



Düsseldorf Local Division
UPC_CFI_355/2023
UPC_CFI_186/2025

Decision
of the Court of First Instance of the Unified Patent Court
delivered on 9 July 2025
concerning EP 3 594 009 B1

CLAIMANT:

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

represented by: Attorney-at-law Lars Baum, Attorney-at-law Amedine Métier, Attorney-at-law Laurène Borey, Attorney-at-law Alix Fourmaux, Attoreney-at-law Joscha Torweihe, HOYNG ROKH MONEGIER, Steinstraße 20, 40212 Düsseldorf, Germany

assisted by: Patent Attorney Christian Hollatz, Patent Attorney Claudia Schwartzkopff, Ter Mer Steinmeister & Partner Patentanwälte mbB, Nymphenburger Straße 4, 80335 München, Germany

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DEFENDANTS:

- 1. Kodak GmbH**, represented by its CEOs Sven Freyer and Manfred Stegmaier, Kesselstraße 19, 70327 Stuttgart, Germany
- 2. Kodak Graphic Communications GmbH**, represented by its CEOs Sven Freyer and Manfred Stegmaier, Kesselstraße 19, 70327 Stuttgart, Germany
- 3. Kodak Holding GmbH**, represented by its CEOs Sven Freyer and Manfred Stegmaier, Kesselstraße 19, 70327 Stuttgart, Germany

all Defendants represented by: Attorney-at-law Wolrad Prinz zu Waldeck und Pyrmont, Attorney-at-law Kilian Seidel, Attorney-at-law Eva Acker, Freshfields Partnerschaftsgesellschaft mbB, Feldmühleplatz 1, 40545 Düsseldorf, Germany

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assisted by: Patent Attorney Dr Natalia Berryman, Patent Attorney Dr Ursula Schnakenbeck, Vossius & Partner Patentanwälte

PATENT AT ISSUE:

European patent No. EP 3 594 009 B1

PANEL/DIVISION:

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This decision is delivered by Presiding Judge Thomas acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Procedure for a cost decision – Art. 69 UPCA, R. 150 et seqq. RoP

SUMMARY OF THE FACTS:

1. The Claimant sued the Defendants for infringing EP 3 594 009 B1 (hereinafter: the patent in suit) in Germany and the United Kingdom. The proceedings were being conducted under the file number ACT_578607/2023 (UPC_CFI_355/2023). The Defendants contested the infringement of the patent in suit. Additionally, the Defendants filed a counterclaim for revocation (CC_3088/2024, CC_3090/2024 and CC_3093/2024). The Claimant opposed the counterclaim for revocation and filed an application to amend the patent (App_33385/2025) as an alternative.
2. On 28 January 2025, the Düsseldorf Local Division revoked the patent in suit in its entirety and dismissed the infringement action. According to this decision, the costs of the infringement action and the counterclaim for revocation are to be borne by the Claimant. The value in dispute of the infringement action and the counterclaim for revocation was set at € 15,000,000.00 each. The ceiling for recoverable costs for the infringement action and the counterclaim for revocation was set at € 1,500,000.00 in total. This ceiling includes a 25 % increase of the applicable level by 25 %.
3. On 28 February 2025, the Defendants submitted an application for a cost decision, claiming the costs of the infringement action and the counterclaim for revocation. In response to Claimant's comment on the application for a cost decision, the Defendants additionally claimed representation costs for the cost procedure. The claimed costs are broken down as follows:

	Type of costs	Amount in EUR
UPC_CFI_355/2023 ACT_578607/2023 CC_3088/2024 (CC_3090/2024, CC_3093/2024)	Representation costs for the infringement action and counterclaim for revocation (R. 152.1 RoP UPC)	
	Representation costs for the cost procedure (R. 152.1 RoP UPC)	
	Other expenses (R. 151(d))	
	Costs of the successful party (R. 150.1 RoP UPC)	
	Costs of experts (R. 181, 153 RoP UPC)	
	Court fees (R. 151(d) RoP UPC)	20,000.00
	Total	

INDICATION OF THE PARTIES' REQUESTS:

4. The Defendants request,
 - I. to set the costs to be awarded to the Defendants to the amount of [...];
 - II. to order the Claimant to pay the costs within the period ordered by the judge-rapporteur.
5. The Claimant partially opposed the application for costs.

