Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Mannheim Local Division
UPC_CFI_365/2023

Order
of the Court of First Instance of the Unified Patent Court
issued on 23 July 2025
concerning EP 3 511 174
App_25602/2025

CLAIMANT:

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

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DEFENDANTS:

1. **Kodak GmbH,** Kesselstraße 19, 70327 Stuttgart,

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

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2. **Kodak Graphic Communications GmbH,** Kesselstraße 19, 70327 Stuttgart,

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3. **Kodak Holding GmbH,** Kesselstraße 19, 70327 Stuttgart,

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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 order was issued by Judge Tochtermann acting as presiding judge and 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: Application for the imposition of a penalty

STATEMENT OF FACTS AND REQUESTS:

Claimant requests in the course of enforcement proceedings which followed after the decision of 2 April 2025 had been rendered as follows:

We request

I. to issue a warning to the Respondents, based on the circumstances of the individual case, that in the event of any breach of and/or failure to comply with any of the orders set out in Section B.II (information), B.III. (destruction), B.IV. (recall) and B.V. (removal from the channels of commerce) of the judgement dated 2 April 2025, ref. UPC_CFI_365/2023 the respective Respondents shall pay to the court a penalty of up to EUR 30,000.00 per day of delay and/or non-compliance, with any days that have commenced counting as full days;

II. to order the Respondents, by means of an appropriate penalty, the amount of which is to be determined by the panel, to comply with the order under section B.II. (information) of the decision of the Court of First Instance of the Unified Patent Court dated 2 April 2025, ref. UPC_CFI_365/2023;

III.

1. to order that the measures imposed on the Respondents under section B.III. (destruction) of the judgement dated 2 April 2025, ref. UPC_CFI_365/2023, be carried out at the expense of the Respondents and to order the Respondents to hand over products, material and/or implements referred to under A.I.1. of the judgement dated 2 April 2025, ref. UPC_CFI_365/2023, which are in the possession and/or ownership of the Respondents within Germany

   a) to the Applicant

   b) in the alternative to item III.1.a)

      to a Court Bailiff

   for destruction;

2. in the alternative to item III.1.

   to order the Respondents, by means of an appropriate penalty, the amount of which is to be determined by the panel, to comply with the order under section B.III. (destruction) of the decision of the Court of First Instance of the Unified Patent Court dated 2 April 2025, ref. UPC_CFI_365/2023;

IV. to order the Respondents, by means of an appropriate penalty, the amount of which is to be determined by the panel, to comply with the order under section B.IV. (recall) of the decision of the Court of First Instance of the Unified Patent Court dated 2 April 2025, ref. UPC_CFI_365/2023;

V. to order the Respondents, by means of an appropriate penalty payment, the amount of which is to be determined by the panel, to comply with the order under section B.V. (removal from the channels of commerce) of the decision of the Court of First Instance of the Unified Patent Court dated 2 April 2025, ref. UPC_CFI_365/2023;

VI. to order that the Respondents shall bear the costs of the enforcement proceedings;

VII. to declare that the order is immediately enforceable.

Claimant submits, that Defendants did not comply with the decision of 2 April 2025 despite Claimant giving proper notice of enforcement. All formal requirements had been met.

Notification for enforcement of operative part B.II (information) was made on 29 April 2025, notification for enforcement of operative parts B.III. (destruction), B.IV. (recall) and B.V. (removal) on 9 May 2025 and served on that day upon Defendants on that date via the CMS.

A certified translation had been furnished for the enforcement of B.III alone, since Claimant is of the opinion that a translation was only necessary in that respect as the enforcement of the obligation to destroy attacked embodiments needs the support of national authorities whereas enforcement of the other parts of the decision lies in the hands of the UPC itself so that no translation were required.

In the eyes of Claimant defendants did not comply with the operative part of the decision. Claimant had set Defendants three weeks for rendering information, which had lapsed on 20 May 2025. With respect to the other parts of the decision to be enforced Claimant set a period of one week which lapsed on 16 May 2025. Furthermore Claimant reiterated its requests in direct communication to defendants (Exhibit KAP E2). However no response had been received.

The judge-rapporteur gave the defendants the possibility to comment, which requested to reject the request.

Respondents submit that Claimant did not make it sufficiently clear that it intended to unconditionally enforce the operative parts referred to in this request. Rather Claimant made it conditional upon the court issuing a warning, which the court refused to order. Therefore Defendants did not have to understand the overall behavior of Claimant in such a way as to enforce the decision unreservedly.
Furthermore the translation requirements had not been met, since Claimant failed to provide German translations of the operative part and/or the decision as well as of the notice of enforcement. Defendants had already been proactively working on the recall, destruction and information processes and immediately were able to initiate implementation of the measures under section B.II-B.V. of the decision. Claimant had been informed by a letter of 12 June 2025 (Exhibit FBD-E2) that Defendants complied with its obligations. Claimant's application had to be dismissed, as there were no legal basis for the renewed application for a “warning”. The further penalty requests were also inadmissible and unfounded. Furthermore, no reasonable period of time had expired within which Defendants could have complied.

