Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

UPC Court of Appeal
UPC_CoA_312/2025
UPC_CoA_333/2025
UPC_CoA_880/2025
UPC_CoA_882/2025

DECISION
of the Court of Appeal of the Unified Patent Court
issued on 2 June 2026
concerning EP 3 511 174 (DE and UK designations)

HEADNOTES

Claim construction

1. There is no general rule that the skilled person would always and automatically take into account fluctuations which are due to the manufacturing process and the measurement method and in doing so would automatically add deviations to the – as such precise – numerical value in a claim feature. This may be a result of claim interpretation but is not inherent to the use of a numerical value in a claim.

Private prior use

2. According to Article 28 UPCA, "Any person, who, if a national patent had been granted in respect of an invention, would have had, in a Contracting Member State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that Contracting Member State, the same rights in respect of a patent for the same invention."
3. Whether a right of private prior use in respect of the German designation of the Patent may be relied on is thus to be determined under German law.

Front loaded proceedings

4. It is not contrary to R. 29(c) RoP and the front-loaded system of the RoP if a party submits additional evidence of an already stated fact or submitted argument for which other evidence had already been submitted, but which was disputed by the other party.

International jurisdiction

5. Art. 34 UPCA states that "Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member States for which the European patent has effect". It is not meant to confine the UPC's jurisdiction to its own territory. Art. 34 UPCA clarifies that as a rule – unless a more limited scope is requested (cf Art. 43, 76 UPCA) – decisions of the UPC shall cover the territory of all Contracting Member States where a European patent has effect.
6. There is no indication that the Contracting Member States when entering into the UPCA wished to confer a more limited jurisdiction to the UPC – confined to its own territory – in situations where the national courts would have extra-territorial jurisdiction.
7. The UPCA is expressly not limited to European patents insofar as validated for the UPC territory only. As such, European patents validated in territories outside the UPC territory is 'matter governed by the UPCA'.
8. Art. 24(3) UPCA specifically leaves open the possibility that there is a need for the UPCA to apply national law, including that of non-contracting States. The use of 'in particular' makes clear that the areas of application of such foreign law is not limited to the matters referred to in the articles mentioned.

9. Where a court has jurisdiction under Article 4 Br I bis because the defendant is domiciled in its territory, as is the case in the present proceedings, the Regulation precludes that court from declining jurisdiction on the ground that a court of a non-Member State would be a more appropriate forum for the trial of the action, even if the jurisdiction of no other Member State is in issue, or the proceedings have no connecting factors to any other Member State (CJEU, judgment of 1 March 2005, Owusu, C-281/02, ECLI:EU:C:2005:120, paras 36 – 46). This approach has recently been endorsed by the CJEU in *BSH v Electrolux*.
10. Accepting jurisdiction in the infringement action vis-à-vis a defendant domiciled in the UPC's territory based on Art. 4 Br I bis as such cannot be considered contrary to the TRIPS Agreement.

Exercising international jurisdiction

11. A court which has jurisdiction to hear an alleged infringement of a patent validated outside of its own territory, is not only required to apply the law applicable to that patent, but must also apply international law principles such as comity.
12. In situations where the Court has jurisdiction to decide on the alleged infringement and remedies requested by the patentee based on a non-UPC designation of a European patent (EP), and where the defendant has – as a defence – asserted that the EP relied on is invalid, then:
    - where designations in the territories of Members States of the European Union (EU) and Signatories to the Lugano Convention (LC) are concerned ('EU/LC EPs'), it follows from Art 24(4) Br I bis and Art. 22(4) LC that the Court shall not consider the validity of such patents, but as decided in *BSH v Electrolux* the Court does not lose jurisdiction to decide the infringement action based on such patents;
    - where designations in territories of non-EU and non-LC States are concerned ('non-EU/LC EPs'), it follows from *BSH v Electrolux* that the Court can consider the validity of such patents in *inter partes* proceedings and the Court may on that basis decide the infringement action based on such patents.
13. The Court of Appeal considers the following approach regarding actions based on EU/LC European patents and/or non-EU/LC European patents to be in line with *BSH v Electrolux* and international principles of law, including comity, for the following situations (I, II and III respectively):

    I. when a revocation action is lodged with the Court with respect to (a) EU/LC EP(s) and/or non-EU/LC EP(s)

14. The Court shall declare that it lacks jurisdiction to decide the action.

    II. *in an infringement action which is also based on (a) EU/LC EP(s) and/or non-EU/LC EP(s), and the patent in force in the UPC territory is considered <u>invalid</u>, but the attacked embodiment or process would <u>infringe</u> if it were valid*

15. It will be appropriate for the Court to first offer the patentee the opportunity to withdraw the infringement action insofar as based on (a) EU/LC EP(s) and/or non-EU/LC EP(s) within an appropriate period of time.

16. Where it concerns EU/LC EPs:
    a. if the patentee does not wish to withdraw the infringement action, and insofar a revocation action is not already pending with the relevant competent national court(s), it is appropriate to give the defendant the opportunity to file a revocation action with the relevant competent national court(s) within an appropriate period of time.

    b. if and to the extent that (a) revocation action(s) is pending, or the defendant has lodged such action(s), it is generally appropriate for the Court to use its discretion and/or case management powers (cf R. 295(l) and (m) RoP) to stay the infringement proceedings insofar

as based on that EU/LC EP(s) until a final decision has been rendered in the revocation action(s) by the competent national court(s).

c. if and to the extent that the defendant does not lodge such action(s) within the given time period, the Court must assume that the patent(s) is/are valid and shall decide the infringement action on that basis.

17. Where it concerns non-EU/LC Eps:
    a. if the patentee does not wish to withdraw the infringement action, the infringement action shall be dismissed, unless there are specific reasons not to do so (e.g. because the claim(s) of an extra-territorial part is different and may be considered valid – in such a situation the next paragraph applies)

III. in an infringement action which is also based on (a) EU/LC EP(s) and/or non-EU/LC EP(s), and the patent in force in the UPC territory is considered <u>valid</u> and <u>infringed</u> in the UPC territory

18. Where it concerns either EU/LC EPs (in view of Art. 24(4) Br I bis and 22(4) LC) or non-EU/LC EPs (in view of comity):
    a. the Court may – where appropriate and in order to avoid undue delay – consider there is a reasonable, non-negligible possibility that the patent will be held valid by the competent national court and issue a decision including its orders under the condition subsequent that the patent is not held to be wholly or partially invalid to the extent the infringement is based thereon in first instance or appeal proceedings before the national court competent to hear the revocation case in relation to such an EP (R. 118.2 RoP and Solvay v Honeywell (C-616/10) *mutatis mutandis*).

    b. if such a competent national court holds the patent to be valid, then the decision including its orders stays in place with the condition subsequent; if the decision is final, the injunction becomes permanent.

    c. if such a competent national court at first instance or on appeal holds the patent to be wholly or partially invalid to the extent the infringement is based thereon then the condition under which the decision, including its orders, was issued is not fulfilled and it falls away.

    d. In the case under c. the patentee may request the Court for orders consequential on such a decision within two months of the decision of such a competent national court (R. 118.4 RoP), including a request for a stay of the proceedings until a final decision is rendered by the competent national court.

Joint tortfeasorship

19. As the Court of Appeal held in *Belkin v Philips* (UPC_CoA_534/2024, of 3 October 2025) an "infringer" within the meaning of Art. 63 UPCA in conjunction with Art. 25 UPCA is also a person who does not personally carry out the acts referred to in Art. 25 UPCA but to whom the acts of a third party are attributable because he is an accessory. The jurisdiction of the UPCA under Art. 32.1(a) UPCA to hear actions for patent infringement therefore extends to allegations of joint tortfeasorship.

<u>KEYWORDS</u>
Claim construction, priority, added matter, novelty, inventive step, infringement, private prior use, international jurisdiction, exercise of international jurisdiction, joint tortfeasorship, rectification, frontloaded proceedings

APPELLANTS (AND DEFENDANTS BEFORE THE COURT OF FIRST INSTANCE)

1. **Kodak GmbH**, Stuttgart, Germany
2. **Kodak Graphic Communications GmbH,** Stuttgart, Germany
3. **Kodak Holding GmbH**, Stuttgart, Germany

(hereinafter jointly referred to as "Kodak" or the "Kodak companies" and individually as Kodak GmbH, Kodak Graphic or Kodak Holding respectively)

all represented by Kilian Seidel, and other attorneys at law of the law firm Freshfields Bruckhaus Deringer, Munich, Germany, as well patent attorneys of Vossius and Partner, Munich, Germany

RESPONDENT (AND CLAIMANT BEFORE THE COURT OF FIRST INSTANCE)

Fujifilm Corporation, Tokyo, Japan
(hereinafter referred to as "Fujifilm")

represented by Dr. Christof Augenstein, and other attorneys at law of the law firm Kather Augenstein, Düsseldorf, Germany

PATENT AT ISSUE

EP 3 511 174

LANGUAGE OF THE PROCEEDINGS

English

PANEL AND DECIDING JUDGES

This decision was issued by Panel 2:
Rian Kalden, presiding judge and judge-rapporteur
Patricia Rombach, legally qualified judge
Ingeborg Simonsson, legally qualified judge
Lorenzo Parrini, technically qualified judge
Max Tilmann, technically qualified judge

IMPUGNED DECISIONS AND ORDER OF THE COURT OF FIRST INSTANCE

In the main proceedings UPC_CFI_365/2023,

- in ACT_579338/2023 (infringement action),
- in CC_8809/2024 (counterclaim for revocation)

issued by the Mannheim Local Division on 2 April 2025.

In the main proceedings UPC_CFI_365/2023,

- on the UK designation of the patent issued by the Mannheim Local Division, issued on 18 July 2025.
- Order on the rectification of the decision of 18 July 2025 (R. 353 RoP), issued by the Mannheim Local Division on 5 September 2025.

ORAL HEARING
27 March 2026

SUMMARY OF THE FACTS

The parties

2. Fujifilm is a manufacturer of inter alia lithographic plates.

3. The Kodak companies belong to a multinational group of companies producing and distributing inter alia printing plates. Kodak GmbH acts as the German sales company purchasing the products from a UK based company of the group, Kodak Ltd. Kodak Graphic and its legal predecessor, respectively, own and operate a manufacturing facility in Germany as contract manufacturer of printing plates for Kodak Ltd. Kodak GmbH is a wholly owned subsidiary of Kodak Graphic, which itself is a wholly owned subsidiary of Kodak Holding and subject to a control and profit and loss transfer agreement with Kodak Holding.

Procedural background and the impugned decision

4. Fujifilm lodged an infringement action before the Mannheim Local Division (hereinafter also 'MLD') based on the patent at issue (hereinafter also 'the Patent') with effect for Germany and the United Kingdom (UK). In response, Kodak lodged a counterclaim for revocation. The MLD decided to deal with the German and UK designations of the Patent separately.

5. In its decision of 2 April 2025 in both the infringement action and the counterclaim for revocation the MLD held the Patent to be valid and infringed in Germany.

6. Kodak has appealed this decision for both the infringement action and the counterclaim for revocation (UPC_CoA_312/2025 and UPC_CoA_333/2025 respectively).

7. In its decision of 18 July 2025, the MLD held it has jurisdiction to decide on the UK designation of the Patent in accordance with the judgment of the Court of Justice of the European Union (CJEU) dated 25 February 2025 (C-339/22, *BSH Hausgeräte* v *Electrolux*). The MLD found an infringement of the UK designation. In its order rectifying this decision, the MLD in addition dismissed the counterclaim for revocation of the UK designation of the Patent.

8. Kodak has also appealed this decision for both the infringement action and the counterclaim for revocation (UPC_CoA_880/2025 and UPC_CoA_882/2025 respectively).

9. This decision will refer to the submissions of the parties as follows:

On appeal:
- SoGA Kodak Grounds of appeal as filed on 18 August 2025
- SoR Fujifilm Statement of response as filed on 2 December 2025
- KFP Kodak Further pleading as filed on 20 January 2026
- FFP Fujifilm Further pleading as filed on 3 February 2026

At 1st instance:
- SoC Fujifilm Statement of claim of 10 October 2023
- SoD Kodak Statement of defence and Counterclaim for revocation of 16 February 2024
- Reply Fujifilm Reply to the Statement of defence, Defence to the Counterclaim for revocation and Application to amend the patent of 13 June 2024
- Rejoinder Kodak Rejoinder to the Reply, Reply to Defence to the Counterclaim for revocation and Defence to the Application to amend the patent of 30 September 2024
- CC-Rejoinder Fujifilm Rejoinder to the Reply to the Defence to the Counterclaim for revocation and Reply to the Defence to the Application to amend the patent of 29 November 2024
- R30-Rejoinder Kodak Rejoinder to the Reply to the Defence to the Application to amend the patent of 30 December 2024

SUMMARY OF THE PARTIES' SUBMISSIONS AND REQUESTS

Infringement action

10. In its SoC, Fujifilm argued that the printing plates marketed by Kodak under the product names Sonora X, Sonora Xtra-2 and Sonora Xtra-3 fall within the scope of claims 1 to 9 and 14 of the Patent and are means relating to an essential element of the subject-matter of claims 15 and 16 of the Patent. In its Reply Fujifilm unconditionally submitted to amend its claim 1 (see below, para. 27) and limited its requests to the Sonora Xtra-3 (hereinafter also referred to as 'the attacked embodiment').

11. Summarised, Fujifilm requested a declaration of infringement, permanent injunction, subject to a penalty in case of non-compliance, payment of damages, compensation for moral prejudice, an order to communicate information, also subject to a penalty, destruction, recall, removal of the product from the channels of commerce, an order to place a statement about the infringement on Kodak's website, as well as an interim award of damages and costs. Fujifilm requests that Kodak's request for an enforcement security be dismissed.

12. Kodak disputed that its SONORA Xtra-3 plate is directly or indirectly infringing the Patent. It asserted that the Sonora XTRA-3 plate has no micropores in the meaning of the Patent. In addition, Kodak alleged a private prior use right pursuant to Sec. 12 German Patent Act in conjunction with Art. 28 UPCA, allowing it to manufacture and distribute the attacked embodiments in Germany.

13. Kodak requested that Fujifilm's requests be dismissed and provisional reimbursement of its costs of the proceedings; in the alternative, to make the enforcement of the decision subject to a security of at least EUR [redacted] (as updated) and to permit the Kodak companies to avert enforcement of the decision by providing security.

Counterclaim for revocation

14. Kodak asserted that the Patent is not entitled to the first claimed priority date of 29 September 2017 and that the relevant date is 30 March 2018; that the Patent claims extend beyond the disclosure of the original application; that the patent is invalid for lack of novelty in view of public prior use by Kodak and/or in view of anticipation by WO 2018/160379 A1 (WO'379, Exh T12) and/or EP 2 878 452 A1 (EP'452, Exh. T34); that the Patent lacks inventive step in view of the publicly available Sonora X plates, or in view of EP'452, in the alternative starting with EP 2 839 968 A1 (EP'968, Exh. T36), in combination with common knowledge and/or US 2009/0047599 A1 (US'599, Exh. T40) or EP'968.

15. Kodak requested revocation of the Patent in its entirety with effect in the territory of all Contracting Member States in which the patent has effect and, without prejudice to the primary position that the Court cannot or should not determine the claim so far as it concerns the UK, and on the basis that if the court were to assume jurisdiction for the UK designation of the Patent, it should only do so if the Claimant first undertakes to consent before the UK Court and Intellectual Property Office to revocation or restriction of the UK designation of the Patent in line with the decision to be handed down by the Court, a decision that the UK designation is also invalid in its entirety. Kodak further requested a provisional reimbursement of costs.

16. Fujifilm requested that the counterclaim for revocation be dismissed and filed an Application to amend the patent under R. 30 RoP. With its Main Request it unconditionally amended claim 1 of the patent.

UK case

17. Kodak filed a preliminary objection rejecting the international jurisdiction and competence regarding the UK designation of the Patent. This was disputed by Fujifilm. The MLD decided on this together with the main action.

The impugned decisions

18. The MLD held the infringement and revocation action inadmissible with regard to the national parts of the Patent other than Germany and the UK (due to lack of jurisdiction, because these patents had already lapsed) and considered the German designation of the Patent (as amended according to the Main Request, see below, para. 27) to be valid and infringed by the Sonora Xtra-3 plates. The MLD dismissed Kodak's preliminary objection and validity defence in relation to the UK designation of the Patent and considered it to be infringed by all Kodak companies.

19. The MLD issued injunctions subject to penalties, and orders for provision of information, payment of damages, destruction, recall, and removal from the channels of commerce in relation to both the German and UK designations of the Patent. Kodak was ordered to bear the costs of the proceedings. No security for enforcement has been required.

Appeal from the 2 April 2025 decisions (German designation)

20. Kodak requests that the impugned decision be set aside, to dismiss the infringement action, to revoke the Patent in its entirety with effect for the territory of Germany; to dismiss Fujifilm's requests to amend the patent, to order that Fujifilm shall compensate Kodak for the injury caused by the enforcement of the impugned decisions, and to order that Fujifilm shall bear the costs of the proceedings in both instances.

21. Fujifilm requests that the appeals be dismissed; in the Counterclaim for revocation, as a subsidiary request in case the Court considers the Patent to be invalid, amend the Patent in accordance with its (new) Auxiliary Requests and that the injunction be amended accordingly.

Appeal from the 18 July 2025 decision and 5 September 2025 rectification order (UK designation)

22. Kodak requests that the impugned decision and order be set aside, that international jurisdiction of the Court to rule on the UK designation of the Patent be rejected and the action in respect of the UK designation be dismissed. Alternatively, if the Court accepts jurisdiction, Kodak requests for a stay or dismissal of the action. Further alternatively, Kodak requests a decision that Kodak does not infringe the UK designation. Further alternatively, a decision that the Court should only assume jurisdiction for the UK designation if Fujifilm first undertakes to consent before the UK Court and Intellectual Property Office to revocation or restriction of the UK designation in line with any decision to be handed down by this Court, and further alternatively an inter partes decision that the UK designation of the Patent as granted and as proposed to be amended is invalid. Further alternatively, if the Court does not agree with Kodak, to request a preliminary ruling from the CJEU, all with an order that Fujifilm shall bear the costs of the proceedings.

23. Fujifilm requests the dismissal of the appeal and as a subsidiary request an injunction based on the Auxiliary Requests, and that Kodak must bear all costs of the proceedings.

The patent at issue

24. The Patent relates to a planographic printing plate original plate, a method for manufacturing, and a printing method.

25. Fujifilm is the registered proprietor of the Patent, which is still in force in Germany and the UK but expired in all other designated Contracting Member States (CMSs) before the entry into force of the UPCA on 1 June 2023. The mention of the grant of the Patent was published on 26 May 2021. It was filed on 31 May 2018, claiming the priority of Japanese patent applications of 29 September 2017 and of 30 March 2018.

26. Claim 1 of the Patent as granted reads 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 colour former."

27. The independent process 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.

28. Fujifilm has unconditionally submitted to amend claim 1 of the Patent as granted in accordance with its Main Request under R. 30.1 RoP, so that "90% or less" is replaced by "in a range of 10% to 50%". Unless indicated otherwise, all references to claim 1 of the Patent hereinafter must be understood to refer to the Patent as unconditionally amended.

