having filed an Application to amend the patent (App_35678/2024) requests:

C. As a further main request,

to **dismiss** the Counterclaim for Revocation of EP 3 511 174 B1 to the extent of the **new Main request**;

D. As a **subsidiary request**, insofar as the Court considers the claims of EP 3 511 174 B1 to be anticipated by any of the prior art documents invoked as contended in the Counterclaim for Revocation under Articles 54(2), 54(3) EPC and/or Article 56 EPC,

I. to hold that the Application to Amend EP 3 511 174 B1 submitted as Auxiliary Request 1 is admissible;

II. to hold that the Claimant has demonstrated that the contested printing plate precursor SONORA XTRA-3 reproduces or implements claims No. 1, 2, 3, 4, 5, 6, 7, 12, 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. of the Statement of Claim;

E. As **a further subsidiary request**, if the Court considers the claims of EP 3 511 174 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 3 511 174 B1 submitted as Auxiliary Request 2 is admissible;
 - II. to **hold** that the Claimant has demonstrated that the contested printing plate precursor SONORA XTRA-3 reproduces or implements claims 1, 2, 3, 4, 5, 6, 7, 12, 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 1 of the Main Request or of Auxiliary Request 1 and/or 2 of EP 3 511 174 B1 to be violating Article 123 (2) EPC as invoked in the Counterclaim for Revocation,
- I. to **hold** that the Application to Amend EP 3 511 174 B1 submitted as Auxiliary Request 3 is admissible;
 - II. to **hold** that the Claimant has demonstrated that the contested printing plate precursors SONORA XTRA-3 reproduce or implement claims No. 1, 2, 3, 4, 5, 6, 7, 8, 13, 14 and 15 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.
16. The Defendants request to dismiss the Claimant's requests to amend the patent.

POINTS AT ISSUE

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 topmost 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. 469 et seq.; Exhibit K 39 - 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. 472 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. 107 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. 658) 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) due to public prior use, or over WO 379, or over EP 452, and
 - lack of inventive step (Art. 138(1)a) in conjunction with Art. 56 EPC) in the light of EP 452 and common general knowledge, or in combination with pre-published patent applications EP 968, US 599,
 - added matter (Art. 123(2) EPC).

GROUNDS FOR THE DECISION

26. The infringement action being subject to the separate proceeding at hand is admissible and founded as the attacked embodiment infringes upon the validated national part of the patent-in-suit in the UK as well. The UK part of the patent-in-suit is deemed valid – as a prerequisite for finding for infringement of the UK part of the patent-in-suit – for the same reasons, for which the admissible Counterclaim for revocation directed against the German part of the patent-in-suit had been rejected.

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

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

I. RELEVANT REQUESTS CONCERNING THE INFRINGEMENT ACTION

28. The Claimant's amendments to the infringement action are admissible.

Amendments by Claimant's reply

29. 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 as detailed in the decision of 2 April 2025 (para. 25). 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 4 February 2025

30. As far as Claimant has amended its requests for the infringement action by its brief of 4 February 2025, the panel has no concerns under R. 263 RoP either. It is referred to the decision of 2 April 2025 (paras. 26 et seqq).

II. JURISDICTION FOR INFRINGEMENT IN THE UK

31. 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.
32. 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 (Lugao 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.).
33. 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.

34. 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, UPC_CFI_355/2023 (p. 23).

35. 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

36. 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. 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, judgement of 25 February 2025, C-339/2022, para. 73 – BSH Hausgeräte).

37. 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.

III. FURTHER ASPECTS OF ADMISSIBILITY

38. In all other respects, the infringement action is admissible.

B. SCOPE OF THE PATENT-IN-SUIT

39. 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. 41 et seq.).

40. 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 (numbering according to Claimant's feature analysis, but reordered for the sake of better comprehensibility). The Claimant defends its patent-in-suit only with the following limited feature **1.7'**.

1 A lithographic printing plate precursor comprising:

1.1 an aluminum support (10),

1.3 wherein the aluminum support (10) includes an anodized film (20) on a surface of the image recording layer side,

1.8 a thickness (X, F) of the anodized film (10) is in a range of 550 nm to 2850 nm,

1.4 the anodized film has micropores (30) extending in a depth direction from the surface of the anodized film on the image recording layer side,

1.5 the micropores (30) include at least large-diameter pores (130) whose maximum diameter inside the anodized film (34, 122) is in a range of 0.01 μm to 0.30 μm [= 10 nm to 300 nm],

1.6 and wherein an average value of depths of the large-diameter pores (130) to the bottom from the surface of the anodized film (D) is in a range of 100 nm to 1500 nm,

1.7' an average pore diameter of the micropores in the surface of the anodized film (124) is ~~90 % or less~~ in a range of 10 % to 50 % of the maximum diameter of the micropores inside the anodized film; and

1.2 an image recording layer on the aluminum support (10),

1.9 the image recording layer contains an acid color former.