Claimant was given a further opportunity to comment on Defendants’ defense arguments.
Claimant argues there could have been no misunderstanding about its intention to immediately enforce the respective orders. All requests had been correctly served upon Defendants via the CMS and contained unambiguous deadlines. It were neither required to submit a certified translation of the whole decision, nor to submit a certified translation of the notice of enforcement itself. The Defendants did not provide any information according to order B.II. within the reasonable time period of three weeks, the reasonableness being underlined by the fact that Claimant offered an extension of the period but Defendants never responded. Pointing to the absence of one lead sales person alone were insufficient to justify Defendants’ disobedience. Even after more than nine weeks no information had been rendered.
Defendants rather decided to engage in further delaying tactics by submitting clearly unfounded confidentiality requests and did not substantiate their allegations that rendering information were

difficult due to a change in their IT system.
Defendants did not submit sufficient facts so as to have reason to believe that they sent out recall letters to their customers. The draft letter provided also didn't make it clear that the customers may not resell Sonora XTRA-3 plates.
Defendants were also not allowed to withhold items encompassed by the operative part of the decision as evidentiary samples.

For further details reference is made to the briefs and exhibits exchanged between the parties.

GROUNDS FOR THE ORDER:

This order – as Defendants' unsuccessful request for a confidentiality order in the enforcement proceedings – is referred to and decided by the whole panel in order not to prolong these enforcement proceedings any further.

Claimant's application had to be accepted and a penalty be imposed upon Defendants to punish their shortcomings and disobedience with the operative part of the decision of the UPC Claimant seeks to enforce and to coerce Defendants to comply with what had been ordered by the Court.

The penalty regime imposed is three-pronged. For the past period, a lump sum penalty payment is being imposed. In a next step, moderate daily penalty payments are being imposed and a time period is set to catch up on what should already have been provided. In a further step drastic penalty payments are being imposed, in case Defendants still are not prepared to comply with the decisions and orders of the UPC.

GENERAL REQUIREMENTS FOR ENFORCEMENT

The general requirements for enforcement are fulfilled.

According to R. 354.3 RoP, the Court's decisions and orders may provide for periodic penalty payments payable to the Court in the event that a party fails to comply with the terms of the order or an earlier order. The value of such payments shall be set by the Court having regard to the importance of the order in question.

Under the circumstances at hand the court decided in its decision of 2 April 2025 not to provide details of the penalties to be payed up-front as this appeared to be too complex in the case at hand. Rather the court decided that such determination will be made based on the circumstances of the facts contained in the request for enforcement. Any determination up-front could have been disproportionate in either imposing to harsh sanctions on the Defendants or sanctions being not drastic enough in the light of the level of disobedience. Both is to be avoided. Still, the decision clarified that the Defendants have to provide proper information as soon as possible without undue delay and pointed to the possibility of severe penalties to be imposed upon Defendants (cf. decision of 2 April 2025 mn. 140). The same holds true for the further parts of the operative part of the decision Claimant seeks to enforce in the present enforcement proceedings (cf. ibid. mn. 141 (destruction), mn. 142 (recall), mn. 143 (removal)).

Since the court did not put enforcement of the decision under further preconditions, it had been clear from the date of service, i.e. 2 April 2025 of the decision that compliance is mandatory and the only remaining step is a notification of the Claimant according to R. 118.8 RoP. Therefore, as already decided upon the various respective applications of Claimant in the orders issued upon R. 333 RoP requests, no further warning was necessary.

Indeed neither R. 354.3 or .4 RoP explicitly call for a warning. The language of R. 354.3 RoP does not call for a warning at least when – as it had been the case here – the decision on the merits unambiguously states that the imposition of penalties may be the court's reaction to disobedience with the operative part of the judgement. Insofar as some German commentators appear to be of the opinion that such a warning is necessary in all instances (Tilmann/v. Falck/Stoll, Einheitspatent, R. 354 mn. 75, Kircher, Handbuch, 3. Ed, § 27 mn. 49) that opinion may be influenced by the German Code of Civil Procedure (section 890 (II) ZPO), which explicitly states that a prior warning has to be issued either in the final decision or upon subsequent request. However, the terminology of Art. 82 UPCA and R. 354 RoP do not contain such explicit prerequisite of enforcement. That appears not to be an oversight. Rather – within the system of the RoP of the UPC – R. 118.8 RoP already mandates that the defendant is warned by the claimant, who has to fulfil the prerequisites contained therein prior to execution.