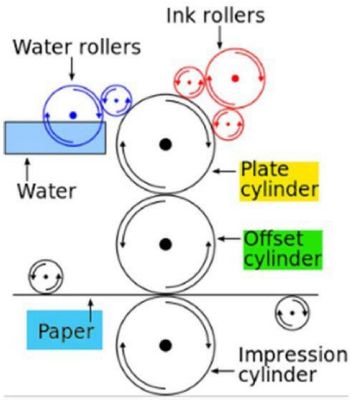
Technical background of the Patent

29. The below technical background, of which the skilled person as at the relevant priority date was aware, is derived from the undisputed introduction into the technology in Fujifilm's SoC para. 17-31 and Kodak's SoD para. 21-26.

    Lithography and offset printing

30. Lithography is a printing technique to print text or images from a plate onto other materials, such as paper. The method operates on the principle of the mutual repulsion between water and oil-based substances. Printing plates used in this process feature both hydrophobic regions that are receptive to oil-based ink (image areas) and hydrophilic regions that are receptive to water (non-image areas).

31. In 'offset printing' the applied ink is first transferred from the printing plate to a rubber plate or cylinder and from there to paper. This indirect method enables high-speed, clean and automated printing, cf. the following simplified illustration.

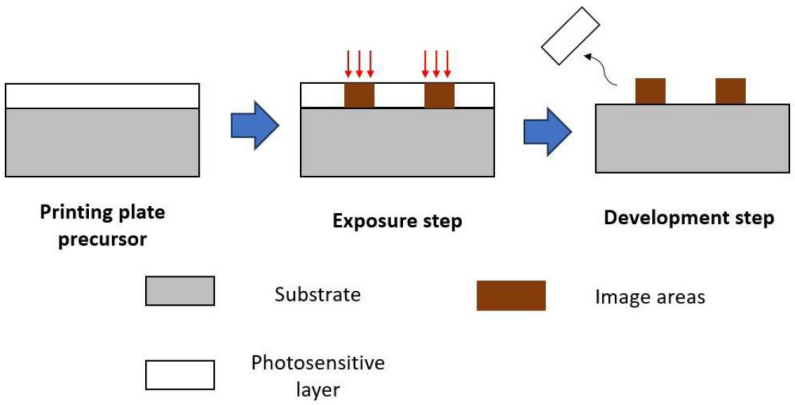


Preparation of the printing plate by exposing and developing a plate precursor

32. The printing plate is mounted on the plate cylinder (indicated in yellow in the figure above). Water and ink rollers apply water and, subsequently, ink to the printing plate, whereby the ink only adheres to the hydrophobic image areas, after the hydrophilic non-image areas were wetted with water to remain inkless. After the ink has been applied to the printing plate, the printing plate transfers the image onto the offset cylinder (green) before the latter prints the image onto the paper (blue).

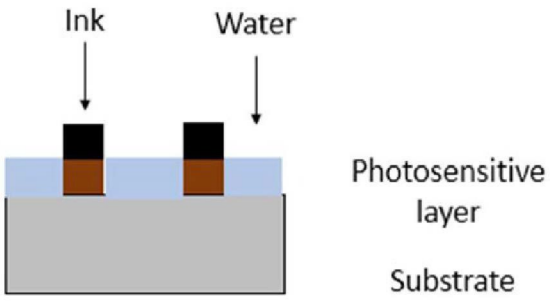
33. The printing plate itself is produced from a printing plate precursor composed of a hydrophilic substrate, typically an aluminium support comprising an anodized film and an aluminium plate, coated with a photosensitive layer (i.e. an image recording layer). In computer-to-plate (CTP) technology, the printing plate is produced by exposure to light, such as infrared light, whereby a cross-linking reaction (polymerisation) is induced to form the hydrophobic ink-receptive image area (exposure step). In a subsequent development step, the unexposed photosensitive layer is removed from the non-image areas, revealing the underlying hydrophilic substrate.

34. In a simplified overview, the production of a printing plate from a precursor can be summarized as follows.



Printing process

35. After exposure and development, the printing plate is mounted on the plate cylinder of the printing press. Water wets the hydrophilic non-image areas, while oil-based ink adheres to the hydrophobic image areas.



36. The ink is then transferred to the offset cylinder and then to the paper.

On-press development

37. During the early days of off-set printing, the non-image portions were removed in a separate step before the printing was conducted. Large amounts of water and chemicals as well as additional time and effort are required for this step.

38. In the later developed "on-press development" method, the printing plate precursor is directly mounted to a printing press after exposure and the development step is performed thereafter, saving both time and chemicals.

The patent description and the technical problem

39. The Patent relates to a lithographic printing plate precursor. In a lithographic printing plate precursor that includes an aluminium support and an image recording layer, formation of an anodised film formed on a surface of the aluminium support has been examined in order to suppress its dissolution (para. [0002]).

40. Before using a lithographic printing plate and attaching it to a printing press, the image thereupon is inspected and identified in order to verify whether it is recorded on the plate in an intended manner (para. [0004]). In case of an on-press development type lithographic printing plate precursor it is difficult to confirm an image on the precursor and thus the image cannot be sufficiently inspected in some cases (para. [0005]), as the plate had already been mounted on the press before being developed thereon. In this case means for confirming an image already at a stage after the exposure (but before development), a so-called print-out image, can be examined by colouring or decolouring an exposed region (para. [0007]).

41. An acid colour former can be used for this purpose (para. [0008]). However, unintended colouring, also referred to as “appearance failure”, may occur with time in a case where an aluminium support on which an anodised film is formed is used for a lithographic printing plate precursor. Said appearance failure occurs in a case where an aluminium support on which the anodised film is formed is used and even in a case where an image recording layer contains an acid colour former or is not exposed (para. [0009], [0026]).

42. The description of the patent speculates about the reasons for such appearance failures. A reason may be that a component in the image recording layer, particularly an anion containing a halogen atom, infiltrates into the anodised film so that a part of the aluminium base of the aluminium support is dissolved. Due to the consequential presence of a proton H+, i.e., an acid being formed during that dissolution process, the acid colour former may develop colour in spots where no image is intended (para. [0027]).

43. Against this background, the technical problem the Patent seeks to solve is to provide a lithographic printing plate precursor that suppresses occurrence of appearance failure (para. [0010]-[0011]). The description mentions (para. [0032]) that the printing plate precursor in accordance with the invention also has improved scratch resistance.

GROUNDS FOR THE DECISION

Feature breakdown claim 1

44. The Court shall use the same feature breakdown as used by the parties and the MLD in its impugned decision:

1 A lithographic printing plate precursor comprising:

1.1 an aluminum support (10), and

1.2 an image recording layer on the aluminum support,

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

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 in a range of 10 % to 50 % of the maximum diameter of the micropores inside the anodized film,

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

1.9 the image recording layer contains an acid color former.

Skilled person

45. The MLD found that the person skilled in the art is a chemist or physicist with a master's degree or diploma from a university and usually a doctorate, specialised in the field of physical chemistry and several years of experience in the production of lithography plate precursors and the relevant substrates. This has not been disputed in the appeal proceedings.

Claim interpretation

Principles

46. The principles applicable to claim construction have been set out by this Court in its final order in *NanoString v 10x Genomics* (UPC_CoA_335/2023 of 26 February 2024, as rectified). The patent

claim is to be interpreted from the point of view of a person skilled in the art. The patent claim is not only the starting point but the decisive basis for determining the protective scope of a European patent under Art. 69 EPC in conjunction with the Protocol on its interpretation. The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim. In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.

Assessment

47. Some features of claim 1 require interpretation.

Features 1, 1.1, 1.2, 1.3, 1.8, 1.9

48. The interpretation of features 1, 1.1, 1.2, 1.3, 1.8 and 1.9 is not in dispute.

49. Feature 1 relates to the precursor of a printing plate. The printing plate as such is mentioned by claim 15 relating to a manufacturing method. The precursor is not directed towards the use of a specific photoresist or printing method. Claims 15 and 16 both contain features being characteristic for a printing plate of an on-press development type, but this is not reflected in claim 1. Neither is claim 1 restricted to a special type of image recording layer. It may be of the positive or negative type (para. [0094]).

50. The printing plate precursor according to feature 1.1 comprises an aluminium support and according to feature 1.2 an image recording layer. Feature 1.3 sets out that an anodised film is arranged in between. Further layers like an undercoat layer (para. [0293 et seq.]), an overcoat layer (para. [0299 et seq.]) or a protective layer (para. [0327 et seq.]) are optional and not reflected in claim 1.

51. The thickness F of the anodised film (see fig. 3 below) is in a range of 550 nm to 2850 nm, which is directly covered by feature 1.8, preferably in a range of 600 nm to 2500 nm and more preferably in a range of 700 nm to 2500 nm (para. [0061], [0075]). It is clear to the skilled person from para. [0035], this feature, in combination with feature 1.7', provides for excellent scratch resistance, because the aluminium support has a sufficiently large thickness and the hardness of the surface of the aluminium support is high.

52. According to feature 1.9 the image recording layer contains an acid colour former. The acid colour former according to the description is a compound that exhibits a colour-developing property by being heated in a state of accepting an electron-accepting compound, for example, a proton such as an acid [0100]. The type of acid colour former is not limited. It can be a compound having structures being rapidly opened or cleaved, whereby a leuco dye is preferable [para. [0100] et seq.).

53. The acid colour former enables the formation of a print-out image by colouring an exposed region (para. [0007]). However, it is assumed that in a case where an aluminium support with an anodised film is used together with an image recording layer containing an acid colour former, appearance failure may occur.

Features 1.4 – 1.7'

54. The parties have a difference of opinion on the correct interpretation of features 1.4 to 1.7', which relate to the size and position of micropores contained in the anodised film.

55. Figures 1, 2 and 3 below show a schematic embodiment of micropores within the anodised film according to these features (para. [0055 et seq.]).

FIG.1

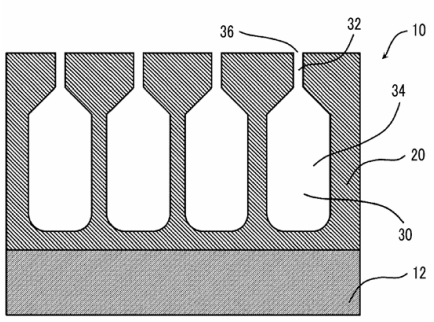


FIG. 2

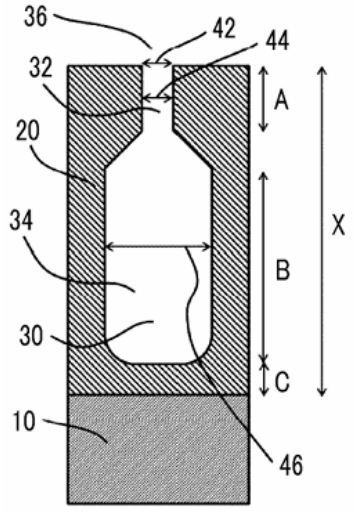
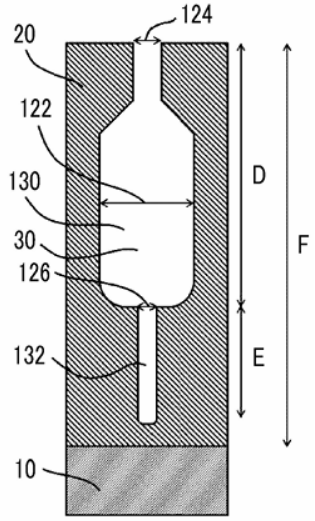


FIG. 3



56. The description sets out that micropores (30) may be distributed in the entire surface of the anodised film or in at least a portion thereof (para. [0043]).

57. The surface opening portions 32 and the internal maximum diameter portions 34 in Fig. 1 and 2 are collectively referred to as "large-diameter pores" (para. [0056]). Figure 3 illustrates an example of a cross-sectional view obtained by enlarging one micropore (30) (para. [0057]). The maximum diameter (122) of the large-diameter pore (130) inside the anodised film is in a range of 0.01 µm to 0.30 µm, as required by feature 1.5, and preferably in a range of 0.015 µm to 0.2 µm and more preferably in a range of 0.020 µm to 0.1 µm from the viewpoint of suppressing the appearance failure (para. [0058], [0063]).

58. The average value of depth D of the large-diameter pores (130) to the bottom from the surface of the anodised film, from the viewpoints of suppressing the scratch resistance and the appearance failure, is preferably in a range of 100 nm to 1500 nm (as required by feature **1.6**) and more preferably in a range of 200 nm to 1000 nm (para. [0076]). For the skilled person's understanding of the surface, reference is made to para. 83 below.

59. That the large-diameter pore has a bottom is apparent from the wording of feature 1.6 that defines an average value of depths of the large-diameter pores *to the bottom* from the surface of the anodised film. In view of feature 1.4 defining the micropores to extend in a depth direction from the surface of the anodised film, the skilled person understands that the bottom of the large-diameter pore defines the end of the large-diameter pore in the depth direction.

60. Feature 1.7' concerns a dimensional relationship between an average pore diameter of the micropores *in the surface* of the anodised film and the maximum diameter of the micropores *inside* the anodised film. Feature 1.7' requires the average pore diameter of the micropores *in the* surface of the anodised film to be in a range of 10% to 50% of the maximum diameter of the micropores *inside* the anodised film. Feature 1.7' thus requires the average pore diameter of the micropores in the surface of the anodised film *to be smaller* than the maximum diameter of the micropores inside the anodised film. According to the description, a range of 10% to 50% is the more preferable range from the viewpoint of suppressing the appearance failure (para. [0059], [0064]).

61. The skilled person understands from the description that the size and depth of the large-diameter micropores inside the anodised film and the size of the pores in the surface of the anodised film relative thereto to be essential for achieving the envisaged technical effect. Para. [0031] teaches the skilled person that with the (relative) dimensions of features 1.5 and 1.7', the dissolution of the anodised film is unlikely to be promoted even in a case where the component in the image recording layer infiltrates into the micropores (para. [0031]). From para. [0032] and [0033] it learns that with these features, the scratch resistance of the precursor is considered to be improved, because stain is unlikely to be generated on the scratched sites after a lithographic printing plate is obtained.

62. According to para. [0062] of the description, the micropores 30 may or may not have small-diameter pores 132 communicating with the bottom of the large-diameter pore 130. It is preferable that the [small-diameter] micropores are micropores which communicate with the bottom of the large-diameter pores, and extend in the depth direction from the communication position. The pore diameter of the small-diameter pores in the communication position is smaller than the pore diameter of the large-diameter pores in the communication position. Typically one, but two or more small-diameter pores 132 may communicate with the bottom of one large-diameter pore 130 (para. [0068]). Small-diameter pores are not part of claim 1, they are covered by dependent claim 2.

63. Provided the dimensions required by claim 1 are observed, the shape of the large-diameter pores is not particularly limited. Further, the shape of the bottom portion of the pores is not particularly limited but may be a curved shape (depression) or a planar shape (para. [0067]). However, whatever the shape, the skilled person understands from para. [0067] that the large-diameter pore has a bottom, from which – if present – one or more small-diameter pores extend in downward direction.

64. Neither claim 1 nor the description limits the shape or depth of the surface opening portion of the large-diameter pores (32, 36). The anodised film may have an uneven surface, with partial – even deep – recesses in the surface opening portion of the large-diameter micropores.

65. The skilled person understands that the anodisation process will not produce micropores with ideal shape and dimensions throughout the whole layer as displayed in figures 1 to 3. The Court of Appeal agrees with the MLD that, as follows from 'has micropores' in feature 1.4 and 'include' in feature 1.5, the mere existence of micropores with other dimensions than those claimed, also referred to as other 'void volumes' does not lead out of the scope of protection, as long as a sufficient number of micropores comprising said geometrical dimensions exist to ensure the technical effects of suppressing the occurrence of appearance failure and enhancing scratch resistance. Contrary to Kodak's assertion (para. 117 SoGA), the existence of such void volumes does not prevent the identification of the micropores as claimed, as shown by the measurement reports submitted by both Fujifilm and Kodak.

66. As to measuring the relevant dimensions, the description states that the pore diameter of each micropore in the surface of the anodised film is measured as the pore diameter of the opening

portion 36 ([0065]) and that the maximum diameter of the large-diameter pores inside the anodised film is measured as the maximum value from among the pore diameters of respective micropores in the internal maximum diameter portion ([0066]).

67. The Patent does not describe how to determine the maximum diameter or the average depth of the large-diameter pores, nor the average diameter of large-diameter pores in the surface of the anodised film.

68. In relation to the *void volume* of the anodised film, the description in para. [0042] provides that this is calculated as an arithmetic average value obtained by observing 4 sheets (N = 4) of the cross sections of the anodised film 20 using a field emission scanning electron microscope (FE-SEM) at a magnification of 150000, measuring the void volume in a range of 400 nm x 600 nm in the obtained four sheets of images, and averaging the measured values.

69. The description further states that the *average diameter of the small-diameter pores* 132 is calculated as an arithmetic average value obtained by observing 4 sheets (N = 4) of the surfaces of the anodised film 20 using a field emission scanning electron microscope (FE-SEM) at a magnification of 150000, measuring the diameters of micropores (small-diameter pores) present in a range of 400 nm x 600 nm in the obtained four sheets of images, and averaging the values. In a case where the depth of the large-diameter pores is large, the average pore diameter of small-diameter pores 132 may be acquired by cutting (for example, cutting the upper portion using argon gas) the upper portion (a region where large-diameter pores are present) of the anodised film 20 as necessary and observing the surface of the anodised film 20 using the above-described FE-SEM ([0071]). It is further stated that the average pore diameter is acquired as the arithmetic average value of the pore diameters of 25 micropores in the communication position of the small-diameter pores ([0072]) and further that, in a case where the shape of the small-diameter pores 132 is not circular, an equivalent circle diameter is used ([0073]).

70. The MLD rightly considered that the skilled person will appreciate that both methods for determining average values may also be used for determining the average values in relation to the large-diameter pores.

71. The features of the independent claims 15 and 16 correspond largely to those of claim 1 and do not require further interpretation.

72. Kodak argues in relation to features 1.4 to 1.7' that (i) large-diameter pores need to be distinguished from small-diameter pores based on the anodisation process; (ii) feature 1.7' requires opening portions with continuous boundaries; (iii) feature 1.7' requires that each micropore according to the claim has (exactly) one surface opening portion, and (iv) the numerical ranges, in particular in feature 1.7', require that fluctuations which are due to the manufacturing process and the measurement method are to be taken into account. None of these arguments is successful.

(i) large-diameter pores need to be distinguished from small-diameter pores based on the anodisation process

73. Kodak alleges without success that the MLD failed to interpret the term 'large-diameter pore', leaving the dimensions and shape that the micropores can have largely open. In relation to the large-diameter pores the MLD rightly mentioned the dimensions required by features 1.5 to 1.7', including their depth D from the surface of the anodised film to the bottom ranging from 100 nm to 1500 nm (as required by feature 1.6) and also rightly considered that the shape of the large-diameter pores is not particularly limited.

74. The MLD specifically recognised that pores with other dimensions than those claimed in claim 1, other void volumes, may be present, including *optionally* small-diameter pores which communicate with the bottom of the large-diameter pores and extend therefrom in the depth direction. Since the pore diameter of the small-diameter pores in the communication position is smaller than the pore diameter of the large-diameter pores in that position (para. [0068], fig. 3), this is sufficient for the skilled person to be able to distinguish the large-diameter pores from the small-diameter pores, if present.

75. Contrary to Kodak's argument, neither claim 1 nor the description requires or prompts the skilled person to distinguish between the different types of pores based on the manufacturing process, in particular the anodisation steps. The description does not describe nor distinguish different pores in terms of the separate 'layers' in which they are formed as a result of separate anodisation steps, as Kodak suggests.