41. The independent procedural claims protect corresponding methods of manufacturing a lithographic printing plate (claim 15) and for printing with that plate (claim 16), 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

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

C. COUNTERCLAIM FOR REVOCATION

43. The counterclaim, being solely directed against the remaining German part of the patent-in-suit (see supra admissibility), is to be dismissed. It is to be stressed, that the following reasoning is solely of relevance to the UK part of the patent-in-suit insofar as the validity of that part of the bundle patent is a prerequisite to find for infringement of the UK part of the bundle patent in the relation between the parties in the proceedings before the UPC. 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 (cf. ECJ judgement of 25 February 2025, C-339/2022, para. 74 – BSH Hausgeräte). The Defendants can neither rely on public prior use, nor does the patent-in-suit lack novelty or inventive step, nor does it contain added matter. In the absence of deviating arguments of the defendants challenging 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 (cf. paras. 64 - 101).

INFRINGEMENT BY SONORA-XTRA 3 PLATES

44. The Defendants also directly infringe upon claim 1 of the UK-Part of the patent-in-suit in the version corresponding to the main request through the commercialization of Sonora-XTRA 3 plates in the UK. The acts of offering, placing on the market, using or storing it for those purposes had not been contested by Defendants with a sufficient level of substantiation (see infra).
45. However, as far as Claimant requests to order that the Defendants shall refrain from making the attacked embodiments in the UK, it failed to submit sufficient

facts that there at least is an imminent danger that the Defendants will infringe upon the UK bundle patent by relocating the production site from Germany to the UK. Furthermore Claimant did not elaborate on the respective principles of UK law applicable to that question. Furthermore Claimant did not argue that the manufacturing in Germany by Defendant 2 under the Toll Manufacturing Agreement with the UK entity of the Kodak Group, Kodak Ltd, Watford, UK (cf. Exhibit K3, page 10), establishes manufacturing in the territory of the UK according to UK law. The Court has taken the order of the Court of Appeal of 14 February 2025 (UPC_CoA_382/2024, APL_39664/2024) into consideration. That order however dealt with the question in a case where the law of the UPCA was applied and when a general preliminary injunction may be justified, and clarified in this regard that a general injunction “may be justified even if it is not shown that a patent is infringed by all possible infringing acts” (cf. headnote and mn. 142). In the case at hand, where UK law is solely applicable to any acts on UK territory, claimant neither put forward any facts why there should be an imminent danger that defendant 2 relocates its manufacturing from Germany to the UK as a Non-EU- and Non-UPC-MS, nor is this likely in the light of the products being manufactured in Osterrode/Germany with processes of considerable manufacturing complexity as well as taking into consideration that the chemical compounds needed for that process like liquid chemicals are being manufactured on site in Osterrode/ Germany as well (see annual financial report Exhibit K3, page 10 and 11), which makes a relocation even more unlikely.

46. Claimant furthermore submitted sufficient facts to find for infringement in the UK. It alleged without this being contested with substantiation that Defendant 2 makes direct deliveries to the UK like in the example of Intuprint as suggested by the “Mintz report” and retaining title to the plates until they reach the distributors’ premises in the UK. Therefore, these acts qualify as disposing in the sense of loss of physical possession by transferring that possession to another entity in the UK under s.60(1)a Patent Act, as offering in the sense of approaching potential customers, individually or by advertisement, indicating a willingness to supply a product, with terms to be agreed under s.60(1)a Patent Act and importing under s.60(1)a Patent Act as construed in *Sabaf v MFI* [2004] UKHL 45 and *Waterford*

Wedgwood v David Nagali [1998] FSR 92 (cited after Exhibit K 39, point 10 and K49). These legal principles of UK law had not been put into question by the Defendants. As the Claimant had good reasons, based on the Mintz report, to make its allegations and as only Defendants have exact knowledge of when and under which conditions title to the plates is retained or transferred, their general disputing of such facts is insufficient. It is the Defendants alone who possess knowledge of the respective facts. Therefore they would have been in a position to submit clear and detailed facts deviating from Claimant's allegation, which under the circumstances of the case at hand could not have been more detailed for lack of knowledge of the facts relating to the delivery to distributors in the UK like Intuprint. Therefore it is insufficient that Defendants only state that "nothing in the Mintz Group report (Exhibit PMJ-1) suggests any different facts" (Rejoinder mn. 664). With respect to Defendants 1 and 3, the Defendants did not suggest any facts and legal standards under UK law, which would bar finding them liable for infringement under UK law alongside Defendant 2 as they had been found liable under the UPCA with respect to acts committed in Germany. It would have been for Defendants to submit detailed deviating facts. Before this background it may remain open whether or not the cooperation under the Toll Manufacturing Agreement is to be qualified as joint tortfeasance.

