Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Reference no:

UPC-COA-312/2025

ORDER

of the Court of Appeal of the Unified Patent Court

issued on 24 November 2026

HEADNOTES:

1. A preliminary opinion given by the Court at the beginning of the oral hearing does not constitute a decision on the issues concerned. In particular, an indication that the Court is provisionally inclined to admit or disregard an argument or item of evidence does not, in itself, remove that matter from the proceedings.

KEYWORDS:

rehearing

APPLICANT

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

represented by attorney-at-law Christof Augenstein, Kather Augenstein Rechtsanwälte PartGmbB

RESPONDENTS

1) Kodak GmbH, Kesselstraße 19, 70327 Stuttgart, Germany

2) Kodak Graphic Communications GmbH, Kesselstraße 19, 70327 Stuttgart, Germany

3) Kodak Holding GmbH, Kesselstraße 19, 70327 Stuttgart, Germany

all represented by attorney-at-law Kilian Seidel, Freshfields PartG mbB

PATENT AT ISSUE

EP 3 511 174

DECIDING PANEL

Panel 1c
Klaus Grabinski, presiding judge and president of the Court of Appeal
Paolo Catallozzi, legally qualified judge and judge-rapporteur
Peter Blok, legally qualified judge

LANGUAGE OF THE PROCEEDINGS

English

DECISION UNDER REVIEW

□ Numbers attributed by the Court of Appeal: UPC_CoA_312/2025, UPC_CoA_333/2025, UPC_CoA_880/2025 and UPC_CoA_882/2025.

SUMMARY OF FACTS

1. By decision of 2 June 2026 the Court of Appeal decided the appeals concerning the infringement actions and the counterclaims for revocation relating to EP 3 511 174 (German and UK designations). As regards the infringement actions, it set aside the decisions of the Court of First Instance and dismissed the Applicant's requests on the ground of a right of private prior use.

2. On 31 July 2026 the Applicant filed an application for rehearing pursuant to Art. 81 UPCA and R. 245 et seq. RoP requesting that: (a) the application be allowed and the decision of 2 June 2026 be set aside or, alternatively, suspended insofar as it concerns the right of private prior use, and that the proceedings be reopened for a new hearing and decision; (b) the application be granted suspensive effect; and (c) the President of the Court of Appeal order that judges other than those who participated in the decision of 2 June 2026 sit on the panel deciding the application for rehearing and, in the event of a reopening of the proceedings, also thereafter.

3. In support of the application, the Applicant submits that the decision is affected by fundamental procedural defects within the meaning of Art. 81(1)(b) UPCA. In particular, it contends that the Court relied on confidential material which it had not been afforded an effective opportunity to address; admitted Exhibits FBD-T 59 and

FBD-T 62 contrary to its preliminary indication at the oral hearing; attributed to certain exhibits an evidential significance which had not been sufficiently discussed; and relied on a new technical argument concerning "Thickness C" and Example 3 of the Patent at issue without affording the Applicant an effective opportunity to respond. According to the Applicant, those defects infringed its right to a fair trial and its right to be heard and were decisive for the outcome of the appeal proceedings.

4. By order of 31 August 2026, the Court dismissed the request that the application for rehearing be given suspensive effect.

5. The Respondents request that the application be dismissed, that parts of the Applicant's submissions be disregarded as belated, and that the Applicant be ordered to bear the costs of the proceedings. The Respondents submit that none of the alleged defects constitutes a fundamental procedural defect within the meaning of Art. 81(1)(b) UPCA. In particular, they contend that the Applicant had a sufficient opportunity to comment on the material concerning the right of private prior use, on Exhibits FBD-T 59 and FBD-T 62, on the existence of a decision to make commercial use of the invention and on the submissions concerning the scope of the prior use right. They further submit that, in respect of certain alleged defects, the requirement laid down in R. 248 RoP was not satisfied and that, in any event, none of the alleged defects was decisive for the outcome of the appeal proceedings.

GROUNDS FOR THE ORDER

Legal framework.

6. Pursuant to Art. 81(1) UPCA, a request for rehearing after a final decision of the Court may exceptionally be granted by the Court of Appeal on the ground of the discovery of a fact of such a nature as to be a decisive factor and which, when the decision was given, was unknown to the party requesting the rehearing, provided that the request is based on an act which has been held, by a final decision of a national court, to constitute a criminal offence, or on the ground of a fundamental procedural defect. Under R. 245.1 RoP, an application for rehearing may be lodged by a party adversely affected by a final decision within the meaning of that provision.