76. To the contrary, the skilled person appreciates that claim 1 protects a lithographic printing plate precursor with the features of that claim, regardless of how it is manufactured. It understands that the manufacturing process described in the patent description only sets out one manner of manufacturing, without this being a mandatory process. This is confirmed by the fact that para. [0080] states that "an aluminum support *can* be produced using the method described below" – emphasis added.

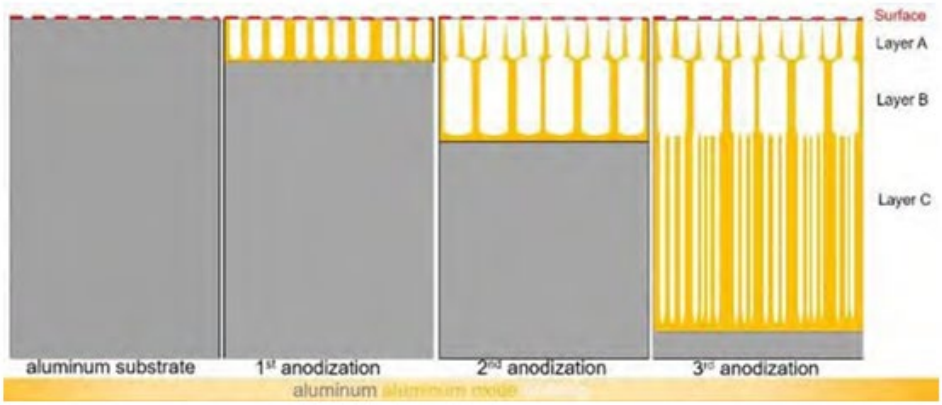
77. As such, the skilled person appreciates that it is irrelevant whether for instance the large-diameter pores, that include both the surface opening portion and the internal maximum diameter portion, have been created in one or two distinct anodisation steps. Neither is reliance on the manufacturing method required in order to distinguish a large-diameter pore from a small-diameter pore. As said, the position and relative diameters at the communication position provide sufficient guidance to be able to do this.

78. The mere fact that two other patent applications (one of Kodak WO' 379 (Exh. T12) and the other of Fujifilm, EP'408 – Exh. T6) disclose the same manufacturing process does not lead to another conclusion. Patent applications are not generally considered to represent common general knowledge. Kodak has also referred to a 'standard procedure' and 'standard practice in the field' (para. 131, 737 SoGA) but has not provided any substantiation for this allegation.

79. It follows from the above that when considering whether a certain embodiment falls within the scope of claim 1, this is to be based on measurements determining whether it complies with the dimensions as set forth in features 1.5 to 1.7' only and not based on the step within the anodisation process which created the pores.

(ii) feature 1.7' requires opening portions with continuous boundaries

80. As already considered, the skilled person understands from the patent description that the surface opening portion (32) is part of the large-diameter pore (130) and also that the shape thereof is not limited. The skilled person understands that the 'surface' is at the remainder of the top of the aluminium layer after anodisation, as illustrated by the red dotted line in an illustration in para. 14 of Kodak's Rejoinder.



81. The skilled person knows that the surface opening portion of the micropore may not be perfectly circular. He does not consider this to be problematic, since he understands that para. [0073], which states in relation to small-diameter pores 132 that in a case where the shape thereof is not circular an equivalent circle diameter is used, is to apply equally to the shape of the opening in the surface.

82. As the MLD rightly considered (Decision para. 107), the skilled person also recognises that the surface is not as flat as represented in the illustration above (the dotted red line is not as perfectly straight as illustrated), because the anodisation process generally leads to an uneven surface, and may even result in a 'spike like structure' like that of the surface of the Attacked Embodiment. This has not been contested.

83. Kodak incorrectly draws the conclusion from the presence of such a structure at the surface that the average pore diameter in the surface of the anodised film cannot be measured, as feature 1.7' requires, because it would not provide for a continuous boundary which is measurable.

84. The skilled person indeed understands that the relevant opening in the surface whose diameter must be measured needs to have a boundary, which delimits the opening. A spike-like structure at the surface, however, does not prevent that there is a boundary around the opening in the surface. Where aluminium has remained after the anodisation process, and has formed spikes, the surface is at the top of the spikes. Where the anodisation process has caused the aluminium layer to be deteriorated there are now recesses (valleys in between the spikes) and the surface has become lower, i.e. to the bottom of the valleys. The skilled person will appreciate that the relevant opening is not located at the top of the spikes, because at that level there is no boundary, but rather at the level of the 'valleys' in between them, where there is a continuous boundary. This opening is still located 'in the surface' because – the surface being uneven – the 'valleys' in between the spikes are as much 'in the surface' (nothing else on top of it), as the top of the spikes. As Fujifilm rightly noted (para. 8 Reply) the diameter does not require a continuous boundary at the very top of the anodized film. The claim allows for the thickness A in Fig. 2 to be zero, so that the opening in the surface portion can be at the lower end of the "bottleneck", where the "shoulders" begin.

(iii) feature 1.7' requires that each micropore according to the claim has (exactly) one surface opening portion

85. The Court of Appeal cannot accept Kodak's argument that each micropore necessarily has only one surface opening portion. Neither the claim wording, nor the description requires such a restricted understanding. The claim language consistently uses the terms 'micropores', 'large-diameter pores' and 'micropores in the surface' in plural form and does not relate a specific micropore in the surface to the portion of the micropore inside the anodised film of which it forms part (contrary to Kodak's suggestion (in para. 158 SoGA) using language deviating from the claim wording). To the contrary, feature 1.7' only generally requires that an *average* pore diameter of the micropores in the surface of the anodised film is in a range of 10-50% of the maximum

diameter of the micropore*s* (plural) inside the anodised film. This does not exclude that one micropore has two openings in the surface. Naturally, for measuring the diameter of the opening in the surface relative to the maximum diameter inside, in case of two openings these shall be taken together.

86. Neither the figures, nor the fact that for small-diameter pores the possibility of more than one pore communicating with the bottom of a large-diameter pore is mentioned (para. [0068] lines 54-55), leads to another, limited, interpretation. The skilled person appreciates that the figures contain exemplary very schematic two-dimensional drawings only and that even though typically one surface opening will communicate with one large-diameter pore, as for small-diameter pores, it is not excluded that a large-diameter pore has more than one surface opening. The skilled person understands this to follow from the fact that the anodisation process leads to a variety of shapes.

87. According to Kodak it is the core teaching of the patent that a large-diameter pore has a single narrow opening in the surface (in a range of 10-50% of the maximum diameter inside the anodized film), so that the infiltration of the component, which causes the dissolution of the aluminium support, is reduced. This must be rejected. It cannot be seen that this cannot be achieved if two openings together fall within the required range.

88. At the oral hearing Kodak clarified that in this respect also the openings between adjacent spikes must be considered, because that prohibits that the relevant component can be captured in the large-diameter pore inside the anodised film. This must also be dismissed. As Kodak itself argues, the 'opening' in the surface of the anodised film whose pore diameter is to measured in view of feature 1.7' must be understood to be the opening situated in the surface which has continuous boundaries, and not the open space between adjacent spikes.

89. Since claim 1 is a product claim, any considerations relating to the manufacturing process, advanced by Kodak (para. 162 SoGA), do not lead the skilled person to the understanding advanced by Kodak either.

(iv) the numerical ranges, in particular in feature 1.7', require that fluctuations which are due to the manufacturing process and the measurement method are to be taken into account

90. Kodak unsuccessfully submits that an interpretation of the claimed numerical ranges in accordance with their technical meaning requires that fluctuations which are due to the manufacturing process and the measurement method are to be considered.

91. Contrary to what Kodak suggests, there is no general rule that the skilled person would always and automatically take into account fluctuations which are due to the manufacturing process and the measurement method and in doing so would automatically add deviations to the – as such precise – numerical value in a claim feature. This may be a result of claim interpretation but is not inherent to the use of a numerical value in a claim.

92. Nothing in the claim nor the description leads the skilled person to an interpretation that also covers lithographic printing plate precursors with an average pore diameter of the micropores in the surface of the anodised film (124) above the exact value of 50 % of the maximum diameter of the micropores inside the anodised film. To the contrary, the fact that the skilled person is aware that the anodisation process undisputedly leads to pores with very different shapes and sizes (para. 171 SoGA) but the description nevertheless does not mention any fluctuations, tolerances or deviations, indicates to the skilled person that the stated ranges are not meant to be further extended to cover such fluctuations, tolerances or deviations.

93. Furthermore, the features each relate to ranges and average values and therefore already take fluctuations, tolerances or deviations in pore dimensions into account. An average value averages precisely these deviating values and thus arrives at a single value from a plurality of values.

94. The use of average values does not only explicitly follow from feature 1.6 for the depth of the large-diameter pores and from feature 1.7' for the openings in the surface. For the other dimensions this follows from the method of measuring provided for in the description which leads to an arithmetic average value of the pore diameters of 25 micropores (para. [0072]). For the maximum diameter of the large-diameter pores inside the anodised film this is reinforced by table 2. As follows from para. [0385] the first and second column of this table refer to the *average* values of both the pores in the surface as well as the maximum diameter inside the anodised film.

95. In addition, the skilled person appreciates that taking into account fluctuations or a 'standard deviation', is also not required because not each and every pore in the anodised film is required to have the claimed dimensions and the existence of some pores with dimensions outside of the claimed values does not necessarily lead the lithographic printing plate precursor out of the scope of claim 1 (see para. 64 above).

96. Finally, even if a 'standard deviation' were to be considered, its amount would have to be based on the measurements as disclosed in the description. The deviation in the range of 25% to 28%, as Kodak suggests, is calculated based on measurements of the attacked embodiment and its alleged public prior use, which cannot be used to interpret the claims.

Priority

Principles

97. In accordance with Art. 87 EPC a European patent application is only entitled to priority in respect of 'the same invention' as was disclosed in the previous application. The test to be applied in this respect is the same as the disclosure test under Art. 123(2) EPC (added matter).

Assessment

98. Kodak's arguments in their SoD to the effect that the first priority date was invalid, were dismissed. The MLD considered the grounds submitted by Kodak to be insufficient, more in particular because Kodak had limited its arguments to the disclosure of the claims of JP'837 without elaborating on the disclosed technical teaching in the document as a whole.

99. This assessment cannot be upheld.

100. At the heart of Kodak's argument lies that the original application (EP'174 A1) distinguishes between two different embodiments of a printing plate precursor referred to as Aspect A and Aspect B and that JP'837 only discloses Aspect A while the Patent only claims Aspect B.

101. Kodak mentioned in its SoD (para. 32-47) that Aspects A and B were the subject of the independent claims 1 and 3 of the original application respectively. It also cited the two paragraphs in the original application where these Aspects were mentioned (para. [0024] and [0026]) and referred to the paragraphs where the details of these Aspects were further described (para. [0050] to [0101] and para. [0102] to [0129] respectively).

102. The differences between these Aspects were presented in a table, setting out the different parameters, ranges and ratios by which the micropores in the anodised films were defined for Aspect A and Aspect B. (SoD para. 42).

	Aspect A	Aspect B
Average maximum diameter inside the anodized film	**0.04** µm to 0.30 µm	**0.01** µm to 0.30 µm
Average pore diameter in the surface of the anodized film	Greater than 0 µm and **0.03 µm or less**	90% or less of the maximum diameter inside the anodized film (from the range of the maximum diameter inside the anodized film, the following values can be

	Aspect A	Aspect B
		calculated as lower and upper limits: 0.01 µm x 90% = 0.009 µm 0.30 µm x 90% = 0.27 µm; the diameter at the surface is therefore in the range of **0.009 µm** to **0.27 µm**
Ratio of thickness of internal maximum diameter portion B to thickness of surface opening portion A i.e. (B/A)	$2.5 \leq B/A \leq 28.0$	**missing**
Thickness of internal maximum diameter portion B	500 to 2800 nm	**missing**
Thickness of the anodized film	**missing**	550 to 2850 nm

103. Kodak then stated that JP'837 describes the printing plate precursor according to Aspect A, but that Aspect B is not disclosed therein, while the patent is limited to that Aspect B and therefore cannot validly claim priority of JP'837. Kodak referred to claim 1 of JP'837, which was cited and shows it covers Aspect A, stated that the further claims 2-15 of JP'837 were dependent claims and did not refer to Aspect B and stated: "There is no information on this Aspect in the description of JP 837 either".

104. In its Reply, Fujifilm did not respond to Kodak's priority attack at all. The Court of Appeal fails to read in para. 188 Reply that Fujifilm "denied the blanket allegation" of Kodak at first instance, as it now states. Fujifilm for the first time on appeal defends the first priority date with new arguments. It justifies this by arguing that at first instance Kodak did not sufficiently substantiate its priority attack in its SoD "by comparing only the wording of the claims" and did not revisit the issue in subsequent pleadings.

105. The Court of Appeal does not agree with Fujifilm and the MLD that the grounds submitted by Kodak in its SoD were insufficient. Even though Kodak primarily relied on the claims in the various documents, it clearly also stated that in the description of JP'837 nothing could be found on Aspect B. Under the circumstances this was sufficient. Even a cursory look at the description of JP'837 shows that all paragraphs dealing with aspect A in the original application referred to by Kodak could be found in JP'837 and that this was not the case for Aspect B. It could not be expected from

Kodak to explain paragraph by paragraph what was disclosed in JP'837 to finally conclude nothing is mentioned in relation to Aspect B. Rather, it fell on Fujifilm to verify Kodak's allegations and respond thereto in its Reply. Failing such response, there was no reason for Kodak to further elaborate on its priority attack in its Rejoinder.

106. The Court of Appeal does not accept that based on Kodak's statements in its SoD, Fujifilm was unable to argue that and how Aspect B was disclosed in JP'837, as it has now purported in its SoR on appeal. What Kodak brought forward on this issue on appeal is essentially a repetition of its arguments already brought at first instance. Fujifilm thus has no justification for making the new submissions for the first time on appeal. Kodak is clearly disadvantaged by these late submissions, to which it could not even respond in a regular pleading on appeal. The Court of Appeal therefore exercises its discretion under R. 222.2 RoP to disregard Fujifilm's new submissions on the issue of priority (para. 383 – 424 of its SoR).

107. Kodak's attack on the validity of the first priority date based on JP'837 is successful. Given the different parameters, ranges and ratio's that define the claimed precursors and given that Aspects A and B were separately claimed in two independent claims in the original application, they cannot – failing arguments to the contrary – be considered to relate to the same invention.

108. More in particular, while in feature 1.7' the ratio of diameters of the portions in the surface and inside the pores are at the heart of the invention, in JP'837 it is the ratio of thickness A and B that matters. JP'837 does not contain any pointers in the direction of relevance of the diameter ratio. The skilled person would therefore have no incentive to calculate the diameter ratio based on para. [0020] in JP'837 which states:

> [0020]
>
> In the present disclosure, the surface opening portion 32 is a region continued from the opening portion 36 where the pore diameter of the micropore in the depth direction is greater than 0 μm and 0.03 μm or less.
>
> Further, in the present disclosure, the internal maximum diameter portion 34 is a region positioned at a position deeper than the deepest portion of the surface opening portion 32 in the depth direction and is a region where the pore diameter of the micropore in the depth direction is in a range of 0.04 μm to 0.30 μm.

Feature 1.7' is therefore not clearly and unambiguously disclosed in JP'837. Already for this reason, claim 1 does not validly claim the priority of JP'837.

109. In addition, even if the individual parameters of features 1.5 and 1.6 can be found in JP'837, failing a pointer towards the specific combination of features of claim 1, this combination will not be considered by the skilled person and can only be identified with hindsight. Furthermore, the diameter ratio range arrived at for feature 1.7' and the parameters of features 1.5 and 1.6 as disclosed in JP'837 have different ranges. Again, even if these ranges could be arrived at by applying the partial priority approach, failing a pointer in the direction of the ranges as required by claim 1, no clear and unambiguous disclosure thereof can be found in JP'837.

110. The relevant date of the patent is thus that of the (undisputed) second priority date of 30 March 2018.

VALIDITY OF THE PATENT

Added matter

Principles

111. There is added matter if the claim as granted contains subject-matter that extends beyond the content of the application as filed. In order to ascertain whether there is added matter, the Court must thus first ascertain what the skilled person would derive directly and unambiguously using his common general knowledge and seen objectively and relative to the date of filing, from the whole of the application as filed, whereby implicitly disclosed subject-matter, i.e. matter that is a clear and unambiguous consequence of what is explicitly mentioned, shall also be considered as part of its content.

The disclosure of the application as filed

112. In the SoD (para. 511 to 524) Kodak argues that feature 1.6 of claim 1 of the Patent extends beyond the disclosure of the European patent application in the version originally filed as WO 2019/064696 A1, published by the European Patent Office as EP 3 511 174 A1 (EP'174, Exh T2) (hereinafter: the Original Application). No other parts of the granted claim are attacked under Art. 138 (1) (c) EPC ("added matter").

113. Kodak objects to the MLD decision where this argument was rejected.

114. Kodak argues that the range of 100nm to 1500nm for the average value of depths of the large-diameter pores to the bottom from the surface of the anodised film, is only disclosed in the Original Application in para. [0123], which is a paragraph describing the particular embodiment of Fig. 3. According to Kodak's view the range of "100nm to 1500nm" is only disclosed in the context of further features of the particular embodiment to which Fig. 3 relates, namely in the context of (1) the existence of small-diameter pores connected to the bottom of the large-diameter pores and (2) the particular shape of the large-diameter pore (with a bottleneck and a body of the bottle) and (3) a relation between the depths D and E and (4) a particular range of the value of the depth E (100 nm to 2500 nm).

115. The MLD rightly considered that the Original Application in para. [109] which relates to the embodiment of Fig. 3 discloses the small-diameter pores as optional: "In Fig. 3, a small-diameter pore 132 communicating [with] the bottom of the large-diameter pore 130 is described, but the micropores 30 according to the aspect B may or may not have the small-diameter pores 132." This indicates to the skilled person that – in general - an embodiment derived from Fig. 3, but omitting the small-diameter pores, and a thickness E, is also part of the original disclosure.

116. The Original Application in para. [0122] to [0127] independently discloses possible values for the thickness of the anodised film (F, para. [0122]), the thickness of the depth of the large-diameter pores (D, para. [0123]) and the thickness of the depth of the small-diameter pores (E, para. [0124]). These thicknesses are not set in conjunction with one-another in para. [0122] to [0127] of the Original Application. In view of the clear teaching of para. [0109] that the small-diameters pores of Fig. 3 are optional, the skilled person understands that for the thickness F and the thickness D, the ranges given in para. [0122] and [0123] of the Original Application are stand-alone ranges that are suggested to the skilled person without any interrelation to a thickness E of small-diameter pores that may optionally be present.

117. The allegation that the range of "100nm to 1500nm" is only disclosed in the context of the particular shape of the large-diameter pore (with a bottleneck) also fails. The Original Application in para. [0114], which clearly relates to the embodiment of Fig. 3, because the large-diameter pore

is addressed as “large-diameter pore 130” and the reference sign 130 is only being used in the embodiment of Fig. 3, states that the shape of the large-diameter pore 130 is not particularly limited. This indicates to the skilled person that the disclosure of the embodiment of Fig. 3 is not limited to the particular shape shown in Fig. 3. In addition, insofar as Fig 3 discloses a “bottleneck”, this is reflected in claim 1, because feature 1.5 prescribes a larger diameter inside the anodised film and feature 1.7’ prescribes a smaller diameter in the surface of the film, so these features together lead to a bottleneck shape.