The prerequisites of R. 118.8. RoP had been complied with contrary to Defendants' opinion. First, Claimant is correct in arguing that a translation is only necessary where the enforcement is not being carried out by the UPC itself through imposing penalties under R. 354 RoP but through the national enforcement authorities. The provision does not aim at protecting the defendant by ensuring that he is furnished with a version of the operative part to be enforced that he can understand. Rather, defendant has to be able to understand the language of the proceedings as used or determined by the CFI upon request in accordance with Art. 49 UPCA, R. 14 RoP. For defendants which are worthy to be protected due to limiting their commercial activity to one UPC-CMS alone, R. 14.2(b) RoP contains a rule, which is sufficient to protect the interests of such defendants. In contrast, the requirement pursuant to R. 118.8 RoP to serve a certified translation into the official language of a UPC member state, in which the enforcement shall take place, on the defendant in advance serves the purpose of enabling the defendant to verify up-front whether the certified translation on which the national enforcement authorities will base their enforcement measures actually corresponds to the decision to be enforced. In the case at hand, where the language of the proceedings is English and where Defendants are doing business not only in Germany, but throughout Europe and even world-wide, there is no reason to have the operative parts which are being enforced by the UPC to be translated into German. The same holds true for the notification as such. Finally, it is not necessary to translate the whole final decision containing the operative part to be enforced.
As far as Claimant relies on national authorities for enforcement (B.III), a translation of the respective operative part of the final decision had been served.

Pursuant to R. 354.1 RoP, the final decision of 2 April 2025 was enforceable without the provision of a security as of its service on 2 April 2025, subject to R. 118.8 RoP.

The request for enforcement had also not been unclear or based on conditions as Defendants argue. The request and notification have to be read with the eyes of an objective and reasonable party. The understanding outlined by Defendants in their brief can only be characterized as artificial and displaying unwillingness to understand. The intention of Claimant to have the operative parts of the final decision referred to unconditionally enforced is abundantly clear to the objective reader. A subjective and unreasonable construction as presented by Defendants is irrelevant. As far as Claimant refers to warnings being issued and served upon Defendants, Claimant's wish to enforce the decision was by no means made conditional upon the issuance of such warning.

ENFORCEMENT OF THE DUTY TO PROVIDE INFORMATION

In the case of an obligation to communicate information, it is evident that the provision of such information does not have to be provided on the day the notice of intention to enforce is served. It is obvious that the provision of information requires a certain amount of time. For reasons of proportionality (cf. Art. 67(1) UPCA), the party obliged to communicate the information must be granted a reasonable period of time, taking into account the specific circumstances of the individual case. In determining the length of this period, particular consideration must be given, amongst other, to the scope of the information required to be provided, the time period to which the disclosure relates, and the resources available to the obliged part (CoA UPC_CoA_845/2024, APL_68523/2024, UPC_CoA_50/2025, APL_3697/2025 mn. Order of 30 May 2025 – Belkin v. Philips). If, as in the present case, no time period is specified in the final decision, it is the responsibility of the claimant to set a time period for the provision of information when notifying the defendant of the intention to enforce the decision (CoA ibid. mn. 40). In the notice of intent to enforce, Claimant requested Defendants to provide information within three weeks.

This time period had not been too short. First, Defendants should have started to prepare a request for information already as soon as the decision had been served upon them as the duty to render information promptly does not depend on the Claimant starting an enforcement campaign before the court. Second, the information to be provided only dates back to five instead of nine years as in the case decided by the CoA (CoA ibid. mn. 40). Third, the case at hand is not characterised by a complex distribution network and many entities involved in the process of commercialization. Even if one would be of the opinion, that a longer time period were justified, such reasonable period would have been triggered (CoA ibid mn. 41).
In the present case, the reasonable period set by Claimants ended on 20 May 2025. The reasonableness of the period had not been challenged by Defendants, when it was time to do so. Claimant communicated explicitly that Defendants should approach Claimant in case an extension of the period were necessary. However, Defendants decided to argue in that direction only in the course of the present request and decided to accompany its arguments by a further request to set up a confidentiality regime, which had been rejected by the panel by order of 17 July 2025 (App_28969/2025).