47. Also Defendants cannot be heard with their argument that the attacked embodiment would not infringe upon feature **1.7'** as no pore diameter in the surface could be measured due to the spike-like structure of the surface of the attacked embodiment. Reference is made to the decision of 2 April 2025 (paras. 103 et seqq.).

NO PRIVATE PRIOR USE RIGHT IN GERMANY AND/OR THE UK

48. Defendants can also not rely on a private prior use right under Art. 28 UPCA, § 12 German Patent Act. At least Defendants did not submit sufficient facts so as to establish that they had also made the final business decision within the Kodak Group to commercialize printing plates with the features of the claimed invention before the relevant priority date. Reference is made to the decision of 2 April 2025 (cf. mn. 117 et seqq). In consequence, Defendants' argument, that the German

prior use right would also extend to acts in the UK due to principles of EU law must also fail.

49. As far as Defendants argue additionally that they could refer to a prior use right under s.64 UK Patents Act 1977 this argument falls through as well, as they did not show a business decision amounting to effective and serious preparations in good faith according to s. 64(1)(b) UK Patents Act 1977 in the UK as the burden of proving that defence also rests on the infringer under UK law (cf. standards of UK law as set out in Exhibit 39).
50. Finally, as the decision on the preliminary objection had been reserved for the main trial, Defendants' argument that Claimant's arguments submitted with regard to UK law had been filed late, cannot be heard.

INFRINGING ACTS AND REMEDIES SOUGHT

51. The infringing acts in the UK, remain undisputed by Defendants. The established infringement predominantly justifies Claimant's requests.

REQUEST FOR DECLARATION OF INFRINGEMENT

52. Since the Claimant did not further elaborate on the request and did not set out that such declaration serves a legitimate interest, the request had to be denied (compare facts in LD Mannheim ORD_11865/2025, UPC_CFI_159/2024 of 11 March 2025 at para. 111), especially since the latest version of the requests explicitly refer to the product name of the attacked embodiment which therefore is displayed in the operative part of the judgement which may be communicated in case of need. Claimant did not submit arguments that a declaratory relief may be granted under different prerequisites according to s.61(1)(e) UK Patents Act 1977.

REQUEST FOR PERMANENT INJUNCTION

53. The requested injunctive relief has its basis in s.61(1)(a) UK patents Act 1977. It

has not been submitted that the court's power to render an injunction under UK law deviates from Art. 25 (a), Art. 63 (1) UPCA. The request is to be granted with regard to the acts of offering, placing on the market and using and the acts of storing and importing for those purposes, within the UK, because the infringement in the past constitutes a risk of repetition, but not for making as set out supra. There is no need for explicitly deciding upon Claimant's "in particular"-requests relating to the subclaims, because they are merely exemplary specifications of acts already covered by the decision relating to the new Main request's claim 1.

54. Since the court has discretion to grant the permanent injunction under UK law as well as under the UPCA (Art. 63 (1) UPCA "may") the circumstances of the individual case can be taken into account, in particular whether an injunction would be disproportionate (Art. 42 UPCA, Art. 3 (2) Enforcement-Directive). Insofar it may be referred to the decision of 2 April 2025.
55. The requested threat of a penalty payment in general terms ("to be determined by the court for each case of infringement") is a sufficient basis to determine such request as Claimant has elaborated on estimated sales price of Defendants' printing plates per square meter at which it arrives by referring to Defendants' annual reports and invoices (Exhibit K12) of roughly 10 € per square meter (SoC para 246), which remained undisputed and rather is in line with Defendants' submissions on security, so that in accordance with previous decisions of the Local Division Mannheim (see LD Mannheim ORD_11865/2025, UPC_CFI_159/2024 of 11 March 2025 at para. 114 (factor 3) and Local division Mannheim ORD_598506/2023 UPC_CFI_210/2023 of 22 November 2024, para. 175: 1.000 € per mobile) to be dissuasive, the amount is set to 50 € per square meter. Defendants did not submit that UK law would not allow such order.