118. In addition, Fujifilm rightly argues (para. 660 SoR) that Fig. 3 only shows a single pore but feature 1.6 defines the *average* depth of the large-diameter pores. As from a single pore as shown in Fig. 3 no average values for the “thickness D” can be derived, it is also evident for the person skilled in the art that the information in the last sentence of para. [0123] according to “the average value of the thicknesses D in the support is preferably in a range of 100 nm to 1500 nm and more preferably in a range of 200 nm to 1000 nm” must be seen as a general information pertaining to the invention according to aspect B, but not to a description of Fig. 3 in particular.

119. Kodak’s argument, raised in its SoGA para. 478 3rd bullet, that the range of 100nm to 1500nm, by virtue of it being mentioned only in para. [0123] where the embodiment of Fig 3 is discussed, must be connected to micropores having the further characteristic that it does not extend through the whole thickness of the anodized film F (i.e. a barrier layer without pores must be present, or “the sum of D + E is smaller than F”) is a new argument on appeal. In its SoD Kodak has not identified this characteristic of the micropores described in Fig. 3. Kodak has not explained, and the Court of Appeal fails to see, why this was not brought earlier.

120. It can be left undecided whether the Court shall use its discretion under R. 222.2 RoP to disregard this argument. If it would be considered it would fail. In relation to Fig. 3, para. [0122] of the Original Application describes the thickness F to be in a range of 550 nm to 2850 nm, while para. [0123] of the Original Application describes the thickness D (the depth of the large-diameter pores 130 from the surface of the anodised film to the bottom) to be in a range of 100 nm to 1500 nm. The values for F and D hence are disclosed as overlapping ranges, which includes embodiments where D=F. This overlap speaks against an understanding by the skilled person that D plus E must be smaller than F, as Kodak argues.

Novelty

Principles

121. According to Art. 54(1) EPC, an invention is considered new if it does not form part of the state of the art. A technical teaching does not form part of the state of the art if it differs in at least one of its known features from what is already known in the state of the art. Only that what the skilled person, using his common general knowledge at the relevant filing or priority date, would derive directly and unambiguously from a single piece of prior art is considered to be anticipated thereby (cf. UPC_CoA_182/2024, 25 September 2024, Mammut v Ortovox; UPC_CoA_382/2024, 14 February 2025, Abbott v Sibio).

122. The disclosure of the prior art document as a whole must be considered. However, the content of a prior art document must not be treated as a reservoir from which features may be drawn to create a particular embodiment, but rather different passages in a document may only be combined if there is a clear and unmistakable teaching suggesting this.

123. A feature may also be disclosed implicitly, but this requires that that the skilled person would objectively consider such feature to be necessarily implied in the explicitly disclosed content, i.e. matter that is a clear and unambiguous consequence of what is explicitly mentioned, shall also be

considered as part of its content. Knowledge that a skilled person only acquires as a result of further deliberation beyond this cannot be considered a direct and unambiguous disclosure.

124. For a claim that defines features of the claimed product by way of ranges – like the present claim 1 in features 1.5, 1.6, 1.7', 1.8 – lack of novelty is found if the state of the art contains either by way of description or by other means of disclosure *an individual product* that for each and every feature that the claim defines by way of ranges has a particular value or subrange that falls into the claimed ranges (and the subrange not extending beyond the claimed range).

Assessment

Public prior use

125. Kodak asserts that the Patent lacks novelty because its [redacted]/ Sonora X plates were publicly available before the priority date of 30 March 2018 and they disclose all the features of claim 1 of the Patent. The MLD, proceeding from the priority date of 29 September 2017 and disregarding all submissions by Kodak regarding alleged public prior use after the filing of the SoD, rejected the novelty attack based on public prior use.

126. Kodak unsuccessfully argues that everything disregarded by the MLD should still be considered on appeal because it was anyway 'submitted' during proceedings before the Court of First Instance, while R. 222.2 RoP only applies to anything 'not submitted'. This cannot be accepted as a general rule, because it would render the principle of front-loaded proceedings and the principle underlying R. 222.1 RoP that the appeal in principle is based on the requests, facts, evidence and arguments submitted at first instance largely meaningless if everything that was rightly disregarded by the Court of First Instance should nevertheless be considered on appeal.

127. Kodak has (as a subsidiary position) requested that the Court of Appeal uses its discretion under R. 222.2 RoP to allow everything that has been disregarded by the MLD in relation to its alleged public prior use into the proceedings on appeal. Indeed, the Court could use its discretion to do so, in particular if it considers that the Court at First Instance was wrong to disregard certain arguments or documents. There is no need to decide on this request in the context of Kodak's public prior use attack.

128. With its Rejoinder, Kodak uploaded experimental reports (Exh. T59 and T62) containing measurements of pore diameters in its [redacted]/Sonora X plates from batches #239185 and #253299. These show that the diameter ratio as required by feature 1.7' was 57% and 56% respectively. Given that there is no reason to consider fluctuations or a 'standard deviation', as Kodak has submitted (see under claim interpretation in para. 89-95 above) it has not been shown that the [redacted]/ Sonora X plates disclosed the ratio in a range of 10-50% as required by feature 1.7'. The ratio measured by Fujifilm (Exh K15, batch #310773) was 53%, also outside the required range.

129. Kodak has submitted further new evidence of alleged public prior use with its SoGA. It has stated that only after the first instance hearing it was able to locate a retained sample of a third batch of SONORA X (#263612), which was sold and delivered to several customers before the priority date of 30 March 2018. Its explanation why it could not reasonably have been found it earlier is unsatisfactory.

130. Kodak first states (para. 285 SoGA) that "Clarifying which product batches had been sold and delivered to which customers during the period in question was particularly difficult, as these sales had taken place more than six years prior to the first instance proceedings", without explaining why this batch was found considerably later than the other batches submitted during the proceedings at first instance.

131. From Kodak's further statement (para. 286 SoGA) that it had to *additionally* identify physical samples of the respective batches that could be examined for their characteristics with regard to the claim features, since "[Fujifilm] continued to dispute Appellants' assertion that the printing plate precursors sold to multiple customers anticipated the features of the asserted claims", rather indicates that Kodak had not endeavoured to find all possible evidence at once and only started to look for further evidence later.

132. This is confirmed by Kodak's further explanation (para. 287 SoGA) that it had no reason to expect that the evidence presented in relation to batches #239185 and #253299 would not be sufficient to prove its alleged public and private prior use and that only after the MLD took a different view in its order of 22 January 2025 and in the oral hearing on 11-13 February 2025, Kodak *once more* searched for *further* retained batch samples and then found the retained sample of batch #263612.

133. This indicates that Kodak would have found and could have submitted the new evidence during the proceedings at first instance, if it had searched for it at that time. That it was difficult to clarify which batches were sold at which time to which customers, as Kodak asserts, is not convincing, since Kodak makes use of SAP for its administration, which should enable it to trace batches sold before the priority date within a reasonable period of time, as Kodak managed to do with sales to [redacted], Laserline and AtéCé.

134. There was also reason for Kodak to search for further evidence, given that its own measurements of the batches #239185 and #253299 showed that the [redacted]/Sonora X plates did not disclose feature 1.7'. The dismissal of a party's arguments by the Court of First Instance cannot be a sufficient justification to only then start looking for (further) evidence and submit that for the first time on appeal. It would render R. 222.1 and 2 RoP largely meaningless.

135. The lack of proper justification for the new submissions on appeal cannot be outweighed by its relevance and the procedural position of the other party. Kodak and its witnesses have consistently stated that Kodak Graphic has as from 28 August 2017 always used the same substrate starting materials and process settings for substrate production of Sonora X as used in the production of Sonora X with batch #310773, which was measured in Fujifilm's infringement analysis (Exh. K15) and this was confirmed by its own measurements (T59 and T62). Thus, it cannot reasonably be expected that measurements presented on appeal show a substantial deviation from the measurements already submitted at first instance, and if they did it would inevitably raise a completely new debate as to the correctness of the measurements, which is detrimental to the procedural position of other party who is then on appeal for the first time confronted with new facts and evidence. The fact that the time limit to respond is three months does not alter that.

136. The Court of Appeal notes that even if the additional evidence were admitted, it would most probably not have altered the Court's assessment on public prior use. The Court is very much persuaded, based on the arguments and counter-evidence provided by Fujifilm in its SoR and FFP, that the Sonora X plates, upon proper measurement (without selection-bias), did not show a diameter ratio of 47% as presented by Kodak in Exh. A12, but rather 57%, leading to the conclusion that the plates of this batch did not disclose feature 1.7' either.

137. In view of the above, the Court of Appeal exercises its discretion pursuant to R. 222.2 RoP – which applies equally in infringement actions and revocation actions – to disregard the new evidence regarding alleged prior use submitted with its SoGA (Exh. A6 – A15 and related paragraphs of the SoGA and KFP).

138. It follows that Kodak has not established that the [redacted]/ Sonora X plate disclosed the features of claim 1 of the patent, in particular feature 1.7'. Its arguments based on public prior use must therefore already fail for that reason. That being the case, there is no need to decide whether the

[redacted]/Sonora X plates delivered to customers prior to the priority date led to availability to the public, as Kodak contends, but Fujifilm disputes.

WO'379

139. WO'379 (Exh. T12) was filed on 20 February 2018 and published on 7 September 2018, after the filing date of EP'174 (31 May 2018). WO'379 is thus not state of the art according to Art. 54 (2) EPC, but state of the art according to Art. 54 (3) EPC and thus only relevant to novelty.

140. It is not in dispute between the parties that WO'379 does not explicitly disclose feature 1.5 or feature 1.7'.

141. The anodised film that would need to show the features 1.5 and 1.7' in WO'379 is made up of the inner aluminium oxide layer and the outer aluminium oxide layer. The outer aluminium oxide layer is the one that provides the pore diameter of the micropores *in the surface of the anodised film.* The parties rightly proceed from this attribution of features of WO'379 to the relevant features of claim 1 of EP'174.

142. Feature 1.7' requires the average pore diameter of the micropores in the surface of the anodised film to be in a range of 10% to 50% of the maximum diameter of the large-diameter micropores inside the anodised film.

143. Based on the reworking of example 7 of WO'379, Kodak claims that in the three Samples A, B, C that Kodak investigated, the ratio between the average pore diameter of the micropores in the surface of the anodised film to the average maximum diameter of the large-diameter pores inside the anodised film was 56% (Sample A), 64% (Sample B), 54% (Sample C) (Exh. T30, page 12 and 13). These ratios are outside the range of feature 1.7'.

144. As considered above, nothing in EP'174 indicates to the skilled person that the claimed subject matter extends to embodiments where an average pore diameter of the micropores in the surface of the anodised film would be above the exact value of 50% of the maximum diameter of the micropores inside the anodised film. Already for this reason WO'379 does not directly and unambiguously disclose feature 1.7'. The Patent is thus new in relation to WO'379.

EP'452

145. EP'452 was published on 3 June 2015 and hence state of the art according to Art. 54 (2) EPC. The disclosure of features 1.5-1.7' and 1.9 of the Patent is disputed by Fujifilm.

146. The claimed subject matter is new over EP'452, because not every feature of the claimed lithographic printing plate precursor can be derived directly and unambiguously from EP'452.

Feature 1.7'

147. Kodak asserts that Examples 3, 11 and 12 of EP'452 anticipate all features of claim 1.

148. Under the heading <Example A>, EP'452 in para. [0250] to [0320] describes individual lithographic printing plate precursors. As described in para. [0283], each individual lithographic printing plate *precursor* disclosed in the section <Example A> is formed by applying an undercoating solution of the composition indicated in para. [0284] to [0295] onto each lithographic printing plate *support* manufactured as described in para. [0250] to [0282].

149. Table 2 of EP'452 contains various parameters of the examples, including the surface layer average diameter and the bottom average diameter. The resulting lithographic printing plate *precursor* according to Example 3, 11 and 12, are referred to in Table 3 (Part 1) in para. [0309] as

EX3, EX11 and EX12, showing the properties that have been evaluated in the section headed <Evaluation of Lithographic Printing Plate Precursor> (para. [0296] to [0308]).

150. The diameter ratio of feature 1.7' is not explicitly mentioned in EP'452. It is also not implicitly disclosed. Feature 1.7' is not immediately apparent for the skilled person when looking at the values for Examples 3, 11 and 12 in Table 2 of EP'452, which would disclose a diameter ratio within the 10-50% range, as Kodak submits. Table 2 contains values for thirteen parameters, among which the surface average diameter and the bottom average diameter. EP'452, however, nowhere mentions let alone places importance on a relationship between the average diameter of the micropores in the surface and the maximum diameter of the large-diameter portions inside the anodised film (feature 1.7'). Kodak has not shown that EP'452 provides any pointer to the skilled person to specifically select these two parameters out of the thirteen given ones, let alone to consider a ratio between the two values as required by feature 1.7'. Choosing these parameters – and thus the ratio between them – is therefore not necessarily implied in the explicit content of EP'452. Table 2 of EP'452 would thus not inevitably lead the skilled person to feature 1.7'.

151. The reliance by Kodak on the doctrine of inevitable result when reworking an example in a prior art document (para. 328-332 SoGA) must also be dismissed, since Kodak has not shown that an embodiment that fulfils all features of the claim would indeed be obtained by submitting evidence of such reworking of Examples 3, 11 and 12. In addition, the obtained embodiment would not fulfil all features, since the Examples do not describe an acid colour former as required by feature 1.9 (see para. 157 et seq. below).

152. That the description of the Patent in Table 2 also does not have a column explicitly mentioning the diameter ratio does not lead to a different evaluation. The Patent description clearly teaches the skilled person the relevance of the diameter ratio and it is within the skilled person's skills to calculate that ratio from the diameters given in Table 2. As said, such teaching is absent in EP'452 and the skilled person would thus not inevitably arrive at the diameter ratio of feature 1.7' when taking notice of Table 2 in EP'452. The mere fact that he *could* do is insufficient for an implicit disclosure. Feature 1.7' is thus not directly and unambiguously disclosed in Table 2 of EP'452.

153. The reliance by Kodak on an implicit disclosure according to EPO case law regarding situations where an implicit disclosure can occur if the invention is defined by a parameter and in the prior art a different or no parameter is mentioned, under which the applicant is to show that differences exist with respect to the parameters (para. 327 SoGA), is denied. The reversal of the burden of proof may apply where the Patent uses an unusual parameter feature which represents the only distinction over otherwise identical known products, but Kodak has not shown this is the case here (Case Law of the BoA, 2025, page 142, para. 5.2.3).

154. Kodak furthermore refers to the disclosure of values for the "bottom average diameter" in claim 5 in a range of more than 10nm but up to 60nm, and the disclosure of values of the pore diameter in the surface in claim 1 in a range of at least 10nm but less than 30nm, with para. [0026] of EP'452 providing more preferred ranges of 10 to 25 nm, 11 to 15 nm and 11 to 13 nm, which result in diameter ratios of 17-50% when calculating with the maximum diameter of 60 nm.

155. This already does not lead to a direct and unambiguous disclosure of the diameter ratio as defined in feature 1.7' because, as said, EP'452 does not teach the relevance of a relationship between the two diameter parameters.

156. In addition, it also does not disclose the relevant range of 10-50% as required by feature 1.7'. Even though it is true that in case of disclosed ranges, this is to be considered as an explicit disclosure of the end values, it is also true that unless there is a clear teaching to the contrary (which has not been shown), when assessing whether the range of feature 1.7' is implicitly

disclosed, as Kodak asserts, the entire disclosed ranges of both parameters, i.e. both the lower and upper end values of the ranges disclosed in claim 1 and claim 5 (with further preferred ranges disclosed in the description) should be considered. There is no indication in the description that the end value of 60 nm is particularly relevant. Most Examples show a value of around 25nm, which is in the middle of the more preferred range mentioned in para. [0039]. When considering whether feature 1.7' is implicitly disclosed in EP'452, not just the upper end value of 60nm must be considered, as Kodak has done, but also the lower end value of 10 nm for the "bottom average diameter". This leads to a range of 17-300% and cannot take away novelty of feature 1.7'.

157. Kodak's measurements performed on Fig. 2 (para. 368 SoGA) do not lead to the conclusion that feature 1.7' is disclosed either. Figures in a patent specification are not to scale unless explicitly taught to be so. In addition, failing a teaching to that effect, a schematic drawing cannot be used to derive a ratio between two given dimensions. Given the absence of discussion of a relevance of a relationship between the average diameter of the micropores in the surface and the maximum diameter of the large-diameter portions inside the anodised film, it is therefore not permissible to derive either dimensions or a ratio between them from Fig. 2. In addition, in view of the absence of such teaching, the measurements on Fig. 2 as suggested by Kodak, are not immediately apparent to the skilled person and thus not implicitly disclosed.

Feature 1.9

158. It is undisputed (para. 336 SoGA) that none of the examples 3, 11 and 12 includes an acid colour former as required by feature 1.9 (an image recording layer containing an acid colour former).

159. Kodak argues that feature 1.9 is disclosed, if the Examples 3, 11 and 12 are read in the context of the entire disclosure of EP'452 (para. 339 SoGA). For Kodak's argument to succeed, it would require that EP'452 contains a teaching that the explicitly disclosed type of image recording layer of the Examples 3, 11 and 12 should be understood to be incomplete and that an acid colour former must be added. This is not the case. There is no indication anywhere in the description which would lead the skilled person to such understanding when reading EP'452.

160. Kodak has referred to para. [0215] of EP'452, which appears under the heading 'Surfactant', this para. merely states: "Various other compounds than those mentioned above *may optionally* be added to the image recording layer. For example, compounds disclosed in paragraphs [0181] to [0190] of JP 2009-255434 A such as colorants, printing-out agents, polymerization inhibitors, higher fatty acid derivatives, plasticizers, inorganic fine particles and low-molecular weight hydrophilic compounds *may* be used" (emphasis added).

161. Nothing in EP'452 directly and unambiguously teaches the skilled person the need to change the selection of components of the image recording layer made for the Examples by the addition of another compound and if so which. Examples 3, 11 and 12 obtained good results for 'on press developability' and 'microdot' and further product characteristics. To the skilled person's understanding this indicates there is no need for the addition of further compounds. That is particularly so for a print-out agent. *All* examples of EP'452 are free of any colour former, indicating to the skilled person that that image recording layers with a colour former are not necessary or preferred in the view of EP'452.

162. Even if the skilled person would consider the need to add another compound to one of the Examples of 3, 11 or 12 in view of para. [0215], there is no guidance in EP'452 which component(s). The components listed in para. [0215] are unrelated; they do not address comparable issues. Failing any pointer in EP'452 which component(s) to add would require further deliberations by the skilled persons (for example reflecting if any additional compounds would be useful for the Examples 3, 11, 12 and for what reason and what benefit and which possible negative implications introducing a particular additional compound would have on the as such positive results of

Examples 3, 11, 12). The resulting knowledge from such deliberations do not belong to the direct and unambiguous disclosure of EP'452.

163. The mere reference in para. [0215] of EP'452 to JP 2009-255434 A (Exh. 35a in English translation) does not lead to a different conclusion. In the referenced paragraphs JP'434 gives various examples of compounds mentioned in para. [0215]. There is no pointer in EP'434 to consider selecting one particular component out of this unrelated list as an addition to either of the Examples 3, 11 or 12 either. If at all, then only in relation to polymerisation inhibitors it is stated that adding it would be *preferable*. In relation to all other components, it is merely stated as possibility ('can' or 'may'), just as in para. [0215].