7. A rehearing is not an ordinary appeal, but an extraordinary legal remedy. Only a procedural defect that is so fundamental that it is intolerable for the legal system may justify overriding, in the interest of justice, the principle that proceedings which have led to a final decision should not be reopened. Furthermore, a defect may be regarded as fundamental only if it is established that, without that defect, the same decision would not have been taken. It is for the applicant to establish that those requirements are met (Court of Appeal, decision of 19 June 2025, *Alexion v Amgen*, UPC_CoA_405/2024, paras 11-13; Court of Appeal, decision of 24 February 2026, *Suinno v Microsoft*, UPC_CoA_883/2025 and UPC_CoA_892/2025, para. 13).

8. A rehearing does not provide the parties with a further opportunity to challenge the Court's interpretation of the applicable law or its assessment of the requests, facts and arguments submitted in the original proceedings. A mere disagreement with the reasoning of the Court of Appeal or with the outcome of the case does not constitute a ground for rehearing (Court of Appeal, decision of 24 February 2026, *Suinno v Microsoft*, UPC_CoA_883/2025 and UPC_CoA_892/2025, para. 23).

9. Under R. 248.1 RoP, an application based on a fundamental procedural defect is admissible only where an objection in respect of that defect was raised during the proceedings before the Court of First Instance or the Court of Appeal and dismissed by the Court, unless the objection could not have been raised during those proceedings.

No opportunity to comment on confidential material.

10. The Applicant submits that it was prevented from commenting effectively on confidential material relating to the Respondents' alleged possession of the invention and their decision to make commercial use of it. According to the Applicant, that material could not lawfully have been discussed in public because it was subject to confidentiality orders. It contends that, although its representative indicated that exclusion of the public was necessary in order to address the material in detail, the Court did not exclude the public and subsequently relied on that material in the decision.

11. This complaint does not satisfy the requirement laid down in R. 248.1 RoP. Even on the Applicant's own account of the oral hearing, the statements on which it relies did not amount to an objection in respect of the procedural defect now alleged which was raised and dismissed by the Court.

12. In relation to Exhibit FBD-T 18, the Applicant relies on the statement of its representative that "we need to exclude the public to go to the details". As described in the application for rehearing, that statement indicated that exclusion of the public would be necessary in order to discuss the confidential details of that exhibit. However, the Applicant has not established that its representative formulated a request for the exclusion of the public on which the Court was invited to rule, or that such a request was dismissed.

13. The Applicant also refers to a subsequent exchange concerning Exhibits FBD-T 16 and FBD-T 75, during which its representative stated that it was "a good point in time to exclude the public". According to the application, the ensuing discussion concerned the extent to which confidentiality was maintained and whether the relevant material could be addressed without disclosing protected information. The application does not, however, establish that the Applicant requested a ruling on the exclusion of the public, or that such a request was dismissed.

14. Nor has the Applicant established that an objection could not have been raised during the appeal proceedings. If it considered that the presence of the public

prevented it from making submissions necessary for the presentation of its case, it could have requested a ruling on the exclusion of the public and, if the request was not granted, raised an objection in that respect. Even on the facts stated in the application, it did not do so. The exception under R. 248.1 RoP for defects in respect of which an objection could not have been raised is therefore not applicable.

15. This conclusion is not called into question by the fact that the Court, at the start of the oral hearing, gave a preliminary opinion indicating that the Court would not accept a prior use right. For the reasons given below in paragraphs 19 et seq., the Applicant could not reasonably regard the preliminary opinion as a final decision on the issue. The Applicant's contention that it could not have raised an objection because it was not foreseeable that the facts and evidence used by the Court in support of its decision on the private use right were of any relevance, is therefore ill-founded.

16. In any event, the complaint is unfounded. The right to be heard is reflected in Art. 76(2) UPCA, which provides that decisions on the merits may only be based on grounds, facts and evidence which were submitted by the parties or introduced into the procedure by an order of the Court and on which the parties have had an opportunity to present their comments (Court of Appeal, decision of 19 June 2025, *Alexion v Amgen*, UPC_CoA_405/2024, para. 23). The confidential material had been submitted during the written procedure, and the Applicant had been afforded an opportunity to comment on it in writing. The matters to which that material related, including possession of the invention and the existence of a decision to make commercial use of it, were also in dispute in the appeal proceedings.

17. The Applicant has not established, even on its own account of the oral hearing, that the Court prevented it from presenting any specific submission. The additional arguments advanced in the application concerning alleged inconsistencies between the written witness statements and other exhibits seek, in substance, a fresh assessment of the evidential value of the material considered in the decision. The assessment of that material and the conclusions drawn from it cannot as such be reviewed in rehearing proceedings.

Exhibits allegedly excluded during the oral hearing.