REQUEST FOR DECLARATION OF DAMAGES

56. The declaration of entitlement to damages on the merits is based on s.61(1)(c) UK Patents Act 1977 and justified by the established infringement (cf. decision of 2 April 2025). Defendants did not submit deviating principles to be applied under UK law.

57. The determination of the amount of damages and time periods to be taken into account is reserved for subsequent proceedings under R. 125 et seqq. RoP (see LD Mannheim ORD_11865/2025, UPC_CFI_159/2024 of 11 March 2025 at para. 103 et seqq., 116 and infra at “ordering information”).
58. As far as the requests extends back to 17 July 2019 with regard to UK, in the light of the reasoning given in the statement of claim, the request has to be interpreted to relate to compensation pursuant to Art. 67 EPC the amount of which is to be determined in subsequent proceedings under R. 125 et seqq. RoP as well. Therefore, at this stage, the panel does not have to adjudicate on potential time periods to be left out in this regard either.

REQUEST TO PAY DAMAGES IN COMPENSATION FOR MORAL PREJUDICE

59. Even if the request for damages in compensation for moral prejudice may find a basis in UK law, the request is to be denied as set out in more detail in the decision of 2 April 2025.

REQUEST FOR INTERIM AWARD OF DAMAGES

60. Claimant seeks an interim award of damages. However the request had to be denied for three reasons specified in the decision of 2 April 2025.

REQUEST FOR INFORMATION

61. The request for information had to be accepted. Defendants did not point to deviating principles of UK law in that respect. Therefore, reference is made to the decision of 2 April 2025. The panel does take into account the Court of Appeal’s order of 30 May 2025 (UPC_CoA_845/2024, 50/2025). On the instant facts, considering the complexity, the panel regards it as not feasible to set an appropriate time period in advance in the individual case at hand. Whether the Defendants will have provided the required information in due time, depends on the circumstances and will be assessed in the enforcement proceedings, if necessary.

REQUEST FOR DESTRUCTION, REQUEST FOR RECALL, REQUEST FOR REMOVAL

62. The request to destroy the infringing embodiments in possession and/or ownership in the UK is based on s.61(1)(b) UK Patents Act 1977
63. The recall, not being codified but still being accepted in UK law (Paul England, A Practitioner's Guide to European Patent law 2nd ed. p. 227), is to be restricted to commercial recipients only, because private end users are not part of the channels of commerce (cf. Local Division Düsseldorf, decision of 3 July 2024, UPC_CFI_7/2023, GRUR-RS 2024, 17732 mn. 143). However, Claimant's request takes this into account by restricting the requested recall to the channels of commerce. Again, the Defendants did not state any specific fact which calls for the assumption of disproportionality. It is for the infringer to take the appropriate measures to be taken to make an appropriate recall. Similarly as for the destruction, it lies in the infringer's own vital interest to indicate the fulfilment of its recall obligation beyond any reasonable doubts towards the Claimant in order to avoid an enforcement proceedings. However, contrary to Claimant's request at hand, there is no need to order the infringer to provide a list of the recipients of the recall letter.
64. The requested definite removal of infringing products from the channel of commerce is a separate corrective measure additional to the recall (cf. Local Division Mannheim, decision of 22 November 2024, UPC_CFI_210/2024 mn. 177). The Defendants did not state any specific fact which would turn the removal disproportionate. In the opinion of the panel, it suffices to request and order the definite removal without specifying the modalities thereof (different opinion Local Division Düsseldorf, decision of 3 July 2024, UPC_CFI_7/2023, GRUR-RS 2024, 17732 mn. 147). The reason is that Art. 64 (d) UPCA calls for the success of the definite removal. It is the infringer's responsibility how he guarantees such success. The Defendants, again, did not point to deviating principles of UK law.

REQUEST FOR PUBLICATION

65. The requested publication of an own declaration by the Defendants on their webpage had to be denied for the reasons set out in the decision of 2 April 2025.

REQUEST FOR AN INTERIM AWARD ON COSTS

66. The request for an interim award on costs had been accepted in the main proceeding. There are no grounds to exercise the discretion to grant the interim award on costs again with regard to the follow-up-proceedings to the main proceedings.

INDIRECT INFRINGEMENT

67. With regard to the indirect infringement of claims 15 and 16 in the version corresponding to the main request by the attacked embodiment in the UK, the requests are justified according to s.60(1)(b) UK Patents Act 1977. Reference is made to the considerations supra. As far as requests B.V. also refers to A.III.2 this is considered to be a mere oversight by Claimant. It is furthermore not apparent that the attacked embodiment can be used without making use of the invention so that an unrestricted permanent injunction appears justified.