164. The same reasoning applies to the "Second Configuration: Image Recording Layer Including Thermoplastic Polymer Particles as Infrared Absorber and Capable of Recording by Exposure to Infrared Light" in para. [0219] et seq. of the description of EP'452, that Kodak has also referred to.

165. In para. [0224] it is mentioned that the image recording layer *may* further contain other ingredients, that in particular addition of colorants such as dyes or pigments which provide a visible colour that remains in the exposed areas after the processing step is advantageous, and that typical examples of such contrast dyes are amino substituted tri- or diarylmethane dyes, for instance, crystal violet, methyl violet, victoria pure blue, flexoblau 630, basonylblau 640, auramine, and malachite green. Kodak claims that some of these, but not all, are acid colour formers, namely crystal violet, methyl violet, victoria pure blue, auramine and malachite green (para. 344 SoGA).

166. Kodak failed to convincingly substantiate why this would lead the skilled person to objectively consider an acid colour former to be necessarily implied in Examples 3, 11 and 12. The fact that these colorants are disclosed as being *suitable* for image recording layers of on press developable printing plate precursors, because the examples belonging to the Second Configuration were tested on on-press developability, as Kodak argued (para. 286 Reply) is not sufficient to draw that conclusion.

167. It follows from the above that a direct and unambiguous disclosure that a print-out agent must be added to the composition of the Examples 3, 11 or 12 is lacking in EP'452.

168. For completeness' sake, the Court notes that Kodak submitted (albeit in the framework of inventive step, para. 421 SoGA) that acid colour formers were 'conventional' and 'necessary in practical use' with reference to the introductory section of the description of the Patent. There, the use of print-out agents is discussed. Para. [0008] states that "As the means for forming a print-out image, means for allowing an image recording layer to contain an acid colour former has been examined". Even if this must be understood to refer to the situation before the priority date, it cannot be inferred therefrom that specifically acid colour formers were conventional. Such common general knowledge cannot be derived from the use of acid colour formers by Kodak in its Sonora plates and neither by the disclosure of the use of acid colour formers in some patent documents. In addition, Kodak's expert witness Jung (Exh. T 37) considers visual inspection in on-press development to be advantageous (rather than necessary) and does not mention acid colour formers. Thus, taking into account the common general knowledge of the skilled person does not lead to another conclusion.

169. In view of the above, there is no need to discuss the disclosure of the further features 1.5 and 1.6.

Inventive step

Principles

170. The principles for assessing inventive step have been set out by this Court in *Amgen v Sanofi & Regeneron* (UPC_CoA_528 and 529/2024, para. 123-138).

Assessment

Publicly available Sonora X plates

171. Kodak argues that the Sonora X plates have been made publicly available before the relevant priority date. These show a ratio of 56/57%, whereas feature 1.7' requires a ratio of 10-50%. Kodak argues that the patent does not demonstrate that any technical effect is connected to a diameter ratio of 10 to 50 % compared to a diameter ratio of 56/ 57 % and in particular that the "appearance failure" would be improved thereby (para. 209 R.30 Rejoinder).

172. At first instance, this was only submitted by Kodak in its R.30 Rejoinder (para. 207-221). It was, however, already clear from Fujifilm's Reply, with which the range of feature 1.7 was unconditionally limited to a range of 10-50%, that the Sonora X plates fell outside the scope of the Patent. Kodak therefore could and should have brought this new inventive step attack with its Rejoinder, at which time it was also clear that the Sonora X plates showed a ratio of 53-57% instead of the 10-50% as required by feature 1.7'. Kodak has not provided a plausible reason for this delay, while the defendant is obviously negatively affected if a defence is brought for the first time in the very last written statement. The MLD was therefore right to disregard it and the Court of Appeal sees no reason to use its discretion under R. 222.2 RoP to allow it in the appeal proceedings.

EP'452 as starting point

Not a realistic starting point

173. The invention of EP'452 relates to a support for a lithographic printing plate and as well as to lithographic printing plate precursor (para. [0001]; claim 8). As indicated in para. [0008], the object of EP'452 is to provide a printing plate support that has excellent scratch resistance, provides printing plates with long press life and excellent on-press developability. The description also refers to resistance to (micro)dotted scumming, a defect detectable *after* on-press development of the lithographic printing plate precursor (see para. [0305] to [0308] describing the method for evaluating this defect) leading to defects in the printed image.

174. As considered above (para. 42) the object of the Patent is to provide a lithographic printing plate precursor that suppresses occurrence of appearance failure, which causes unintended colouring before development and causes errors in the print-out image. Improved scratch resistance is not an object in itself, but as is clear from the description rather a 'bonus' effect of the invention, an additional inherent advantage, which only became apparent after the solution to the problem of the appearance failure had been found (para. [0032], [0035]). The Patent and EP'452 thus do not have a similar underlying problem.

175. It cannot be accepted that EP'452 is nevertheless a realistic starting point because the cause of dotted scumming and appearance failure are the same, namely corrosion of the substrate, as Kodak asserted (para. 392 et seq. SoGA). According to para. [0003] of EP'452, if the hydrophilicity of the support is too low, ink is likely to be attached to the non-image areas at the time of printing, causing a blanket cylinder to be scummed and thereby so-called scumming to generated. There is nowhere in EP'452 mention of corrosion, leading to polymerisation, causing that polymerised areas are not removed from the image recording layer during development and then accepting ink during printing, as Kodak has advanced (para. 401 SoGA). In addition, Kodak has not substantiated

that at the priority date it belonged to the common general knowledge of the skilled person that both dotted scumming and appearance failure are caused by corrosion prior to development. The cause suggested in the description of the Patent dates from after the priority date and cannot be considered to be known to the skilled person prior to that date.

176. The mere fact that in EP'452 and the Patent the test methods for dotted scumming and appearance failure are both based on evaluating the corrosion resistance of the printing plate precursor, as Kodak argues (para. 393 SoGA), does not lead to a different conclusion. Apart from the fact that there are noticeable differences between these tests, the test in the Patent was obviously not known to the skilled person at the priority date and Kodak failed to show this was a customary test to show appearance failure that the skilled person based on its common general knowledge would have been aware of.

177. Thus, the EP'452 document cannot serve as a realistic starting point for the skilled person wishing to find a solution to the problem of appearance failure.

178. Even if the skilled person would take notice of EP'452, Kodak's inventive step attack fails.

Starting from Examples 3, 11 and 12

179. Kodak argues that the subject-matter of claim 1 is obvious starting from Examples 3, 11 and 12 of EP'452, stating that Examples 3, 11 and 12 of EP'452 show all features except the presence of an acid colour former (feature 1.9) and that the skilled person would add an acid colour former. This does not convince for several reasons.

180. Even if the skilled person would start from Examples 3, 11 and 12 – Examples 13-15 and 26-30 obtain better results – there is no pointer or motivation for the skilled person to arrive at the ratio and range of feature 1.7'.

181. EP'452, like the Patent, generally concentrates on the pore structure of the anodised film as the means to solve the task it has set itself, but places importance on different parameters of the pore structure and different interdependencies than the invention of the Patent does to achieve its aim. As is clear from para. [0009] to [0011] which describes the solution to the problems, as well as claim 1, EP'452 places importance on:

a. the presence of a large-diameter portion *and* a short diameter portion in the micropores, the large-diameter portion being substantially shorter in average depth (75 to 120 nm) than the small-diameter portion (900 to 2000 nm).
b. the relationship of an average diameter of the large-diameter portion at the surface of the anodised film to the average depth (depth A) of the large-diameter pore (ratio 4.0 to 12.0)
c. The average diameter of the small-diameter portion at the level of communication (more than 0 but less than 10.0 nm).

182. The solution of the Patent is different in that the presence of a small-diameter portion is not required according to claim 1 (it is covered by dependent claim 2) and the Patent does not require a particular relationship between an average diameter of the large-diameter portion in the surface of the anodised film and the *depth* of the large-diameter pore, but rather a relationship with the maximum *diameter* of the large-diameter pore inside the anodised film.

183. Kodak has not clarified why the skilled person who wishes to solve the appearance failure problem, failing any hint in that direction in EP'452, would be motivated to deviate from the relationship between an average diameter of the large-diameter portion at the surface of the anodized film and the depth of the large-diameter pore, disclosed therein as being advantageous, and would instead place importance on the ratio between the average pore diameter in the surface and the maximum diameter of the micropores inside the anodised film and thus arrive at the ratio of feature 1.7'. The mere fact that the necessary parameters are present (separately and

in different context) and *could* be combined is not sufficient, since failing a pointer there is no reason for the skilled person to actually combine these separate parameters. Similarly, as explained above the range of 10-50% as required by feature 1.7' is not disclosed in EP'452 and Kodak has not explained why the skilled person would arrive at such range.

Starting from Examples 13-15 or 26-30

184. As a second line of inventive step attack based on EP'452, Kodak relies on Examples 13 to 15 or 26 to 30 as starting point. While those examples obtained the best results as shown in Table 3, Kodak has not convincingly explained how the skilled person would have reached the invention without inventive skill when starting from those examples. For lack of incentive to arrive at feature 1.7', the same reasoning in relation to Examples 3, 11 and 12 applies to these examples as well.

185. In addition, the depth of the large-diameter pores disclosed in these examples (98 nm) is outside the range required by feature 1.6. As discussed above under claim construction, the skilled person would not consider that standard deviations are to be considered, and Kodak has not convincingly substantiated that this would be different for the average range values in EP'452. The argument that Fujifilm has not shown that the lower limit of 100 nm is critical or provides a technical effect compared to the value disclosed in these examples of EP'452 (para. 399 et seq Rejoinder) fails, because the onus of proof of lack of inventive step is on Kodak, who did not show a lack of technical effect. The lower limit is not an inadmissible amendment either, as discussed above under 'added matter'.

186. Kodak has not explained why the skilled person would amend the value for the depth of the large-diameter pores disclosed in these examples and increase it from 98 nm to 100 nm. This is also not apparent, since with the value of 98 nm excellent results were obtained.

Feature 1.9

187. Furthermore, EP'452 lacks a pointer to use an acid colour former in the image recording layers of the Examples (feature 1.9).

188. As discussed above under novelty, none of the Examples in Table 2 have an acid colour former in the image recording layer. Kodak's argument (para. 419 SoGA) that in a commercial setting with precursors to be developed on-press, it is *mandatory* that these printing plate precursors include a colour switch system such as an acid colour former, cannot convince. One key-objective of EP'452 is to provide excellent on-press developability ([0008]) and thus indicates that the primary commercial use of the precursors described in EP'452 is for on-press development. Yet it is undisputed that the skilled person sees in Table 3 of EP'452 that all of EP'452's disclosed embodiments are free of any colour switch system, such as an acid colour former, and both paragraphs identified by Kodak that concern colour formers ([0215] and [0224]) consider these only as optional components, which does not indicate a need to do so.

189. Kodak's allegation that the skilled person understands that for practical use an acid colour former is still to be added, because the exemplary printing plate precursors according to EP'452 were only tested in a laboratory setting, lacks support in the description and is even contrary to the statements of para. [0215] and para. [0224] that – as indicated above – even with providing excellent on-press developability as a key objective of EP'452, and hence precursors that are commercially used for on-press development, clearly consider such an additional compound as optional.

190. In addition, even if the skilled person would have considered amending the existing (print-out agent free) image recording layer of the Examples by adding a print-out agent to form a print-out image, it is not self-explanatory that out of the many alternatives which are not all based on an acid colour former (para. [0182] of JP'434 mentions both an acid and a radical; not all colorants mentioned in para. [0224] of EP'452 are acids) the skilled person would specifically choose an acid

colour former. Kodak has asserted that a choice out of the given alternatives cannot be inventive, but failed to show that an acid colour former constituted an arbitrary selection within the available alternatives.

191. Kodak has failed to explain why the skilled person, starting from one of the Examples of EP'452 and looking to solve the appearance failure problem, would have an incentive to consult EP'968 which discloses – among others – the use of acid colour former for the purpose of obtaining excellent image visibility after exposure in on-press development. As said, EP'452 does not contain a pointer in the direction of a need to improve image visibility and considers colour former/print-out agents only *optional* components. However, even if the skilled person would be directed to this document, Fujifilm rightly points out (para. 596 SoR) that EP'968 suggests as colour-forming agent either an acid colour-forming agent or a heat colour-forming agent or a cyanine dye (see EP'968 para. [0145]). Kodak does not explain, why the skilled person would – in an obvious manner - select from this list of possibilities an acid colour-forming agent to be introduced into image recording layer of one of the Examples in EP'452 or why that would be an arbitrary selection.

192. Similar considerations apply to alleged combinations with US'599 (Exh. T40) and JP'434 (incorporated in EP'452 by reference in para. [0124]).

193. Finally, since it cannot be accepted that acid colour formers were 'conventional' and 'necessary in practical use', as considered above under novelty, (para. 167), the skilled person would also not add an acid colour former based on its common general knowledge.

194. Even if the advantageous use of print-out agents would have been common general knowledge, and acid colour formers could serve that purpose, Kodak has not convincingly explained why in this particular case, where despite this allegedly conventional technology none of the examples contains an acid colour former, good results were obtained and the description only mentions or references the addition of a print-out agent / colorant as a possible option, the skilled person nevertheless had a motivation to apply a print-out agent, let alone specifically an acid colour former (or why that would be an arbitrary choice).

195. Finally, Kodak has not convincingly argued why the skilled person would combine the features of 1.5 to 1.8, with the specifically claimed ranges. Arguing that the skilled person could have arrived at each of these features without inventive skill is, even if that would hold, insufficient to conclude he *would* arrive at the specific combination of all of these features of claim 1 of the Patent without inventive skill.

EP' 968 as starting point

196. Kodak made clear in para. 382, 388-389 SoGA and confirmed during the oral hearing that it does not consider EP'968 a suitable starting point for the examination of inventive step. It therefore cannot support an inventive step attack.

<u>Conclusion on validity</u>

197. The above leads to the conclusion that all validity attacks raised by Kodak in its Counterclaim for revocation fail.

INFRINGEMENT

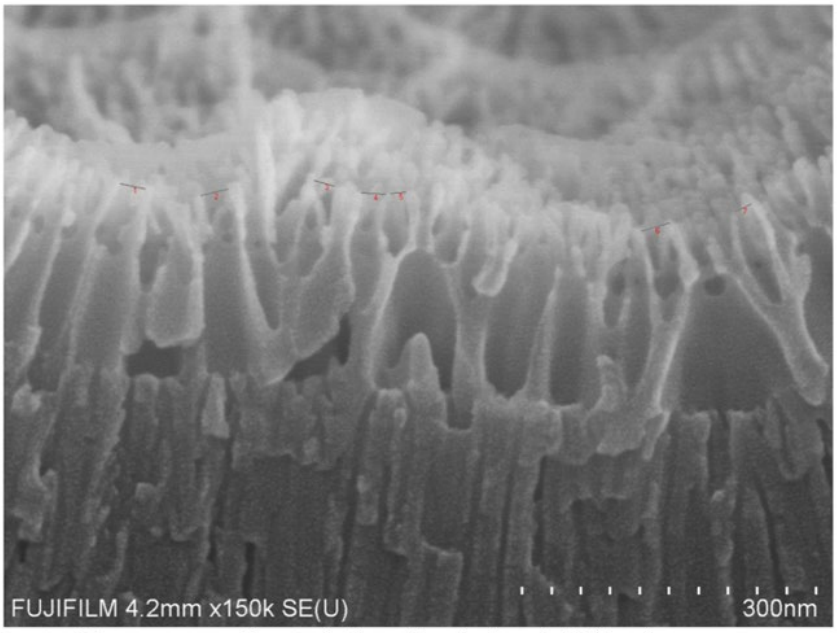
German designation

198. For proof of infringement, Fujifilm relies on Analysis Report EP 3 511 174 filed with its SoC as Exh. K15. In this report, the attacked embodiment is Sample #3. Regarding the analysis of large-diameter pores inside the anodised film and measurement of maximum diameter of the large-diameter pores, K15 on page 13 to 18 explains, how the analysed samples were taken from the sample poduct, prepared for analysis and in particular, that
   a. FE-SEM images of the cross-sectional surface were obtained by using the S-4800 type scanning electron microscope manufactured by Hitachi High-Tech Co., Ltd., with the following conditions applied: Acceleration voltage: 12 kV, Current value: 10 µA, Detector: Upper secondary electron detector, working distance: 4 mm, Data size: 1280 x 960, Magnification: x150.000;
   b. for analysis of the maximum diameter of the large-diameter pores inside the anodised film, a total of 25 measurement points (using 4 images) were analysed.

199. As regards the evaluation of the ratio of the average diameter of the micropores in the surface and their maximum diameter inside the anodised film, it is explained on page 18 of K15 that for the measurement of the average pore diameter in the surface of the anodised film, the same cross-sectional FE-SEM analysis and the same FE-SEM images as for the analysis of the maximum diameter inside the anodised film were used, while for representative analysis, the surface diameter was assessed for a total of 25 measurement points (using 4 images).

200. The methodology applied by Fujifilm is generally in line with what EP'174 suggests in [0042] and [0071] and Kodak has not challenged the set-up and approach documented in K15.

201. From Exh. K15 it is clear that the pore diameter of the openings in the surface have been measured by measuring the distance between peaks of spikes, as for example shown in the FE-SEM picture reproduced below.



Measurement of the average pore diameter in the surface for Sample #3 (showing seven measurements)

202. The first line of Kodak's attack on infringement is the different layer structure caused by the manufacturing process. This is, however, irrelevant to claim 1 (see above, para. 72-78). There is therefore no reason to distinguish a separate layer A and layer B in the attacked embodiment based on the anodisation process (see figure in para. 79 above). In the Patent ([0056]) the surface

opening portions 32 and the internal maximum diameter portions 34 in Fig. 1 and 2 are collectively referred to as "large-diameter pores". It follows that what Kodak refers to as layers A and B in the attacked embodiment must together be considered to form the large-diameter pores, with the 'spikes' being *part of* the large-diameter pores, representing thickness A (see fig. 2 in para. 54 above). Fujifilm's measurements for feature 1.6 spanning across the layers identified by Kodak as Layers A and B is therefore correct. This depth is clearly distinguishable from the depth of the small-diameter pores, which has not been measured. It cannot be seen that Fujifilm arbitrarily allocated separate void volumes at its own discretion to arrive at the value of feature 1.6., as Kodak submits (para. 734 SoGA).

203. Kodak's submissions that the infringement is not proven if layer A or, alternatively, layer B were to be considered to constitute the large-diameter pore (para. 767 - 769 SoGA) – are already flawed because neither is the case.

204. Kodak also argues that even if layers A and B of the attacked embodiment were to be regarded as one "combined" layer, features 1.5-1.7' are not realised because due to the largely dissolved pore walls in layer A of the attacked embodiments, there are no continuous large-diameter pores that extend from the surface of the anodized film specified in feature 1.6, while the void volumes in the lower layer B of the anodized film, on the other hand, are not extending 'from the surface' of the anodized find and thus have no opening in the surface (para. 742, 749 SoGA).