In the context of setting the appropriate penalty payment for not fulfilling the obligation to render information the following aspects had to be taken into consideration:

First and foremost – in the present case where the parties argued at length about the confidentiality regime, which finally had been established by panel decision – Defendant, if it had a real and not only a tactical interest in protecting confidential information, would have been obliged to address the points brought up in the recent application in the enforcement proceedings alone upfront in its briefs on the merits. However, at the time no efforts had been made to put forward that a confidentiality regime would have to be implemented in case the court would find for infringement and allow Claimant's requests. Even if one were of the opinion that in the case at hand it were sufficient to address confidentiality aspects only as soon as Claimant notified Defendants of its intention to enforce the decision, Defendants would have been obliged to request protection under R. 262A RoP as early as possible, especially since a full confidentiality club had already been in place and it would not have needed more than a concise brief asking to extend the scope of the confidentiality orders already in place to the information rendered in the course of the enforcement proceedings. Here, Defendants waited to file their request after the time period for commenting to Claimants penalty request had lapsed in order to gain time for tactical reasons alone. Even in their application, Defendants did not submit any arguments limiting itself to stating that the information to be rendered were current business information and pointing to general lines of arguments without stating any material facts why such protection is needed and measures under R. 262A RoP justified. This has to be weighed in the light of the final decision, which already highlighted that a confidentiality request may only be justified in case of an indication of a specific risk of misuse (decision of 2 April 2025 mn. 138). Defendants did not submit that such facts were apparent before or at least had arisen after the final decision had been pronounced.
In addition, the request under R. 262A RoP had only been filed more than seven weeks after Claimant's notification of enforcement. Until Claimant's last brief in the present proceedings, dating 9 July 2025, still no complete information had been rendered. Claimant did not have to accept partial fulfilment by Defendants' letter of 2 July 2025. At that date, i.e. more than two months after Claimant's notice of enforcement, Defendants still just let Claimant know that they were diligently working on compiling information (Exhibit KAP E 05, page1) and pointing to alleged, but unsubstantiated IT transitions problems in the past. Defendants did not even communicate any concrete date, when they have reason to believe that they are able to render the information comprehensively. Also pointing to the vacation absence of one single lead sales person alone is insufficient to justify Defendants disobedience.

ENFORCEMENT OF THE DUTY TO RECALL AND REMOVAL FROM CHANNELS OF COMMERCE

The deadline of one week set by Claimant also appears to be reasonable (cf. LD Munich, decision dated 15 November 2024, UPC_CFI_15/2023, p. 66, 71 — Edwards Lifesciences/Meril). As Defendants bear the burden of proof that their efforts have been sufficient, their statement that "information needs to be pulled manually from the systems" for identification of the customers and establishing a process for the recall itself could not be done within one week is insufficient. Furthermore Defendants only presented a draft recall letter but did not submit any evidence that such letters had actually been sent out, even not within their group of companies, which Claimant highlights with good reason. Defendants furthermore did not submit a list of customers that had been approached.

ENFORCEMENT OF THE DUTY TO DESTROY

Again, the one week's deadline set is reasonable for the obligation to destroy attacked embodiments, especially since Defendants allege that they were only in possession of some infringing embodiments for evidentiary purposes. For the time being, it appears to be sufficient to impose penalty payments upon Defendants, as in the first place Defendants only owe effective destruction but may decide in which way they wish to comply with their obligation. Only if the imposition of the penalties still does not suffice to coerce Defendants to comply with their obligation under the decision, further penalties may be imposed and concrete measures to guarantee destruction may be ordered.

SETTING OF A PROPORTIONATE PENALTY

Taken the afore-mentioned facts into consideration a lump-sum penalty payment for the disobedience with the court's decision of 100.000 €, payable to the Court within two weeks from the date of service of this order, appears to be justified and proportionate in the light of the value of the dispute being set to 15.000.000 € and the level of disobedience up to date as described before.

To coerce Defendants to comply with the operative parts of the final decision Claimant seeks to enforce in these proceedings, a penalty of 2.500 € per day is set for each day of further non-compliance within a period starting with the day of service of this order and extending until the 4 August 2025.

For every day of further non-compliance with this order after 4 August 2025, the penalty is set to 10.000 € per day and may be increased upon further application of the Claimant.

COSTS

Since the Claimant is essentially successful from an economic point of view, the Defendants have to bear the costs of the proceedings.

ORDER:

1. The Defendants are ordered to pay a penalty of 100.000 €, payable to the Court within two weeks from the date of service of this order, for the failure to comply with order B.II. (information), B.III. (destruction), B.IV (recall) and B.V. (removal from the channels of commerce) of the operative part of the final decision of the Local Division Mannheim, Court of First Instance of the Unified Patent Court dated 2 April 2025 UPC_CFI_365/2023 so far.

2. An additional penalty of 2.500 € per day is set for each day of further non-compliance within a period starting with the day of service of this order and extending until 4 August 2025. The accumulated amount is payable to the Court within two weeks after this period has elapsed, i.e. until 18 August 2025.

3. For every day of further non-compliance with this order after 4 August 2025 the penalty is set to 10.000 € per day and may be increased upon further application of the Claimant. The accumulated penalty amount for each one week of further non-compliance is payable to the Court at the latest five business days after the end of the weekly period.

4. This order is immediately enforceable.

5. All other requests of Claimant are rejected.

6. The Defendants have to bear the costs of the proceedings.

Issued in Mannheim on 23 July 2025

NAMES AND SIGNATURES

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