ENFORCEMENT SECURITY

68. Art. 82 (2) UPCA, R. 118.8 RoP give the court the discretion to make any order subject to the provision of a security for its enforceability. Applying these principles, the panel exercises its discretion not to make the enforceability subject to the provision of a security by Claimant (cf. decision of 2 April 2025).

COSTS

69. The decision on costs is based on Art. 69 (1) UPCA, R. 118.5 RoP. Since the statement of claim was unsuccessful to a minor part only – including the request to render an injunction for making the attacked embodiments – and the panel considers the economical focus of the case to be on the product Sonora XTRA-3, the panel exercises its discretion that the Defendants have to bear the recoverable costs in full despite the partial withdrawal of the infringement action regarding Sonora X and Sonora XTRA-2 and the full substantive scope of the patent-in-suit as granted.
70. Claimant clarified in the oral hearing 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 either.

VALUE IN DISPUTE

71. 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 15.000.000 € after having heard the parties in the oral hearing.

DECISION:

A.I. The Defendants are ordered to refrain from:

1. offering, placing on the market, using or storing it for those purposes a lithographic printing plate precursor within the United Kingdom, that has the following features:

- a. A lithographic printing plate precursor comprising:

- an aluminum support; and

- an image recording layer on the aluminum support,

- wherein the aluminum support includes an anodized film on a surface of the image recording layer side,

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

- the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01 μm to 0.30 μm , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,

- an average pore diameter of the micropores in the surface of the anodized film is in a range of 10% to 50% of the maximum diameter of the micropores inside the anodized film,

- a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

- the image recording layer contains an acid color former,

- direct infringement of claim 1 EP 3 511 174 B1 -

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

lithographic printing plate precursors

which are suitable and intended to use with

- a. method of preparing a lithographic printing plate, comprising

- a step of imagewise-exposing the lithographic printing plate precursor of any of claims 1-14; and

a step of supplying at least any of printing ink or dampening water and removing an image recording layer in a non-image area on a printing press.

- indirect infringement of claim 15 EP 3 511 174 B1 -

b. a printing method, comprising:

a step of imagewise-exposing the lithographic printing plate precursor according to any one of claims 1 to 4;

a step of supplying at least any of printing ink or dampening water and removing a non-image area of an image recording layer on a printing press to prepare a lithographic printing plate; and

a step of performing printing using the obtained lithographic printing plate.

- indirect infringement of claim 16 EP 3 511 174 B1 -

A.II. It is ordered, that in the event of any violation of the injunction under A.I. above, the respective Defendants shall pay severally to the Court a penalty payment of EUR 50 per square meter of the contested printing plate precursor.

B.I. It is held that the Defendants shall pay damages to the Claimant compensating all losses caused by infringing acts referred to in A.I. above in the United Kingdom since 17 July 2019.

II. The Defendants are ordered to inform the Claimant to the extent of which the Defendants have committed the infringing acts of EP 3 511 174 referred to in A.I – stating

1. the origin and distribution channels;

2. the quantities delivered, received or ordered, as well as the price obtained;

in particular

- 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 the Defendants each reserve the right to disclose the names of their non-commercial customers to an impartial auditor only, chosen by Claimant and paid by the respective Defendant, who, upon Claimant's request, confirms or denies whether a specific non-commercial customer is contained in the disclosure and who, in all other cases, is subject to confidentiality towards the Claimant.

- III. The Defendants are ordered to destroy at their own expense the products, material and/or implements referred to under A.I.1. which are in their possession and/or ownership within the United Kingdom.
 - IV. The Defendants are ordered to recall the products referred to under A.I. which have been placed on the market from the channels of commerce, with reference to the infringement determined by a court of law (Unified Patent Court, Local Division Mannheim, decision of 2 April 2025);
 - V. The Defendants are ordered to definitively remove the products referred to under A. I. from the channels of commerce at their own expense.
- C. All further requests of Claimant are dismissed.
 - D. The Defendants have to bear the costs of the litigation.
 - E. The Orders A.I., B.II. to B.VI. shall be enforceable only after the Claimant has notified the Court which part of the orders it intends to enforce, this notification has been served on the Defendant concerned and a certified translation of the orders in the official language of a Contracting Member State in which the enforcement shall take place has been provided by the Claimant and served on the Defendant concerned.

Delivered in Mannheim on 18 July 2025

NAMES AND SIGNATURES

Presiding judge Tochtermann	
Legally qualified judge Agergaard	
Legally qualified judge Böttcher	
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)

An authentic copy of the enforceable decision or order will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.