205. This argument must be dismissed. As explained under claim construction, the spikes form part of the surface and where they protrude from the boundary of an opening in the surface, the spikes form part of the boundary of the opening in the surface (see para. 83 above). The fact that the remnants of several pores initially formed in layer A may be connected to one pore in Layer B, as Kodak submits (para. 743 SoGA), does not lead to a different conclusion. The claim does not require the outer / sidewalls of the large-diameter pore to be even. Also, if some spikes do not extend from the boundary of an opening but communicate at another position with the wall of the large-diameter pore, that does not prevent that other spikes do extend from a boundary of an opening and these are then part of the surface opening portion of the large-diameter micropore.

206. Kodak's further allegation that layers A and B of the attacked embodiment cannot be considered to form large-diameter pores since the spikes are not extensions of the core structure below but distributed independently of the pore walls below (para. 742, 753 SoGA) does not hold. The spikes, even if independently formed, must somehow be on the wall of the pores below, they cannot be unconnected. In addition, as can be seen from Exh. K15 Annex 1c, the spikes do in fact extend from the material surrounding an opening of a pore.

207. Kodak's further assertion that due to the spike-like structure with a high void volume at the surface the attacked embodiment does not achieve the advantage of scratch resistance, because – as para. [0035] of the Patent clarifies – that requires "more bulk" of the film in the surface (para. 748 SoGA) lacks substantiation. To the contrary, Kodak itself has promoted its Sonora Xtra-3 plates as having enhanced scratch resistance (Exh. K11, p.3).

208. That the attacked embodiment does not have large-diameter pores that are associated with exactly one opening in the surface of the anodized film, as Kodak submits (para. 747, 762-763 SoGA) is not relevant because the claim does not require that one large-diameter pore can have only one opening (see under claim construction para. 84-88 above). Kodak has also not shown that in the infringement analysis Exh. K15) pores associated with more than one opening in the attacked embodiment exist, let alone have been part of the measurements.

209. Kodak further submits (para. 765 SoGA) that the attacked embodiment does not implement the technical teaching of the Patent and is known to suffer from the exact problem of appearance failure that the Patent claims to have solved when the support is coated with an image-recording

layer containing halogen-containing anions, due to the fact that the pores in layer B of the attacked embodiment are not connected to a single opening in the surface of the anodised film, but to the remnants of several of the pores initially formed during the first anodisation step in layer A. This lacks any substantiation and must therefore be rejected.

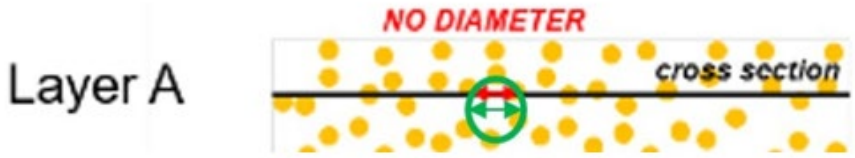
210. It further follows from what has been considered under claim interpretation (see para. 83) above) that the argument that due to the spike-like structure on the surface of the attacked embodiment there are no openings in the surface of the anodised film which have a continuous boundary that would allow measuring an average diameter, is flawed.

211. As also follows from what has been considered under claim construction, para 84 above, the allegation that since the pores in layer A are created independently from the pores in layer B, taking the distance between the peaks of the spikes in layer A as the average pore diameter in the surface and to divide it by the maximum diameter of *unrelated* pores of layer B is not in accordance with the teaching of the patent (SoGA para. 764) has no merit. The claim does not require the measurement of the opening in the surface with the *associated* maximum diameter of the *same* pore, but rather (and only) that the average pore diameter of the micropores in the surface (generally) is in the range of 10-50% of the maximum diameter of the micropores inside the film (generally).

212. That the distance between the peaks of two spikes is not a diameter and that it is impossible to unambiguously recognize the original form of the pores in layer A of the attacked embodiment before their walls are dissolved, as Kodak submits (para. 756-759 SoGA) does not hold in general. Where the spikes protrude from the boundaries of the same opening in the pore below, it is possible to measure the diameter of that surface opening portion using two spikes opposite each other. Measuring the distance between two opposing spikes at the sidewalls of such opening can be considered representative of the diameter of the relevant opening below from whose boundaries the opposing spikes extend.

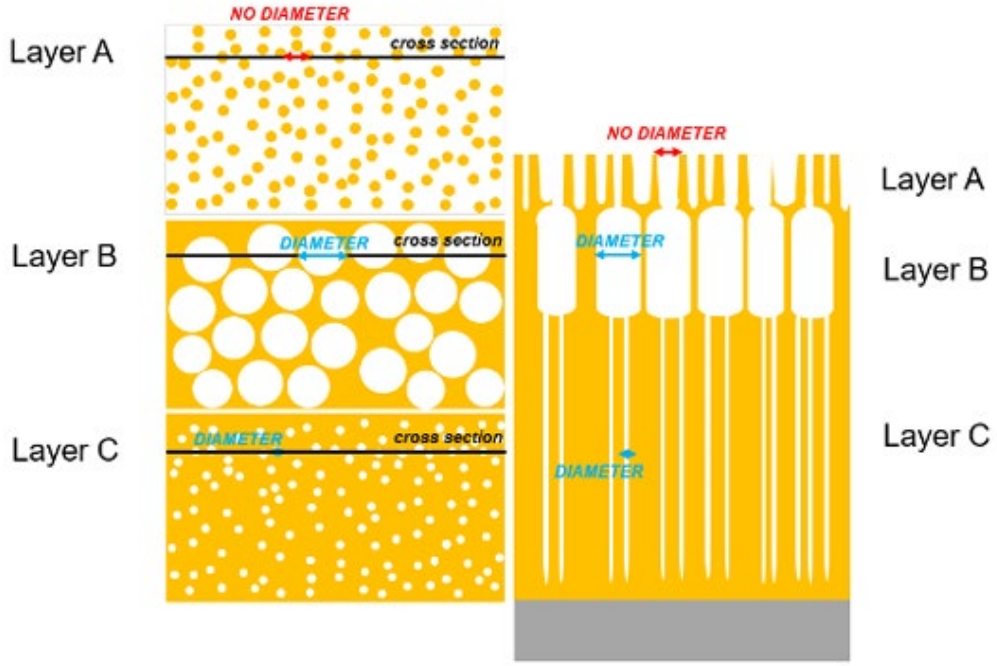
213. Kodak's argument that the distance between two arbitrarily chosen spikes (which are not opposite) does not represent the diameter of the opening (para. 760 SoGA) and that from the FE-SEM cross sections, it is not possible to distinguish opposing spikes which would correspond to the diameter of the initially formed pores remaining as spikes in layer A, from neighbouring spikes which are not related to any diameter at all, and further that since Fujifilm measured the alleged diameter in the cross-section of the anodised film, they are not measuring a diameter but just an arbitrary distance between two spikes (par 761 SoGA) is new on appeal.

214. The 'arbitrarily chosen spikes' argument cannot be derived from para. 41 et seq Rejoinder, to which Kodak has referred. Neither the argument itself, nor the figure shown in para. 760 SoGA (reproduced below) where the green circle illustrates the 'arbitrarily chosen spikes' argument, was included in the Rejoinder.



215. The above figure is an 'annotation' from a figure, shown below, that was included in the Rejoinder. The indication "no diameter" in that figure was, however, to illustrate Kodak's argument that the distance between spikes does not represent the diameter of a micropore in the surface, postulated in the context of the argument that there is no continuous boundary in Layer A due to the spike-like structure, and that even though there is a diameter with a

continuous boundary in Layer B (indicated with 'diameter' in blue), that diameter is not 'in the surface' (rejected in para. 203-204 above).



216. Even when considering this new argument, it cannot call into question the use of cross sections as a proper method for measuring the pore diameters. Kodak has not objected to para. 56 of the impugned decision, which states that the skilled person understands that the measurements described in para [0042] of the Patent (i.e. using cross sections) are used generally for the determination of other diameters and depths as well. The skilled person's understanding that it may use cross sections for the measurement of pore diameters *as such* is therefore not within the scope of the appeal.

217. Insofar as Kodak with this late argument must be understood to attack the correctness of the actual measurements in Exh. K15 which are based on measuring the distance between peaks of spikes, this fails. Kodak failed to show which of the actual measurements in Fujifilm's report (K15) would be incorrect due to alleged arbitrary choice of spikes. Neither has Kodak called the correctness of Fujifilm's measurements into question by presenting measurements of its own based on 'top view' measurements, showing results different from those relied on by Fujifilm.

218. The above leads to the conclusion that the attacked embodiment falls within the scope of claim 1 of the Patent.

<u>Private prior use</u>

Principles

219. According to Article 28 UPCA, "Any person, who, if a national patent had been granted in respect of an invention, would have had, in a Contracting Member State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that Contracting Member State, the same rights in respect of a patent for the same invention."

220. Whether Kodak may rely on a right of private prior use in respect of the German designation of the Patent is thus to be determined under German law.

221. Section 12(1) of the German Patent Act ('Patentgesetz', hereinafter also 'GPA'), in English translation, insofar as relevant, reads as follows:

> *Patents have no effect in respect of a person who, at the time the application was filed, had already begun to use the invention in Germany or had made the necessary arrangements for doing so. That person is entitled to use the invention for the needs of its own business in its own workshop or in the workshops of others.. (…).*

222. The act of use required under Section 12 GPA presupposes that the person acting has acquired independent possession of the invention. Possession of the invention is given if the technical teaching is objectively complete and subjectively recognised in such a way that the actual implementation of the invention is possible. There is no possession pursuant to Sec. 12(1) GPA if the product development has not yet gone beyond the experimental stage (FCJ, 12 June 2012, X ZR 131/09, GRUR 2012, 895, para. 18, *Desmopressin*).

223. Use of the invention is present in case of an act of use according to Sections 9 and 10 GPA, which includes manufacturing, offering for sale and putting the product on the market. Under German case law it is required that use of the invention is not merely private but indicates a serious intention of commercial utilisation (FCJ, 30 April 1964, Ia ZR 224/63, GRUR 1964, 496, 497, *Formsand II*).

224. In addition to the actual (commercial) use of the possessed invention, arrangements that carry out the decision to use the invention by preparing for this use also fulfil the requirements of the right of prior use. This requires that the prior user has taken a firm and final decision to use the invention commercially and has taken steps to put that decision into effect in the near future (cf. FCJ 21 May 1963, Ia ZR 84/63, GRUR 1964, 20, *Taxilan*).

225. With the private prior use right exception to the exclusive rights of a patent owner under Sec. 9 GPA, the law seeks, on grounds of equity, to protect the prior user's existing commercial rights or those already established through preparatory measures, and thereby to prevent the unjust destruction of assets created in a legally sound manner (FCJ 14 May 2019, X ZR 95/18, *Schutzverkleidung*, GRUR 2019, 1171, para. 27).

226. In accordance with this legislative purpose, the prior user is restricted to the use of that existing right for which all the requirements of the exception were fulfilled prior to the filing or priority date. Further developments beyond the scope of previous use are precluded if they encroach upon the subject-matter of the protected invention (*Schutzverkleidung* para. 28*)*. If the original product is modified without making use of a teaching contained in the patent description, the prior user does not benefit from the (later) disclosure of the patent description.

227. The prior user may therefore be precluded from deviations from the prior-used embodiment even if the technical teaching of the invention is realised both by the prior use and by the embodiment used only after the filing date, but the latter realises the teaching of the patent claim in a different configuration or method. If at least one feature of the patent claim is realised in a technically different manner than was the case prior to the filing date, this may exceed the limits of the prior user's right. Whether this is the case must be determined on the basis of an overall assessment which strikes a fair balance between the prior user's interest in being able to make economically sensible use of the acquired rights and the patent proprietor's interest in having to tolerate the use of his intellectual property right only to the extent that the technical teaching covered by the patent has been recognised and implemented by the prior user. Accordingly, the limits of the prior user's right may be exceeded if the modification realises an additional advantage that was not realised by the unmodified embodiment. This may be the case where an embodiment is used for the first time which is highlighted in a sub-claim or in the description of the patent on account of this additional advantage (*Schutzverkleidung,* para 29-31).

228. Consequently, an infringement does not arise from the fact that both the prior use and the use alleged to infringe the patent realise all the features of the patent claim, but do so in a different configuration or method, unless the modified configuration as realised in the contested embodiment compared to the prior use, realised one or more features of the claim in a qualitatively or quantitatively different manner, in particular associated with an additional advantage disclosed in the patent specification (cf *Schutzverkleidung, para. 31,* para. 43).

229. Thus, the decisive factor is whether the modification brings about an additional benefit (in which case the prior use right is exceeded) or whether it constitutes a completely equivalent alternative or a self-evident variation (in which case the prior use right is retained). This requires a substantive examination (FCJ, 20 June 2023, X ZR 61/21, *Faserstoffbahn,* GRUR 2023, 1184*,* para. 83-84).

230. The protection of the prior user established under Sec. 12(1) GPA is not affected by a subsequent limitation of the patent claim(s). Whether or not a modification of the original product is covered by the prior user's right must be determined based on the granted version of the patent. A subsequent amendment to the claims cannot remove a right to modify the previously used object (*Faserstoffbahn*, para. 86).

Assessment

231. Kodak claims a private prior use right for Sonora XTRA-3 based on the possession of the Sonora X plates before the relevant priority date.

Sonora X plates

232. The Sonora X plates were within the scope of claim 1 as granted. Both Fujifilm and Kodak have relied in this respect on the infringement analysis presented by Fujifilm (Exh. K15).

233. To substantiate that the Sonora X plates were already in its possession and that it used the invention commercially or had made the necessary arrangements to do so in the near future, Kodak has relied on witness statements, various documents and measurements of retained plates originating from batches produced prior to the priority date (Exh. T59 and T62).

234. [redacted]

235. 

[redacted]

236. With its Rejoinder, Kodak uploaded experimental reports (Exh. T59 and T62) containing measurements of pore diameters in its [redacted]/Sonora X plates from batches #239185 produced on 18/19 April 2017 (delivered to [redacted]) and #253299 produced on 28 August 2017 (delivered to Laserline and AtéCé). These show that the diameter ratio as required by feature 1.7' was 57% and 56% respectively.

237. These exhibits were disregarded by the MLD, but the Court of Appeal uses its discretion under R. 222.2 RoP to allow them into the appeal proceedings, because these cannot be considered new validity attacks or new facts, but rather as further evidence of facts already stated but disputed by Fujifilm.

238. Kodak in its SoD, as substantiation of its private prior use defence, relied on the measurements of a Sonora X plate presented by Fujifilm (Exh. K15), together with statements of witnesses that Kodak Graphic has always used the same substrate starting materials and process settings for substrate production of Sonora X as used in the production of Sonora X with batch # 310773, which was measured in Fujifilm's infringement analysis (Exh. K15) and that consequently, the Sonora X plates produced prior to the priority date, had all the features of claim 1 as granted.

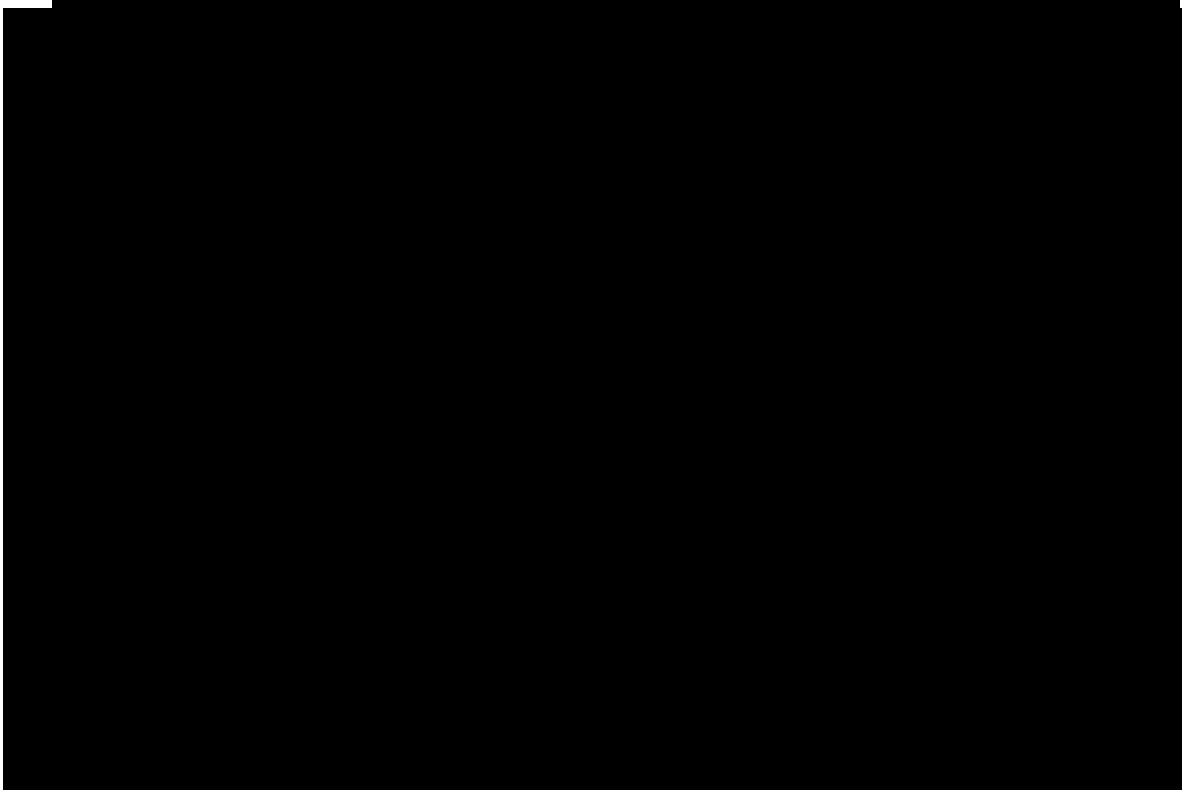
239. Since Fujifilm questioned the reliability of the witness statements and that the Sonora X plates produced prior to the priority date indeed had the features of claim 1 as asserted by Kodak, in response thereto Kodak submitted measurement reports of two batches of Sonora X plates produced prior to the priority date. Even if Kodak could have presented this evidence earlier (and it may have been preferable if it had done so from a procedural efficiency point of view) it is not contrary to R. 29(c) RoP and the front loaded system of the RoP if a party submits additional evidence of an already stated fact or submitted argument for which other evidence had already been submitted, but which was disputed by the other party.

240. The same reasoning applies to para. 101-236 of Kodak's Rejoinder (the first statement by Kodak after Fujifilm limited the Patent in its Reply) and Exh. T54-T66b, T75 and T77-T79b filed with the Rejoinder and R. 30 Rejoinder, with which Kodak responded to Fujifilm's challenges of Kodak's private prior use defence.

241. [redacted]

[redacted]

242. [redacted]



243. In an e-mail exchange dated [redacted] (Exh. T18), [redacted] approval for the renaming of the printing plate precursors developed under the project name [redacted] to 'Sonora X'.

244. As Exh. T19 Kodak submitted a partially blackened invoice to Laserline GmbH dated 12 October 2017 for 12 packages of [redacted] plates (according to Kodak containing 30 plates each). The order has been described as "Ihr Auftrag Nr. [redacted]".

