

**DECISION**  
**of the Court of Appeal of the Unified Patent Court**  
**issued on 13 July 2026**  
**concerning EP 3 476 616 (DE and UK designations)**

HEADNOTES

1. A claimant is required to indicate the extent to which revocation of the patent is requested and is required to sufficiently substantiate this request for each of the claims covered by its request (see R. 25.1(a)-(d) RoP).
2. It follows from R. 29A(c) RoP that where the patentee requests that claimant's request for revocation of several or all claims of the patent is rejected, he is required (whether or not as a subsidiary defence) to identify in a sufficiently substantiated manner which dependent claims it considers to be valid should the independent claim be held invalid (see R. 29A(a)-(c) RoP).
3. If the patentee wishes to rely on a combination of dependent claims that does not directly and specifically follow from their wording, such as where the dependent claims rely on several or even any of the previous claims, the patentee should clearly indicate which combination(s) it considers to be valid, (also) in the language of the patent, should the independent claim be held invalid.
4. It follows from the principles of due process – in a similar manner as provided for in R. 30.1 (c) RoP – that the number of such combinations that the patentee wishes to rely on must be reasonable in number, considering the circumstances of the case.
5. R. 30 RoP does not require that the patentee submit an auxiliary request as a prerequisite for defending dependent claims. An Application to *amend* the patent is only required if the patentee wishes to maintain its patent with amended wording, i.e. deviating from the wording of the claims as granted, or proposes combinations of dependent claims not explicitly included therein, thereby limiting the scope of the patent as granted. This is not the case where a patentee merely defends the dependent claim(s), including combination(s) already encompassed thereby.
6. If there is no pointer to combine a reasonable starting point with another document, a motivation to take the next step in the direction of the invention cannot be derived from the content of such a combination document itself. Failing a motivation for the skilled person to consult a document it will not become aware of its content, and it cannot be concluded that the skilled person would implement the missing feature disclosed therein.
7. It is not appropriate and proportionate to impose a penalty in case of non-fulfilment of an enforceable monetary obligation.

8. A publication of an own declaration by the infringer on its webpage pursuant to Art. 80 UPCA is justified only in the event of special circumstances which call for such a publication as corrective measure due to ramifications of an infringement which cannot be undone or sufficiently compensated otherwise.

#### KEYWORDS

Reliance on dependent claims, novelty, inventive step, direct and indirect infringement, private prior use, international jurisdiction, remedies.

#### APPELLANT (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

#### RESPONDENTS (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

#### PATENT AT ISSUE

EP 3 476 616

#### 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, legally qualified judge

Max Tilmann, technically qualified judge

## IMPUGNED DECISIONS OF THE COURT OF FIRST INSTANCE

In the main proceedings UPC\_CFI\_359/2023,

- in ACT\_578818/2023 (infringement action),
- in CC\_3094/2024 (counterclaim for revocation)

all issued by the Mannheim Local Division on 2 April 2025.

In the main proceedings UPC\_CFI\_359/2023,

- on the UK designation of the patent issued by the Mannheim Local Division 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 4 September 2025.

## ORAL HEARING

30 March 2026

## SUMMARY OF FACTS

### *The parties*

1. Fujifilm is a manufacturer of *inter alia* lithographic plates.
2. 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 Graphic and its legal predecessor, respectively, own and operate a manufacturing facility in Germany as contract manufacturer of printing plates for said UK entity. 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*

3. 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.
4. In UPC\_CFI\_359/2023, the MLD by its decision of 2 April 2025 in the revocation action revoked the Patent in its entirety in the territory of Germany (the only Contracting Member State where EP 3 476 616 was still in force) and dismissed the infringement action.
5. Fujifilm has appealed this decision for both the infringement action and the counterclaim for revocation (UPC\_CoA\_473/2025 and UPC\_CoA\_474/2025 respectively).
6. In its decision of 18 July 2025, the MLD held it has jurisdiction to decide on the UK part of the Patent in accordance with the CJEU judgment of 25 February 2025 (C-339/22, *BSH v Electrolux*). The MLD found the invalidity defence raised in relation to the UK part of the Patent to succeed and dismissed the infringement action in relation to the UK territory.
7. Fujifilm has appealed this decision for both the infringement action and the counterclaim for revocation (UPC\_CoA\_873/2025).