POINTS AT ISSUE:

6. The Defendants' content that, due to the complexity of the case and the intersection of a total of four infringement proceedings as well as a multitude of legal issues, it was necessary to entrust a team of 9 attorneys, seven of them UPC representatives and two UK solicitors, two European Patent Attorneys, one of them also a UPC representative, for the defence against Claimant's complaint. In addition, further employees of Freshfields and Vossius worked on the case for a fewer number of hours compared to the core team.
7. In addition to the representative costs, the Defendants are claiming other expenses and the costs of the successful party and costs of experts.

8. Travel expenses totalling [...] were incurred for two of the Defendants' employees to participate in the oral hearing and a preparatory meeting the day before.
9. [...]
10. The Defendants also engaged Prof. [...] for the computation of HOMO values of certain compounds disclosed in the prior art to show that the patent in suit is not novel. The expenses incurred for the work of Prof. [...] in the amount of [...] were, according to the Defendants, necessary for the defence and reasonable in amount.
11. Additionally, the Defendants engaged barrister [...] to consult with regard to conflict of law issues arising in relation to the UK aspects of the claim. According to the Defendants, consulting barrister [...] was necessary and cost-effective due to his specialism in this field. According to the Defendants, the amount of [...] was also reasonable and proportionate in light of the complex competency questions with regards to the United Kingdom.
12. In its response to Claimant's comments on the application for a cost decision, the Defendants also claimed reimbursement of [...] for representation costs in the procedure for cost decision. [...]
12. The Claimant partially contested the costs claimed.
13. Regarding the costs claimed by the representatives, it should be noted that the ceiling is € 1.2 million. While the Court has set the ceiling at € 1.5 million in recognition of a 25 % increase, such an increase requires a formal application. In view of the Claimant, this application is lacking in the present case.
14. In the Claimant's view, the travel expenses claimed by the Defendants are unreasonable. According to economical litigation, the two employees could either have participated in the preparation meeting and the oral hearing via videoconference, or an equally informed employee could have participated at lower travel costs. In particular, the Claimant does not consider the following to be reimbursable: [...]
15. Regarding the alleged expert costs, the Claimant asserts that an attorney participating [...], based on typical attorney hourly rates, does not constitute an "expert" under R. 153, 181 RoP. Unlike an expert opinion, the purpose of the [...], according to the Defendants, was merely to reassess arguments already submitted in the proceedings. Therefore, in the Claimant's view any costs relating to the [...] are not reimbursable. Furthermore, with an hourly rate of [...], attorney [...] alleged fee immensely exceeds the customary rate for an expert and is therefore not reimbursable, according to the Defendants.
16. The same applies to barrister [...]. Therefore, Mr. [...]’s costs are neither reasonable nor proportionate. Furthermore, the Defendants already list three UK solicitors among their representatives. From the Claimant's perspective, it is not apparent why additional consultation with a barrister could be required. As the costs are not substantiated any further, they are not to be reimbursed either. Since the costs claimed for the services of [...] and Mr [...] would only be eligible for reimbursement as costs for representation, if at all, these costs would not only exceed the applicable cost ceiling of € 1.2 million.
17. The Defendants objected the Claimant's arguments. According to the Defendants, the increase in the ceiling is both effective and lawful. Contrary to the Claimant's submissions, an

explicit request by the parties is not required. Even if that were the case, the Claimant impliedly requested an increase of the ceiling when responding to the Court's procedural order of 9 December 2024 and during the oral hearing when they agreed to the Court's indication to raise the ceiling. In any case, the Claimant did not object to the increase in the ceiling in a timely manner.