245. Kodak submits that it has distributed among its customers a '[redacted]' dated [redacted] (Exh. T20). They are informed that:

[redacted]

246. The Bulletin also mentions [redacted]

247. As Exh. T22 and T23, Kodak submitted further invoices dated 14 February 2018 and 28 February 2018 for a total of 13 packages of '[redacted]' and 17 packages of 'SON X' respectively. The customer name has been blackened, but the customer number on each is the same (779863). The order number has been specified as "Entn. 01.2.-13.2."and "Entn. 14.2.-28.2." respectively. In addition, Kodak submitted as Exh. T24 a list of billing documents. This list includes the two invoices just mentioned, and an additional 13 other invoices dated between 17 November 2017 and 29 June 2018, for which the 'payer' number is the same as the customer number on the two aforementioned invoices (779863).

248. The evidence presented by Kodak discussed above shows that only on 28 August 2017 the [redacted] substrate and the image recording layer containing [redacted] that were developed in parallel, were first brought together as components of manufactured printing plate precursors. The evidence also shows that, after this composition was tested, Kodak Graphic had taken a decision on the final composition of the product and to commercialise this product in the sense of manufacturing it for commercial purposes (ultimately) by December 2017.

249. The circumstance that other Kodak companies may have been responsible for offering for sale and putting the product on the market does not alter the conclusion that Kodak Graphic did have possession of the invention and had made the decision to manufacture the product for commercial purposes (and be it only as contract manufacturer for other Kodak companies) and indeed did manufacture the product for that purpose. Nothing in the file suggests that the manufacture of the Sonora X plates did ever take place or was decided to take place by a different Kodak entity than Kodak Graphic.

250. The timeline is also clear from the [redacted] of [redacted] (Exh. T 20) in which it is announced that [redacted]. The fact that this [redacted] is stated to be "Kodak Confidential", as noted by Fujifilm (para. 931 et seq. SoR) does not change that Kodak shared [redacted] with its own customers. A firm and final decision to commercialise does not have to be publicly available. [redacted]

251. Kodak has presented evidence relating to a delivery from batch #253299 to its customer and reseller AtéCé on 9 January 2018 (Exh. T 77-79b). There is no reason to consider that this delivery took place under an obligation of confidentiality. Fujifilm's reliance on the general terms and condition is rejected. These only provide for a duty of confidentiality for business and trade secrets that are *designated* as confidential. Instead, this delivery rather shows that Kodak had started actually delivering the Sonora X plates as announced in the Customer Bulletin.

252. It is also confirmed by [redacted]: "Kodak significantly increased the manufacturing and sales volume of Sonora X from December 2017 onwards". Similarly, the billing list contains invoices as from mid November 2017. In addition, Kodak Graphic obtained approval for renaming the plates developed under its project name [redacted] to its commercial name Sonora X, clearly indicating an intention to bring the product to the market.

253. The decision to commercialise the Sonora X plates prior to the priority date is also evidenced by publications submitted by Fujifilm. An article published on the website printbusiness.co.uk dated 2 March 2018 (Exh. KAP 7) under the heading "Sonora X can take 80% of printers to process-free plates says Kodak" reports that Sonora X is the latest iteration of Kodak's develop on press plate and that these are manufactured by Kodak Graphic. An article on website print.de dated 20 March 2018 (Exh. KAP 8) has the heading "Kodak stellt neue prozessfreie Druckplatte vor" (Kodak introduces new process free printing plates).

254. The fact that it is reported in some of these publications that the Sonora X printing plates will be available by the second quarter of 2018 does not alter the fact that these publications evidence that the necessary arrangements for commercial use of the Sonora X plates had been made before the priority date (30 March 2018).

255. Contrary to Fujifilm's assertion, there is no need to submit evidence of the actual firm and final decision to commercialise the final product that embodies the invention, once it has been shown that before the priority date the product was both used (such as manufactured) and that the serious intention to use the product commercially was put into practice. As follows from the above, these requirements are fulfilled in this case well before the priority date.

256. The conclusion from the above is that Kodak Graphic acquired a private prior use right with respect to the Sonora X plates. If Kodak GmbH and Kodak Holding also acquired a private prior use right with respect to the Sonora X can be left undecided (see below para. 269-270). While the above may suggest that both Kodak Holding (by means of being the controlling entity of Kodak Graphic) and Kodak GmbH (by means of being wholly owned subsidiary of Kodak Graphic responsible for the sales of the products) also took the decision to commercialize the Sonora X product, it has not been shown by Kodak, which of the technical details known to Kodak Graphic were known by Kodak Holding and Kodak GmbH, and hence if Kodak Holding and Kodak GmbH were in possession of the invention at the time. It might well have been the case that Kodak Holding and Kodak GmbH were aware of the advantages of Sonora X, but not of the actual design of Sonora X.

Sonora Xtra-3 plates

257. The Court finds that this private prior use right extends to the Sonora Xtra-3 plates.

258. For Sonora Xtra-3 [redacted] it is produced by a different manufacturing process, [redacted], which leads to a different pore structure.

259. In terms of features of claim 1, the Sonora Xtra-3 plates differ from the Sonora X plates in that for the Sonora X plates the ratio required by feature 1.7 is measured to be 53% (Fujifilm measurement Exh. K15) and 56 / 57 % (Kodak measurements T59 and 62). The Sonora Xtra-3 plates have a ratio of 40% (Exh. K15 Annex 2c, as corrected). [redacted] no specific acid colour former is claimed. The description also does not attribute any particular advantage to the acid colour former used in Sonora Xtra-3. [redacted]

260. The different manufacturing process is not mentioned or suggested in the description and as such not related to a teaching in the Patent. As said above, the resulting pore structure has a diameter ratio of 40% - rather than the 53-57% ratio of the Sonora X plate – and falls within the scope of claim 1.

261. Para. [0064] of the description states that "The 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, and preferably in a range of 5 to 70% and more preferably in a range of 10 to 50% from the viewpoint of suppressing the appearance failure."

262. This suggests that an advantage would be obtained if the diameter ratio is reduced to a value below 50%. Although the fact that a feature is highlighted as preferred may (as in the case of a sub-claim) suggest that it constitutes a relevant additional advantage, this cannot, however, replace a substantive examination of whether such an advantage exists or whether the feature is an equivalent alternative (see *Faserstoffbahn* para. 84). Kodak has rightly pointed out (para. 890 SoGA and CFI Statements referred to therein) that the suggested increased performance if the diameter ratio is below 50%, does not find support in the examples and the results derived therefrom shown in table 3 (page 49).

263. It is undisputed that Examples 9-14 all relate to embodiments with an image recording layer coating solution not comprising any halogen-containing anion and all exhibited results of A and A after storage of 2 and 4 days respectively, including the embodiments with a diameter ratio below 10%. Given the suggested cause of appearance failure (see para. 41 above), the skilled person will attribute these good results to the image recording layer (not comprising any halogen-containing anion) used.

264. It is equally undisputed that Examples 1-5 and 18-22 relate to embodiments with an image recording layer coating solution comprising a halogen-containing anion and a diameter ratio of 90% or less. As noted by Kodak (para. 228 et seq SoGA) and not disputed by Fujifilm, Examples 18, 20 and 21 have a diameter ratio of around 70% and have an appearance failure result of A and B after storage of 2 and 4 days respectively. Examples 19 and 22, with a diameter ratio of around 20, have a (better) result of A and A. This seems to support the suggested increased performance if the diameter ratio is below 50%.

265. However, examples 1-5, also embodiments having a diameter ratio between 10 to 50%, all have a result of only A and B. Admittedly, examples 1,2,4 and 5 (with a diameter ratio between 16 and 37.5) have a different total coating amount of all layers (between 1.0 and 2.5 g/m^2) than examples 19 and 22 (which have 1.5 g/m^2), but example 3 (with a ratio of 42.9) has a total coating amount similar to the embodiments of examples 19 and 22 and still the result is only A and B.

266. From Table 2 it is clear that Examples 3, 18, 20 and 21 all have 'Thickness C' of 7 nm, while examples 19 and 22 have 'Thickness C' of 20 nm (see fig. 2, para 54 above). The skilled person derives from this that the improved performance in view of appearance failure in Examples 19 and 22 is not caused by the diameter ratio below 50%, but rather by the thicker layer between the bottom of the large-diameter pore inside the anodized film, which functions as a (thicker) barrier between that bottom and the aluminum substrate, preventing a component in the image recording layer, particularly an anion containing a halogen atom, to infiltrate into the anodised film and causing appearance failure (see para. 41 above).

267. Consequently, the Sonora Xtra-3 plate cannot be considered to achieve an additional advantage compared to the Sonora X plate.

268. Contrary to Fujifilm's argument with reference to *Schutzverkleidung,* para 29-31 (see above, para. 226), the fact that the Sonora Xtra-3 plates are manufactured in a different manner is not relevant. According to this decision, a fair balance between the prior user's interest in being able to make economically sensible use of the acquired rights and the patent proprietor's interest in having to tolerate the use of his intellectual property right only to the extent that the technical teaching covered by the patent has been recognised and implemented by the prior user, dictates

that the limits of the prior user's right are only exceeded if the modification realises an additional advantage that was not realised by the unmodified embodiment.

269. Claim 1 of the patent protects a product with the characteristics of the claim features, irrespective of the manner by which it is manufactured. The different manufacturing method used by Kodak is neither disclosed nor suggested in the Patent description. The use of this method thus has no bearing on the technical teaching of the patent and the resulting product does not achieve an additional advantage compared to the original Sonora X plate on which the private prior use right is based.

270. The conclusion is that Kodak Graphic has a private prior use right that extends to the Sonora Xtra 3 plates. The Sonora Xtra-3 plates manufactured by it have entered the channels of commerce and can be used or further traded without infringing the German designation of the patent, The right of prior use also encompasses the establishment of a distribution system and its organization with multiple distribution partners (FCJ, 12 June 2012, X ZR 131/09 (*Desmopressin*, GRUR 2012, 895, para. 35) Kodak GmbH therefore does not infringe the patent.

271. With respect to Kodak Holding, Fujifilm only alleges that it controls Kodak Graphic by virtue of that being a wholly owned subsidiary and for that reason is responsible for the business decisions of Kodak Graphic. It does not allege that Kodak Holding is selling or otherwise dealing with the Sonora plates itself. Since Kodak Graphic is not infringing due to its private prior use right, it cannot be seen and Fujifilm has not explained why Kodak Holding would be infringing. Thus, neither of the Kodak companies infringes the German designation of the Patent.

<u>UK designation</u>

<u>Accepting jurisdiction</u>

272. The MLD did not accept jurisdiction to decide on the validity of the UK validation of the patent. The MLD made it very clear that it only considered the validity of the UK part of the patent insofar as its invalidity was raised as a defence against the infringement claims.

273. The MLD was right to accept jurisdiction to hear the infringement of the UK designation of the Patent. None of the arguments raised by Kodak against this decision has merit.

The UPC's competence is not narrower than that of national courts due to Art. 34 UPCA.

274. Art. 34 UPCA states that "Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member States for which the European patent has effect". Kodak argues without success that Art. 34 UPCA must be understood to provide that the decisions of the UPC shall only cover the territory of the UPC Member States where a European patent has effect. It is not meant to confine the UPC's jurisdiction to its own territory. The word 'only' is not used, as Kodak wrongly submits.

275. Art. 34 UPCA clarifies that as a rule – unless a more limited scope is requested (cf Art. 43, 76 UPCA) – decisions of the UPC shall cover the territory of all Contracting Member States where a European patent has effect.

276. Article 71a Br I bis provides that for the purposes of the Regulation, a court common to several Member States as specified in paragraph 2 (a 'common court') shall be deemed to be a court of a Member State when, pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of the Br I Regulation. For the purpose of the Br I bis, the UPC is a common court (Article 71a (2)(a) Br I bis).

277. Pursuant to Article 71b(1) Br I bis a common court shall have jurisdiction where, under the Br I Regulation, the courts of a Member State party to the instrument establishing the common court (i.e. the UPCA) would have jurisdiction in a matter governed by that instrument.

278. There is no indication that the Contracting Member States when entering into the UPCA wished to confer a more limited jurisdiction to the UPC – confined to its own territory – in situations where the national courts would have extra-territorial jurisdiction, as Kodak asserts. To the contrary.

279. According to Art. 3 (c) UPCA, among the matter governed by the UPCA are European patents which have not yet lapsed at the date of entry into force of the UPCA, or were granted after that date. The UPCA is expressly not limited to European patents insofar as validated for the UPC territory only. As such, European patents validated in territories outside the UPC territory is 'matter governed by the UPCA'. It follows that where a national court would have jurisdiction under the Br I Regulation in relation to a European patent validated outside its own in territory, this jurisdiction is similarly conferred on the UPC (insofar as this European patent has not been opted out).

280. The fact that Art. 34 UPCA is not meant to confine the UPC's jurisdiction to UPC territory only, also follows from Art. 71b(3) Br I bis, which explicitly provides the UPC with long arm jurisdiction (see also COM/2013/0554 final at 1.2 and 3.3).

281. Nothing else follows from Art. 24(3) UPCA which provides that "The law of non-contracting States shall apply when designated by application of the rules referred to in paragraph 2, in particular in relation to Articles 25 to 28, 54, 55, 64, 68 and 72". To the contrary, this specifically leaves open the possibility that there is a need for the UPCA to apply national law, including that of non-contracting States. The use of 'in particular' makes clear that the areas of application of such foreign law is not limited to the matters referred to in the articles mentioned.

282. The MLD was therefore right to consider that Art. 34 UPCA did not exclude its jurisdiction over the UK designation of the Patent.

283. The CJEU has recognised that the Br I bis Regulation should be applied consistently with international law principles including comity.

284. Even though it is true that rules and principles of general international law are binding upon the EU institutions and form part of the EU legal order and that the Br bis Regulation must be interpreted in the light of those rules and principles (*BSH v Electrolux*, para. 68-69), and also that this equally applies to the UPCA (Art. 20 UPCA), this does not lead to the conclusion that the MLD wrongly accepted jurisdiction to hear the case in relation to the UK part of the Patent.

285. Where a court has jurisdiction under Article 4 Br I bis because the defendant is domiciled in its territory, as is the case in the present proceedings, the Regulation precludes that court from declining jurisdiction on the ground that a court of a non-Member State would be a more appropriate forum for the trial of the action, even if the jurisdiction of no other Member State is in issue, or the proceedings have no connecting factors to any other Member State (CJEU, judgment of 1 March 2005, Owusu, C-281/02, ECLI:EU:C:2005:120, paras 36 – 46).

286. The MLD applied Article 4 Br I bis correctly by not denying jurisdiction to hear the alleged infringement of the UK designation of the patent.

287. This approach has recently been endorsed by the CJEU in *BSH v Electrolux*. In that judgment it ruled that Article 24(4) Br I bis does not apply to a court of a third State, such as the UK, and "consequently, as not conferring any jurisdiction, whether exclusive or otherwise, on such a court as regards the assessment of the validity of a patent granted or validated by that State".

Furthermore, the CJEU ruled that "If a court of a Member State is seised, on the basis of Article 4(1) of that regulation, of an action alleging infringement of a patent granted or validated in a third State in which the question of the validity of that patent is raised, as a defence, that court has jurisdiction, pursuant to Article 4(1), to rule on that defence, its decision in that regard not being such as to affect the existence or content of that patent in that third State or to cause the national register of that State to be amended" (para 76).

Accepting jurisdiction is not incompatible with the TRIPS Agreement.

288. Kodak's argument that this would be contrary to the TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights, signed in Marrakesh, Morocco on 15 April 1994) cannot be accepted. Kodak refers to the WTO appeal in case DS611 between the EU and China, published on 21 July 2025, concerning China's policy of granting anti-suit injunctions against SEP holders. Kodak argues that a TRIPS Member court would inevitably risk undermining the protection and enforcement of IP rights implemented by the other TRIPS Member in its territory by either (i) imposing inappropriate relief in the territory of that other Member or (ii) not granting the relief actually due in the territory of that other Member, and either way potentially preventing the proper and proportionate enforcement of patent rights in the other Member's territory due to res judicata issues.

289. Kodak also referred to the reasoning of the MLD in the *InterDigital v Amazon* proceedings (MLD 30 September 2025, UPC_CFI_936/2025), where it held that the determination of an interim licence encroaches on the patent rights of EU Member States and on the judicial sovereignty of other states.

290. These arguments must also be dismissed.

291. Accepting jurisdiction in the infringement action vis-à-vis a defendant domiciled in the UPC's territory based on Art. 4 Br I bis as such cannot be considered contrary to the TRIPS Agreement. The CJEU has clarified in *BSH v Electrolux* that a court which has jurisdiction to hear an infringement action under Article 4 Br I bis does not subsequently lose that due to a later invalidity defence (para 41). Kodak is right in saying that the UK courts have taken a different approach to this, but it is the case law of the CJEU that binds the UPC, not that of the courts of the UK. Accepting jurisdiction if and when conferred on it by Article 4 Br I bis, must be distinguished from how this jurisdiction is subsequently exercised by the Court in view of all the circumstances of the case.

There is no pleaded case of infringement in the UK

292. Kodak argues that in the present case Fujifilm failed to bring a plausible allegation and reliable facts that each of the Kodak companies carries out infringing acts in the UK.

293. This argument is rejected.

294. The jurisdiction concerning the action against the Kodak companies follows from the fact that they are domiciled in a Contracting Member State of the UPCA, namely Germany (Article 4 in conjunction with Article 63 and Article 71b(1) of Br I bis). Jurisdiction pursuant to these provisions is not limited to acts of the defendant within the UPC territory. The connection with the UPC territory is established by the domicile of the defendant, and not the location where the acts of the defendant occurred. Accordingly, contrary to the view expressed by Kodak, it is not necessary to examine the plausibility of any acts committed by the Kodak companies in the UK for the purposes of establishing jurisdiction in respect of them (UPC_CoA_789 and 813/2025 of 6 March 2026, *Dyson v Dreame,* para. 12).

295. Kodak's argument that the patent (also as amended) is invalid is a matter to consider when deciding on the substance of the infringement action, not when establishing jurisdiction.

296. Similarly, arguments as to whether it is more appropriate for the UK courts to apply UK law on damages and consider matters of UK public policy, have rightly not been taken into account by the MLD when determining whether it had jurisdiction over the infringement of the UK designation of the Patent by the Kodak companies. Contrary to Kodak's submission, this is not required by *BSH v Electrolux*.

The patent in suit has not been accepted to be invalid as granted in the UK

297. Kodak's argument that by unconditionally amending the German designation of the Patent during the course of the proceedings, Fujifilm has accepted that the unamended patent is invalid, cannot be accepted in its generality. Fujifilm has relinquished its right to the patent as granted, but it may have done so for several reasons. It does not necessarily follow that Fujifilm accepts that it was invalid. It therefore also does not follow that Fujifilm lost its patent rights in the UK, let alone its right to at least the limited protection which Fujifilm has proposed and which is held valid. UK law has implemented Art 138(2) EPC under which a patent is only invalidated insofar as it is invalid.

298. Neither are any formal requirements in the UK that have to be fulfilled prior to an amendment of a patent claim relevant to accepting jurisdiction to hear the infringement action and they do not prevent that the UPC Courts may evaluate the validity arguments as a defence in view of the infringement allegations in inter partes proceedings.

The MLD was not wrong not to stay or dismiss the case

299. As considered above, accepting jurisdiction if and when conferred on it by Article 4 Br I bis, must be distinguished from how this jurisdiction is subsequently exercised by the Court in view of all the circumstances of the case. A decision to stay or dismiss can only be made once jurisdiction has been accepted.

Conclusion on accepting jurisdiction

300. From the above considerations, it follows that the MLD was right to accept jurisdiction vis-à-vis the Kodak companies in relation to the alleged infringement of the UK designation.