18. The Applicant further submits that the admission and consideration of Exhibits FBD-T 59 and FBD-T 62 infringed its right to be heard. It relies on the preliminary assessment communicated at the beginning of the oral hearing, according to which the Court was at that stage not inclined to admit those exhibits. It argues that, since the Court did not subsequently announce that it had departed from that assessment, it had no reason to address the admissibility and content of the exhibits in further detail.

19. This complaint is unfounded. The UPCA and the Rules of Procedure do not require the Court to communicate a preliminary opinion to the parties. R. 112.4 RoP provides

only that the presiding judge may give a preliminary introduction to the action at the beginning of the oral hearing. Such an introduction does not necessarily include an opinion on the factual or legal issues to be determined. Nevertheless, in the exercise of its case-management powers, the panel may consider it appropriate, for the efficient and effective conduct of the oral hearing, to communicate its preliminary opinion on all or some of the issues in dispute. By doing so, the Court enables the parties to understand its provisional position, to focus their oral submissions on the matters identified and to seek to persuade the Court to confirm or reconsider that position.

20. A preliminary opinion does not constitute a decision on the issues concerned. In particular, an indication that the Court is provisionally inclined to admit or disregard an argument or item of evidence does not, in itself, remove that matter from the proceedings. A definitive exclusion requires a procedural decision to that effect, including, where appropriate, a decision excluding the relevant issue from consideration under R. 334(f) RoP.

21. In the present case, it is not disputed that the Court stated at the beginning of the oral hearing that the views communicated to the parties were preliminary and that it did not consider itself bound by them. With regard to Exhibits FBD-T 59 and FBD-T 62, the Court indicated that, at that stage, it was not persuaded that there were sufficient grounds for admitting them. However, the Court did not make a decision excluding those exhibits from the proceedings or otherwise remove the question of their admission from consideration.

22. The Applicant could not therefore reasonably regard the preliminary opinion as a final determination that Exhibits FBD-T 59 and FBD-T 62 would not be admitted. The question remained open for determination in the light of the parties' submissions and the Court's final assessment of whether the exhibits constituted further evidence of facts already stated in the Statement of defence or introduced new facts or grounds of defence.

23. The Court was not required, before closing the oral hearing, to inform the parties whether and to what extent its preliminary opinion had evolved. The purpose of communicating such an opinion is to facilitate the discussion at the oral hearing, not to provide the parties with an advance decision or a continuing account of the panel's deliberations. The right to be heard does not require the Court to inform the parties in advance of its opinion on every issue in dispute or of the basis for that opinion, unless the decision could not have been objectively foreseen and would come as a surprise to a well-informed representative (Court of Appeal, decision of 19 June 2025, UPC_CoA_402/2024, *Alexion v Samsung*, para. 24).

24. The admission of Exhibits FBD-T 59 and FBD-T 62 was not objectively unforeseeable. According to the Applicant's own account, the preliminary opinion addressed whether the allegations and evidence filed after the Statement of defence could be regarded as mere elaborations of arguments and evidence already submitted. In the

decision of 2 June 2026, the Court admitted the exhibits because it considered them to be further evidence of facts already stated in the Statement of defence and disputed by the Applicant, rather than new facts or new grounds of defence. The final determination therefore concerned the same procedural question addressed in the preliminary opinion and did not rest on a procedural basis which had not previously formed part of the proceeding.

25. The same considerations apply to the Applicant's reliance on the principle of equality of arms. The fact that the preliminary opinion expressed at the beginning of the oral hearing was favourable to the Applicant did not give rise to a legitimate expectation that it would remain unchanged. Both parties were entitled to address the issues identified by the Court and to seek to persuade it to adopt their respective positions.

26. To the extent that the Applicant challenges the Court's ultimate conclusion that Exhibits FBD-T 59 and FBD-T 62 were admissible, rather than the opportunity afforded to it to comment on that issue, that challenge falls outside the scope of rehearing proceedings. This applies also to its submissions concerning when the measurements could have been performed and filed, which challenge the assessment underlying the admission of the exhibits and the exercise of the Court's discretion under R. 222.2 RoP. The assessment of the parties' arguments and evidence, and the conclusions drawn from them, cannot, as such, be reviewed in rehearing proceedings.

Evidential relevance of the material.

27. The Applicant further challenges the finding that, after the composition of the product had been tested, Kodak Graphic Communications GmbH had taken a decision on its final composition and, ultimately by December 2017, to commercialise the product in the sense of manufacturing it for commercial purposes. It submits that, in reaching that conclusion, the Court relied on confidential material which could not be adequately discussed in public and on exhibits which had been presented and discussed, if at all, only in relation to possession of the invention. According to the Applicant, the Court did not indicate during the oral hearing the evidential significance that it might attribute to those exhibits in determining whether a decision to make commercial use of the invention had been taken.