GROUNDS FOR THE DECISION:

18. The application for a cost decision is admissible and mostly well founded.

I. Principles

19. According to Art. 69(1) UPCA, reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity requires otherwise, up to a ceiling in accordance with the Rules of procedure.
20. For representation costs, this principle is specified in R. 152.1 and .2 RoP to the effect that the applicant shall be entitled to recover reasonable and proportionate costs for representation, whereby the Administrative Committee shall adopt a scale of ceilings for recoverable costs by reference to the value in dispute. Regarding expert costs, R. 153 RoP stipulates that the compensation for costs of experts of the parties exceeding the expenses referred to in R. 180.1 RoP shall be based on the rates that are customary in the respective sector, with due regard to the required expertise, the complexity of the issue and the time spent by the expert for the services.
21. The costs of the legal dispute are those that have actually been incurred in the specific pending or disputed proceedings. These include the costs listed in R. 151(d) RoP, in particular. Other costs are those that have not been incurred in the pending proceedings, but which are directly and closely related to them (see UPC_CFI_696/2024 (LD Munich, Panel 2), Decision of 19 March 2025 – MSG Maschinenbau v EJP Maschinenbau; UPC_CFI_363/2023 (LD Düsseldorf, Decision of 14 April 2025 – Seoul Viosys v expert; UPC_CFI_16/2024, Decision of 22 April 2025, mn. 16 – Ortovox v Mammut).
22. To be eligible for reimbursement, the costs in question must be cumulative reasonable and appropriate, which is always a matter of individual assessment. These criteria are intended to safeguard the objectives set out in Art. 3 and 14 of the Directive 2004/28, namely to ensure a high level of protection for European patents and to prevent an injured party from being deterred from taking legal action to enforce its rights. They also aim to ensure that the measures, procedures and remedies necessary for the enforcement of intellectual property rights are not unnecessarily costly (ECJU, 28 April 2022 – C-531/200 – NovaText/Ruprecht-Karls-Universität Heidelberg; ECJU, 28 April 2022 – 559/20 – Koch Media/Funke; ECJW, 28 July 2016 – C-57/15 – United Video Properties/Telenet; UPC_CFI_16/2024 (LD Düsseldorf), Decision of 22 April 2025, mn. 17 – Ortovox v Mammut). This also applies for the legal defence.
23. Taking this into account, “reasonable” essentially means “necessary”. From the perspective of a reasonable and rational party, the decisive factor is whether the measure that incurred the costs was objectively necessary and appropriate for achieving the legitimate object of the proceedings. Therefore, the measure must be relevant to the pursuit or defence of legal rights (UPC_CFI_16/2024 (LD Düsseldorf), Decision of 22 April 2025, mn. 18 – Ortovox v Mammut).

24. The focus of appropriateness is primarily on the amount of costs incurred. The costs incurred by the necessary measure must not be disproportionate. In particular, they must not exceed the value in dispute, the significance of the case, the difficulty and complexity of the relevant legal and factual issues, and the measure's prospects of success. An ex ante assessment is also appropriate here (UPC_CFI_696/2024 (LD Munich, Panel 2), Decision of 19 March 2025, mn. 18 – 22 – MSG Maschinenbau v EJP Maschinenbau; see also UPC_CFI_363/2023 (LD Düsseldorf), Decision of 14 April 2025 – Seoul Viosys v expert; UPC_CFI_16/2024 (LD Düsseldorf), Decision of 22 April 2025, mn. 19 – Ortovox v Mammut).