Exercising jurisdiction

301. A court which has jurisdiction to hear an alleged infringement of a patent validated outside of its own territory, is not only required to apply the law applicable to that patent, but must also apply international law principles such as comity.

Principles

302. In situations where the Court has jurisdiction to decide on the alleged infringement and remedies requested by the patentee based on a non-UPC designation of a European patent (EP), and where the defendant has – as a defence – asserted that the EP relied on is invalid, then:

- where designations in the territories of Members States of the European Union (EU) and Signatories to the Lugano Convention (LC) are concerned ('EU/LC EPs'), it follows from Art 24(4) Br I bis and Art. 22(4) LC that the Court shall not consider the validity of such patents, but as decided in *BSH v Electrolux* the Court does not lose jurisdiction to decide the infringement action based on such patents;

- where designations in territories of non-EU and non-LC States are concerned ('non-EU/LC EPs'), it follows from *BSH v Electrolux* that the Court can consider the validity of such patents in *inter partes* proceedings and the Court may on that basis decide the infringement action based on such patents.

303. The Court of Appeal considers the following approach regarding actions based on EU/LC European patents and/or non-EU/LC European patents to be in line with *BSH v Electrolux* and international principles of law, including comity, for the following situations (I, II and III respectively):

I. a revocation action is lodged with the Court with respect to (a) EU/LC EP(s) and/or non-EU/LC EP(s)

304. The Court shall declare that it lacks jurisdiction to decide the action.

II. in an infringement action which is also based on (a) EU/LC EP(s) and/or non-EU/LC EP(s), and the patent in force in the UPC territory is considered <u>invalid</u>, but the attacked embodiment or process would <u>infringe</u> if it were valid

305. It will be appropriate for the Court to first offer the patentee the opportunity to withdraw the infringement action insofar as based on (a) EU/LC EP(s) and/or non-EU/LC EP(s) within an appropriate period of time.

306. Where it concerns EU/LC EPs:

a. if the patentee does not wish to withdraw the infringement action, and insofar a revocation action is not already pending with the relevant competent national court(s), it is appropriate to give the defendant the opportunity to file a revocation action with the relevant competent national court(s) within an appropriate period of time.

b. if and to the extent that (a) revocation action(s) is pending, or the defendant has lodged such action(s), it is generally appropriate for the Court to use its discretion and/or case management powers (cf R. 295(l) and (m) RoP) to stay the infringement proceedings insofar as based on that EU/LC EP(s) until a final decision has been rendered in the revocation action(s) by the competent national court(s).

c. if and to the extent that the defendant does not lodge such action(s) within the given time period, the Court must assume that the patent(s) is/are valid and shall decide the infringement action on that basis.

307. Where it concerns non-EU/LC Eps:

a. if the patentee does not wish to withdraw the infringement action, the infringement action shall be dismissed, unless there are specific reasons not to do so (e.g. because the claim(s) of an extra-territorial part is different and may be considered valid – in such a situation the next paragraph applies)

III. in an infringement action which is also based on (a) EU/LC EP(s) and/or non-EU/LC EP(s), and the patent in force in the UPC territory is considered <u>valid</u> and <u>infringed</u> in the UPC territory

308. Where it concerns either EU/LC EPs (in view of Art. 24(4) Br I bis and 22(4) LC) or non-EU/LC EPs (in view of comity):

a. the Court may – where appropriate and in order to avoid undue delay – consider there is a reasonable, non-negligible possibility that the patent will be held valid by the competent national court and issue a decision including its orders under the condition subsequent that the patent is not held to be wholly or partially invalid to the extent the infringement is based thereon in first instance or appeal proceedings before the national court competent to hear the revocation case in relation to such an EP (R. 118.2 RoP and Solvay v Honeywell (C-616/10) *mutatis mutandis*).

b. if such a competent national court holds the patent to be valid, then the decision including its orders stays in place with the condition subsequent; if the decision is final, the injunction becomes permanent.

c. if such a competent national court at first instance or on appeal holds the patent to be wholly or partially invalid to the extent the infringement is based thereon then the condition under which the decision, including its orders, was issued is not fulfilled and it falls away.

d. In the case under c. the patentee may request the Court for orders consequential on such a decision within two months of the decision of such a competent national court (R. 118.4 RoP), including a request for a stay of the proceedings until a final decision is rendered by the competent national court.

Alleged infringement of the UK designation

309. Pursuant to Article 8 of Regulation 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations, OJ L 199, 31.7.2007, pp. 40–49 (Rome II), in conjunction with Art. 24(2)(a) UPCA, whether the UK designation of the Patent is infringed is a matter of substantive law of the jurisdiction of its registration. Thus, UK law applies to this question.

310. In the 'Responsibility of the defendants' section of the SoC Fujifilm stated that "all three defendants are responsible for production, offering, selling and placing on the market of the infringing embodiments". To this end it referred to the audited financial statements of Kodak Holding (submitted by Fujifilm as Exh. K3) and stated amongst other:

a. Kodak GmbH acts as the German sales company which purchases the Kodak products from the UK Kodak company, Kodak Ltd., Watford, UK, and sells them in Germany.
b. Kodak Graphic operates under a toll manufacturing agreement as a contract manufacturer of printing plates for a UK entity of the Kodak Group, Kodak Ltd., Watford, UK, which is in charge of the distribution across Europe.
c. According to the information in the German commercial register, the business purpose of Kodak Holding is, inter alia, the acquisition and management of shareholdings in and management of other companies in Germany and abroad.

311. Fujifilm stated that the involvement of Kodak Graphic follows from the fact that its address is mentioned on the packaging of the Sonora Xtra-3 plates, as well as "Made in E.U." and that Kodak Graphic knows that the attacked embodiments are destined for the European market.

312. Kodak GmbH is linked to the manufacturing process because its name is shown together with the address of Kodak Graphic in a brochure of the Sonora X plates, which is said to be in line with its business purpose according to the financial statements K3.

313. Fujifilm advanced that Kodak Holding is linked to the alleged infringing activities of Kodak Graphic, because Kodak Holding controls the Kodak Graphic by virtue of that being a wholly owned subsidiary, such that it is also responsible for the business decisions of Kodak Graphic.

314. Only in its Reply Fujifilm submitted a declaration on UK law (Exh. K39) with a report by Mintz Group annexed thereto, which states – based on information provided by a customer of the UK based Kodak company Kodak Ltd – that there are direct shipments from Kodak Graphic to UK customers and that title to the plates shifts to the customer upon arrival at the premises of the customer. In addition, Fujifilm submitted a press release (Exh. K40) dated 12 October 2023 which suggests that Kodak Graphic supplies the attacked embodiments directly to customers throughout Europe.

315. The Court does not have to decide on Kodak's objection that these statements were filed too late and should have been disregarded. Kodak rightly argues that Fujifilm failed to substantiate an infringement of the UK designation of the Patent.

Importing into the UK

316. Kodak has rightly commented that the facts brought forward by Fujifilm do not support an allegation of infringement of the UK designation of the Patent.

317. Fujifilm accepts that under UK law, pursuant to section 60(1)(a) Patents Act 1977, importing a product embodying the invention into the UK is an infringing act, and that the importer is the party who has legal and beneficial interest in the goods.

318. On page 11 of the financial statements (Exh. K3) it is stated:

Activity as a contract manufacturer of printing plates and production of chemicals for production

KGC's main business activity is the manufacture of digital printing plates at the Osterode am Harz plant. Production takes place as a service within the framework of toll manufacturing or consignment manufacturing for the principal Kodak Ltd. KGC receives a toll fee for this service. All raw materials used in production, as well as semi-finished and finished products, are owned by the principal. Auxiliary materials and supplies are provided by KGC.

From this it is clear that it is – and remains – Kodak Ltd that holds title to the attacked embodiments, prior, during and after Kodak Graphic's manufacturing activities. As such, it is Kodak Ltd and not Kodak Graphic that is importing the attacked embodiments into the UK. The fact that it is Kodak Graphic that is arranging for the transport of the attacked embodiments to the UK does not alter that. The decision of the England and Wales Court of Appeal [2002] EWCA Civ 976, *Sabaf v MFI*, para. 61, referred to by Fujifilm, confirms this. In that case the manufacturer and seller Meneghetti, after the sale of the goods 'ex works' and thus after transfer of title to MFI, arranged for the transfer of the goods into the UK on MFI's behalf. The Court held that:

> "*In these circumstances it is an odd use of words to say that Meneghetti "imported" the goods. Although it made the relevant contract of carriage, it itself had no ultimate interest in the goods. It only arranged the transportation at MFI's request and it would be paid in any event. It would be more usual to describe as importer the party who had the legal and beneficial interest in the goods, viz. MFI. In any real sense, if property and risk pass to the buyer before or at the beginning of the carriage, the contract of carriage is made on behalf of the buyer even if it is the seller who agrees that he will make the contract*."

Logically, the same must apply where the manufacturer who never had title arranges for the transport of the attacked embodiments to the UK on behalf of Kodak Ltd who retained title.

319. Fujifilm has requested (in its Reply, repeated on appeal) that Kodak be ordered to submit the toll manufacturing agreement into the proceedings according to Art. 59 UPCA, R. 190 RoP. This

must be denied. Fujifilm has not provided any reason why the correctness of the statement regarding the retention of title by Kodak Ltd in the audited financial statements of Kodak Holding should be questioned. Requesting its production amounts to a fishing expedition.

320. Fujifilm also cannot complain that Kodak did not refer to the retention of title by Kodak Ltd as evidenced by the financial statements until its Rejoinder. Fujifilm, who submitted the financial statements with its Statement of claim and also specifically referred to page 11 thereof, where this is mentioned, should have acknowledged and anticipated on this itself when it decided to lodge its infringement action.

321. It follows that Kodak's complaint against the MLD's conclusion that Kodak had not contested with substantiation Fujifilm's allegations that Kodak Graphic holds title to the plates before transfer to a distributor in the UK succeeds. There is no need to rely on the witness statement filed on appeal by Kodak about the retention of title and therefore no need to decide whether this was late filed.

322. Neither the Mintz report nor the press release referred to by Fujifilm (Exh. K40) can lead to another conclusion. In view of the retention of title by Kodak Ltd, the reference therein to deliveries by Kodak Graphic clearly refers to the actual transport arrangements being made by Kodak Graphic on behalf of Kodak Ltd, not to the legal and beneficial ownership of the attacked embodiments at the time of their import into the UK.

323. On appeal, Fujifilm asserts that Section. 950 (1) sentence 1 of the German Civil Code leads to a transfer of ownership to Kodak Graphic. This provision, in English translation, reads as follows:

> "Anyone who manufactures a new movable item by processing or transforming one or more materials acquires ownership of the new item, unless the value of the processing or transformation is significantly lower than the value of the material."

This argument cannot succeed. Under German case law 'manufacture' in Section 950 of the German Civil Code (BGB) does not mean processing or transforming the material oneself. Rather, the prevailing view in legal literature considers the principal of the processing or transformation process as the manufacturer. Consequently, a person who has a material processed into a new item under a contract for work may be regarded as the manufacturer (Federal Court of Justice, 4th Senate, 28 June 1954; BGB RGRK 10th ed., note 5 on § 950, p. 307). It is thus Kodak Ltd who must be considered to be the manufacturer under this provision. Consequently, no legal title passes to Kodak Graphic.

Joint tortfeasorship

324. Fujifilm in its Reply also argued that even if Kodak Graphic is not directly infringing the UK designation of the patent, it would be liable as a joint tortfeasor.

325. It is not entirely clear from the statement on UK law submitted by Fujifilm, which states (para. 12) "Even if a defendant is not liable as a primary infringer under s.60 of the Act in the UK, they may nevertheless still be liable for patent infringement under UK law if they are held to be a joint tortfeasor" whether under UK law joint tortfeasorship must be considered as a patent infringement, or whether this is a tort under common law (as indeed suggested in *Lifestyle Equities CV v Ahmed* [2024] UKSC 17 para. 135). Whichever is the case, it is not relevant to the jurisdiction of the UPC. As the Court of Appeal held in *Belkin v Philips* (UPC_CoA_534/2024, of 3 October 2025) an "infringer" within the meaning of Art. 63 UPCA in conjunction with Art. 25 UPCA is also a person who does not personally carry out the acts referred to in Art. 25 UPCA but to whom the acts of a third party are attributable because he is an accessory. The jurisdiction of the UPCA under Art.

32.1(a) UPCA to hear actions for patent infringement therefore extends to allegations of joint tortfeasorship.

326. Under UK law, merely supplying outside the jurisdiction goods to a party in the UK who later sells them within the jurisdiction is not enough for joint tortfeasorship, even if the supplier knows his customer intends so to sell in the UK (*Generics v Lundbeck* [2006] EWCA Civ 1261, para. 25). As Fujifilm acknowledges, joint tortfeasorship arises when multiple entities jointly commit a tort by acting pursuant to a common design.

327. As is clarified in *Lifestyle*, even though liability for patent infringement is strict and does not require any awareness of its unlawfulness, for a person to be liable as a joint tortfeasor it is necessary to show (1) that he had procured the company to infringe or been joined in common design with the company; and (2) knew of the essential facts which make the act done wrongful (because a person cannot be allowed to escape liability by relying on ignorance of the law it, knowledge of patent infringement cannot be required). As such, knowledge of the existence of the UK designation of the Patent and that the attacked embodiments disclose all the features of the claim(s) of the Patent would be required. Since this would have required knowledge of FE-SEM measurements, it is not evident – and Fujifilm has not shown – that such knowledge actually existed with any of the Kodak companies prior to Fujifilm's allegation that the attacked embodiment infringes the UK designation of the Patent.

328. Given that there is no finding of infringement of the UK designation of the Patent, Kodak's submissions regarding comity and Kodak's objections in respect of the remedies ordered by the MLD do not require consideration.

The initial Order should not have been rectified in respect of the counterclaim

329. Kodak has objected to the rectification order of 5 September 2025 in which the MLD ordered that "the decision of the Local Division Mannheim, dated 18 July 2025, UPC_CFI_365/2023, is rectified in its operative part to the effect that, after point C., the following new point D. is inserted and the original point D. is renumbered as point E. and in consequence point E. is renumbered as point F. "D. The Defendants' request to declare that the EP 3 511 174 B1 (UK) is also invalid in its entirety is dismissed."

330. R. 353 RoP provides that "the Court may rectify a decision or order where such rectification concerns "clerical mistakes, errors in calculation and obvious slips". Kodak submits that its purpose is to ensure that the final written order accurately reflects the decision that the Court actually made and intended to record. For substantive errors, including the Court's failure to rule on a particular claim, the proper and exclusive remedy is an appeal.

331. Kodak argues that the omission of an order dismissing the counterclaim in this case was not an "obvious slip", because the MLD did not express any conclusion on its merits in the reasoning. As such, the rectification order did not correct the external expression of the Decision, but rather altered its very formation and therefore the rectification order exceeded the Court's jurisdiction under R. 353 RoP.

332. Kodak cannot be followed. It is clear from the impugned decision that the MLD considered that it did not have jurisdiction to decide on the validity of the UK designation of the Patent other than as a defence to the infringement allegation. As such, the rectification had basis in the impugned decision.

The counterclaim should not have been dismissed (because the condition was not fulfilled)

333. Kodak has, however, rightly objected to the dismissal of the counterclaim, since (upon close reading) it only conditionally requested a decision that the UK designation is also invalid in its entirety, namely "on the basis that 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 UK designation of the Patent in line with the decision to be handed down by the Court, a decision that the UK designation is also invalid in its entirety". It is undisputed that this condition has not been fulfilled. The rectification order must therefore be set aside.

Requests

334. The above leads to the conclusion that the impugned decisions shall be set aside.

335. Fujifilm's requests in the infringement action must be dismissed, both for the German and UK designation.

336. Kodak's request for an order that Fujifilm compensate Kodak for any injury caused by the enforcement of the impugned decisions shall be granted. The requested part "including without limitation those arising from business changes and disruption, opportunity costs, reputational injury and penalties" shall be dismissed. This is something for the Court to decide in proceedings pursuant to R. 125 RoP to be initiated by Kodak.

337. Fujifilm's request to amend the patent shall be granted.

338. Kodak's requests in the counterclaim for revocation are not successful and shall be dismissed.

Costs

339. In the impugned decision of 2 April 2025 relating to the German designation of the Patent, the value of the dispute was set to € 15.000.000. In that decision, as well as the impugned decision of 18 July 2025 relating to the UK designation, Kodak was ordered to bear the costs of the litigation.

340. There is no need to consider Kodak's objections against these decisions, in view of the different outcome on appeal.

341. Since the decisions insofar as the infringement action is concerned shall be set aside, and the requests denied, Fujifilm is the unsuccessful party in the infringement action, both concerning the German and the UK designation. It shall be ordered to bear Kodak's costs of litigation in those actions both at first instance and on appeal. On the other hand, Kodak has been unsuccessful in its objection to the Court's jurisdiction to hear the infringement of the UK designation. In addition, Kodak is unsuccessful in the counterclaim for revocation concerning the German designation and the condition under which the counterclaim for revocation concerning the UK designation has not been fulfilled. Kodak shall be ordered to bear Fujifilm's costs of litigation in the Preliminary objection and the Revocation action, both at first instance and on appeal.

342. The Court does not see reason to adjust the value of the dispute.

DECISION

The Court of Appeal:

in UPC_CoA_312/2025 and UPC_CoA_333/2025

A. sets aside the impugned decision of 2 April 2025;

B. rejects Fujifilm's requests in the infringement action;

C. allows Fujifilm's unconditional request to amend claim 1 of the German designation of the Patent as granted, revokes claim 1 as granted and upholds it in amended form as follows:

> A lithographic printing plate precursor comprising:
> an aluminum support; and
> an image recording layer on the aluminium support,
> wherein the aluminium 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 colour former.

D. rejects Kodak's requests in the counterclaim for revocation;

E. orders Fujifilm to compensate Kodak for any injury caused by the enforcement of the impugned decision in the infringement action;

F. dismisses all further requests;

G. sets the value of the dispute at EUR 15,000,000;

H. orders that Fujifilm shall bear the costs of litigation in the infringement action, both at first instance and on appeal;

I. orders that Kodak shall bear the costs of the revocation action, both at first instance and on appeal;

in UPC_CoA_880/2025 and UPC_CoA_882/2025:

J. sets aside the impugned decision of 18 July 2025;

K. sets aside the rectification order dated 5 September 2025;

L. dismisses Fujifilm's requests in the infringement action;

M. declares that the condition under which Kodak's counterclaim for revocation was filed was not fulfilled;

N. orders Fujifilm to compensate Kodak for any injury caused by the enforcement of the impugned decision in the infringement action;

O. orders that Fujifilm shall bear the costs of litigation in the infringement action, both at first instance and on appeal;

P. orders that Kodak shall bear the costs of the objection to the Court's jurisdiction, both at first instance and on appeal.

Issued on 2 June 2026

Rian Kalden

Date: 2026.06.02 07:46:28 +02'00'

Rian Kalden, presiding judge and judge-rapporteur

Patricia Ursula Rombach

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Date: 2026.06.02 07:22:06 +02'00'

Patricia Rombach, legally qualified judge

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Ingeborg Simonsson, legally qualified judge

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Lorenzo Parrini, technically qualified judge

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Max Tilmann, technically qualified judge

SARA MARIA BEIRES MOREIRA DE ALMEIDA

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Sara Almeida on behalf of the Registry