28. Insofar as the complaint concerns the Applicant's alleged inability to comment on confidential material, it must be rejected for the reasons set out in paragraphs 10 to 17 above.

29. As regards the alleged use of the exhibits for a purpose other than that for which they had been submitted or discussed, the application does not sufficiently specify the factual basis of the complaint. The Applicant does not identify the passages in the parties' written submissions from which it would follow that the facts and evidence concerned had been relied upon exclusively in relation to possession of the

invention or that their relevance to the existence of a decision to make commercial use of it had otherwise been excluded.

30. In any event, as stated in the decision under review, the facts concerning the development, manufacture, delivery and sale of the SONORA X printing plate precursors, and the evidence relating to those facts, had been introduced during the written procedure in support of the Respondents' private prior use defence. The Applicant does not dispute that those facts and evidence formed part of the proceedings or that they had been relied upon in support of that defence. It submits, rather, that most of the exhibits concerned had been relied upon by the Respondents to establish actual use of the invention, and not the existence of a firm and final decision to make commercial use of it.

31. However, once facts and evidence have been duly introduced into the proceedings, it is for the Court to interpret the parties' submissions, determine the relevance of the facts alleged and assess freely and independently the probative value and significance of the evidence in accordance with Art. 76(3) UPCA. Whether the Court correctly interpreted those submissions or assessed the relevance or probative value of that evidence concerns the merits of the decision. Any error in that assessment does not, as such, constitute a fundamental procedural defect and cannot be reviewed in rehearing proceedings.

Scope of the right of private prior use.

32. Finally, the Applicant submits that its right to be heard was infringed in the assessment of whether the right of private prior use relating to SONORA X extended to SONORA Xtra-3. According to the Applicant, the decision relied on a technical argument concerning "Thickness C" and Example 3 of the Patent which had not been raised in the Respondents' written submissions and was introduced for the first time at the oral hearing.

33. The Applicant further submits that the Court's treatment during the oral hearing of the Respondents' argument concerning the absence of a technical effect associated with amended feature 1.7' led it reasonably to understand that the argument would be disregarded as late filed. It contends that, nevertheless, the decision relied on the more specific "Thickness C" argument in concluding that SONORA Xtra-3 did not realise an additional advantage over SONORA X. In view of the novelty and technical complexity of that argument, the Applicant claims that it was not afforded sufficient time or an adequate opportunity to respond to it before that reasoning was adopted in the decision.

34. This complaint does not satisfy the requirement laid down in R. 248.1 RoP. Even on the Applicant's own account, it was aware during the oral hearing of the circumstances which, according to it, prevented it from responding effectively to the "Thickness C" argument. If the Applicant considered that the novelty or technical complexity of that argument, or the time available, did not allow it to respond

effectively, it could have brought that difficulty to the Court's attention and requested an appropriate procedural measure. The Applicant has not established that it raised an objection or made such a request, or that an objection could not have been raised during the oral hearing.

35. The Applicant's contention that it reasonably understood that the argument would be disregarded as late filed does not alter that conclusion. As stated above in relation to a preliminary opinion, provisional views or indications expressed by the Court in order to focus and structure the oral hearing do not constitute a decision on the issues concerned. The Applicant does not identify any ruling by which the Court decided that the argument would be disregarded.

36. To the extent that the Applicant challenges the Court's interpretation of Examples 3, 19 and 22, the relationship between the diameter ratio and "Thickness C", the technical conclusions drawn from the data in the Patent, or the application of the case law of the German Federal Court of Justice concerning the scope of a right of private prior use, its complaint concerns the merits of the decision. Any error in the formulation or application of the relevant substantive test, or in the assessment of the technical material, does not, as such, constitute a fundamental procedural defect and cannot be reviewed in rehearing proceedings.

Conclusions.

37. It follows that the application for rehearing must be rejected as not allowable.

*Cost*s.

38. As the unsuccessful party, the Applicant shall bear the costs of the rehearing procedure, as requested by the Respondents. These costs shall be included in the costs of the appeal procedure.

ORDER

The Court of Appeal:

i) rejects the application for rehearing as not allowable;

ii) orders the Applicant to bear the Respondents' costs of the rehearing procedure.

Issued on 24 November 2026.

KLAUS STEFAN MARTIN Grabinski

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Date: 2026.11.23 19:24:09 +01'00'

Klaus Grabinski, presiding judge and President of the Court of Appeal

Paolo Catallozzi

Firmato digitalmente da Paolo Catallozzi
Data: 2026.11.24 15:12:58 +01'00'

Paolo Catallozzi, legally qualified judge and judge-rapporteur

Peter Hendrik Blok

Digitally signed by Peter Hendrik Blok
Date: 2026.11.24 08:22:59 +01'00'

Peter Blok, legally qualified judge