II. Reimbursability in the present case

25. Following these principles, costs in the amount of [...] are acknowledged by the Court.
26. In its decision of 28 January 2025, the Court has set the ceiling for recoverable costs for the infringement action and the counterclaim for revocation at € 1,500,000.00. This ceiling, which was set by the Court based on the Parties' submissions in the oral hearing and the cost agreement reached there, is to be taken as a basis in the present proceedings for a cost decision. This already applies because none of the Parties has challenged the ceiling set by the Court based on Art. 2(1)(b) Scale of ceilings for recoverable costs adopted by the Administrative Committee on 24 April 2023. Therefore, the Claimant's allegation that the conditions for an increase of the ceiling were not met is unfounded in the proceedings for the determination of costs.
27. The Claimant has objected unsuccessfully to the costs of [...] claimed for the travel and accommodation costs regarding the attendance of Mr. [...] and [...] at the oral hearing. The Defendants cannot be required that all of their party's representatives participate in the oral hearing online. Since the Defendants have limited their participation to two representatives, the number of party's representatives is within the usual range. Furthermore, the claimed expenses are neither disproportionate nor unreasonable. This applies to both the number of Defendants' representatives (two) and the travel expenses incurred by them and claimed in the present case.
28. With regard to the Defendants' claim for reimbursement of expert costs, the Court recognises only the costs incurred as a result of engaging Prof. [...], [...], as eligible for reimbursement. It was reasonable for the Claimant not to question the eligibility of these costs for reimbursement.
29. It is not necessary to decide whether the costs of [...] can be recognised as recoverable costs in general. In any case, it has not been adequately demonstrated that conducting such [...] was *objectively necessary or appropriate* for achieving the legitimate objective of the proceedings. The fact that conducting such [...] may have served as *optimal* preparation for the oral hearing is not sufficient in this respect. [...] However, it is unclear why the team of representatives, comprising numerous attorneys-at-law and patent attorneys, should not have been able to consider the issues raised by the counterclaim, and in particular the issue of inherent disclosure, from various angles and taking into account the case law of the EPO, and on that basis prepare adequately and appropriately for the oral hearing. [...]
30. The Defendants have failed to provide a comprehensible explanation as to why it was appropriate and necessary for a barrister to be involved in the present proceedings as an expert. The Defendant's team already included three solicitors who could advise the Defendants on

matters relating to the United Kingdom. It is neither apparent nor has it been sufficiently demonstrated by the Defendants that questions arose in the present case which could not be answered by these solicitors. This is all the more true given that there were no parallel proceedings pending in the United Kingdom. Therefore, the costs claimed for the barrister's services, totalling [...], are not recognised as recoverable.

31. The travel and accommodation costs claimed for the preparatory meeting in Munich are not inherently unreasonable. In particular, these costs are not unreasonable solely because the meeting took place in person. However, the Court took into account the fact that the meeting was combined with [...], whose costs were deemed unreasonable, by reducing the reimbursable travel costs by one third. Therefore, only travel and accommodation costs totalling [...] were deemed eligible for reimbursement for this meeting.
32. The Defendants' demand for reimbursement of representation costs for the cost procedure is unfounded. Proceedings for cost decisions under R. 150 et seq. RoP are summary proceedings, determined by the judge-rapporteur. Awarding compensation for the additional costs that can be attributed to the proceedings for cost decisions as such is not envisaged in the Rules. It would give the parties an incentive to spend considerable resources on these summary proceedings. Awarding costs upon costs cannot have been intended in the Rules. A party, even if successful in the context of proceedings for a cost decision under R. 150 RoP, will normally have to carry its own costs attributable to the cost proceedings. In exceptional cases a party may be ordered to bear any unnecessary costs it has caused the Court or another party (see Art. 69(3) UPCA, UPC_CoA_618/2024, Decision of 6 June 2025, mn. 54 – Hanshow v VusionGroup).

ORDER:

1. The Claimant shall reimburse the Defendants for costs totalling [...].
2. Reimbursement shall be made within three weeks of this decision being served.
3. In all other respects, the application for a cost decision is dismissed.

DETAILS OF THE DECISION:

ACT_10138/2025 regarding main proceedings ACT_578607/2023, CC_3088/2024, CC_3090/2024 and CC_3093/2024

UPC-Numbers: UPC_CFI_355/2023 and UPC_CFI_186/2025

Subject of the Proceedings: Patent infringement action and counterclaim for revocation

Düsseldorf on 9 July 2025
NAMES AND SIGNATURES

Presiding Judge Thomas	
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INFORMATION ON APPEAL:

A party adversely affected by a decision referred to in R. 157 RoP may lodge an application for leave to appeal to the Court of Appeal within 15 days of service of the decision (R. 221.1 RoP).