

Order
of the Court of First Instance of the Unified Patent Court
issued on 20 November 2025
concerning EP 3 686 683 B1

CLAIMANT:

Canon Kabushiki Kaisha, represented by its chief executive officer Mr. Fujio Mitarai, 30-2, Shimomaruko 3-chome, Ohta-ku, Tokyo, 146-8501, Japan

represented by: Attorney-at-law Boris Kreye LL.M., Attorney-at-law Anika Boche, Attorney-at-law Lukas Wosnitza, Maximiliansplatz 22, 80333 Munich, Germany,

with support by: Patent Attorney Dipl.-Ing. Rainer Böckelen, Patent Attorney Dipl.-Ing. Tobias Schob, TBK, Bavariaring 4-6, 80336 Munich, Germany,

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DEFENDANTS:

1. **Katun Germany GmbH**, represented by its managing directors Mr. Thomas Arthur Meij and Mr. Robert Henry Moore, Hammfelddamm 4a, 41460 Neuss, Germany
2. **Katun (E.D.C.) B.V.**, represented by its managing director Mr. Robert Henry Moore, De Prinsenhof 11, 4004 LN Tiel, The Netherlands
3. **Katun Corporation**, represented by its chief executive officer Mr. Robert Henry Moore, 7760 France Ave. So., Suite 340, Minneapolis, Minnesota 55435, United States of America
4. **General Plastic Industrial Co., Ltd.**, represented by its chairman Mr. Jack Wang and its president Mr. Jerry Wang, 50, Tzu-Chiang Road, Wu-Chi Dist., Taichung, Taiwan 43547

Defendants 1-4 represented by: Attorney-at-law Dr Thure Schubert, Attorney-at-law Dr Matthias Jentsch, Attorney-at-law Luisa Huber, Patent Attorney Arnold Asmussen, Patent Attorney Dr Axel Leins, Vossius & Partner, Patentanwälte, Rechtsanwälte mbB, Siebertstraße 3, 81675 München, Germany,

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PATENT AT ISSUE:

European patent n° EP 3 686 683 B1

PANEL/DIVISION:

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This order was issued by Judge Dr Schumacher acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: R. 36 RoP – Further exchange of written pleadings

REQUESTS AND PARTIES' SUBMISSIONS:

1. The Claimant requests permission to submit a further pleading as part of the ongoing written procedure in accordance with R. 36 RoP.
2. The Claimant states that:
 - The Opposition Division of the EPO has issued a preliminary opinion concerning the patent in suit, which the Claimant submits as Exhibit C 48.
 - The Opposition Division found that the arguments raised by the opponents in the opposition proceedings (the Defendants 1 to 4) were not convincing.
 - The Claimant conducted an additional test purchase in October 2024 and has only recently concluded the associated monitoring measures. The Claimant has obtained the same infringing embodiment under additional model numbers beyond those identified in the statement of claim.
3. The Defendants request that the application be dismissed.
4. They state that:
 - They do not object to the Court taking the EPO's preliminary opinion into account as a publicly available piece of information, though it is of limited probative weight.
 - Any further arguments or explanations advanced by the Claimant in relation to that preliminary opinion should be disregarded.
 - Regarding the 'second test purchases', the Claimant falls into a circular argument: either the additional products and purchases are materially identical to those already pleaded in the statement of claim, in which case the submission is redundant; or the factual scope of the claim is extended, in which case an application under R. 263 RoP is necessary. Furthermore, the application fails to explain why such material could not have been provided earlier.
5. The Defendants point out that, in the interest of procedural economy and to avoid unnecessary costs, they are refraining from auxiliary requesting a specific time limit for filing

additional pleadings. According to the Defendants, this is because the lack of merit in the R. 36 RoP application lies precisely in the fact that it contains no new or relevant material.

GROUND'S FOR THE ORDER:

6. According to R. 36 RoP, on a reasoned request by a party lodged before the date on which the judge-rapporteur intends to close the written procedure, the judge-rapporteur may allow the exchange of further written pleadings, within a time period to be specified.
7. In this context, it must be considered whether the exchange of further written submissions is required in accordance with the principles of due process, such as in particular the principles of fairness, equity and efficiency and the right to be heard (UPC_CoA_520/2024, Order of 1 November 2024, para 19 – Scandit v. Hand Held Products).

Preliminary opinion of the EPO

8. The submission of the EPO's preliminary opinion (Exhibit C 48) is to be permitted. The Defendants do not object to this.

Summary of the EPO's reasoning

9. As the Claimant's submission relates to the content of the preliminary opinion (para 16 to 28), it is also to be permitted. The Court holds that this part of the submission is essentially a summary of the EPO's preliminary opinion. The content of the submission could have been deduced from the preliminary opinion itself.

Additional test purchase

10. When exercising their discretion, the judge-rapporteur may consider the time at which a request under R. 36 RoP was filed (see UPC_CFI_115/2024 (LD Düsseldorf), Order of 4 March 2025, p. 2 – Hartmann Packaging v. Omni-Pac).
11. The Claimant's application does not sufficiently explain why the submission could not have been made earlier, particularly in the reply to the statement of defence filed on 16 December 2024.
12. The additional test purchase was conducted in October 2024. The Claimant points out that it only recently concluded the associated monitoring measures, after no relevant developments were observed over an extended period. According to the Claimant, the observations should be presented in one streamlined written submission after a comprehensive overview of the Defendants' sales activities has been obtained.
13. The Court believes that the Claimant was obliged to take the necessary measurements without delay. As the deadline for the reply to the statement of defence had not yet passed at the time of the test purchase, the measurements should have been taken immediately, with the results being included in the reply. This would have given the Defendants the opportunity to comment on the results in their rejoinder.
14. However, the Claimant itself states that the submission does not introduce any genuinely new subject matter, since it concerns the same infringing embodiment that is being sold under additional model numbers. According to the Claimant, the toner bottles sold under the additional model numbers are not only identical with respect to the features of the

patent in suit, but also structurally identical to the toner bottles already specified in the statement of claim.

15. If this is true, the additional model numbers will be included in the operative part of the decision anyway (see UPC_CFI_132/2024 (LD Mannheim), Order of 14 May 2025, p. 3 – Total Semiconductor v. Texas Instruments; UPC_CFI_750/2024 (LD Mannheim), Order of 5 June 2025, p. 4 – Fingon v. Samsung), as the Claimant rightly points out.

ORDER:

1. The Claimant may submit the EPO's preliminary opinion (Exhibit C 48) and a summary of the EPO's reasoning until 21 November 2025. This written statement has already been filed.
2. The further request is rejected.
3. Upon expiry of the period as set out in point 1, the written procedure shall be deemed closed.

Issued in Düsseldorf on 20 November 2025

NAMES AND SIGNATURES

Judge Dr Schumacher