8. Kodak also appealed this decision in both actions (UPC\_CoA\_881/2025).

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

|                              |               |                                                                                                                                                                      |
|------------------------------|---------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| On appeal:                   | SoGA          | Fujifilm Grounds of appeal as filed on 15 August 2025                                                                                                                |
|                              | SoR           | Kodak Statement of response as filed on 1 December 2025                                                                                                              |
|                              | FFP           | Fujifilm Further pleading as filed on 20 January 2026                                                                                                                |
|                              | KFP           | Kodak Further pleading as filed on 3 February 2026                                                                                                                   |
| At 1 <sup>st</sup> instance: | SoC           | Fujifilm Statement of claim of 10 October 2023                                                                                                                       |
|                              | SoD           | Kodak Statement of defence and Counterclaim for revocation of 12 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 10 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 30 October 2024 |
|                              | R30-Rejoinder | Kodak Rejoinder to the Reply to the Defence to the Application to amend the patent of 6 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 (also collectively referred to as 'the Sonora plates' or 'the attacked embodiments') fall within the scope of among other claims 1, 2, 3, 6 and 7 of the Patent and are means relating to an essential element of the subject-matter of claims 13 and 14 of the Patent.
11. Summarised, Fujifilm requested a declaration of infringement, permanent injunction, subject to a penalty in case of non-compliance, a right to prevent the indirect use of the invention, 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 requested that Kodak's request for an enforcement security be dismissed.
12. Kodak disputed that the Sonora plates are directly or indirectly infringing the Patent. It asserted that the Sonora Xtra 3 plate does not have micropores as claimed and that the infringement allegations are inconclusive because the AFM measurements relied on were not carried out using the resolution as prescribed by 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 claim 6 of the patent extends 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 T9) and/or US 4 566 952 A (US'952, Exh. T22); that the Patent lacks inventive step starting from EP 2 878 452 A1 (EP'452, Exh. T41) or JP 2015-189021 A (JP'021, Exh. T42) or EP 2 594 408 A1 (EP'408, Exh. T2) in combination with common general knowledge inter alia as evidenced in EP 1 557 262 B1 (EP262, Exh. T36), EP 1 614 541 A2 (EP'541, Exh. T37), JP H08-144090 A (JP'090, Exh. T38) and EP 2 839 968 (EP'968, Exh. T39).
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.

### *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 regarding the UK designation of the Patent.

### *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 before 1 June 2023) and considered the German designation of the Patent to be invalid, which could not be remedied by the auxiliary requests. The MLD held reliance on the dependent claims to be inadmissible, since these were not included in the R.30 RoP application. The MLD dismissed Kodak's preliminary objection and considered the UK designation of the Patent to be not infringed in view of the successful validity defence.
19. The MLD consequently revoked the Patent in its entirety in the territory of Germany, dismissed the application to amend the patent, as well as the infringement action in relation to the German and UK designations. Fujifilm was ordered to pay to Kodak an amount of EUR 300.000 as an interim award on the legal costs and other expenses and ordered Fujifilm to bear the costs of the proceedings.

### *Appeal from the 2 April 2025 decisions (German designation) and the 18 July 2025 decision (UK designation)*

20. On appeal, Fujifilm relies on the Patent as in force after limitation proceedings pursuant to Art. 105b(2) EPC – according to which the amended claim 1 comprises claims 1, 2 and 7 of the originally

granted claims, and which is the same as auxiliary request 1 – and 8 further new auxiliary requests (ARs). Fujifilm did not pursue the ARs filed at first instance.

21. In the infringement action, Fujifilm requests that the impugned decision be set aside, that – in summary – the relief requested at first instance with regard to the German and the UK territories be granted, all orders subject to the payment of a penalty of EUR 30,000 per day of non-compliance after 30 days after the order becomes enforceable, and that Kodak be ordered to bear the costs of the proceedings in both instances.
22. In the revocation action Fujifilm requests that the counterclaim be dismissed in its entirety and as a subsidiary request – as far as the German designation is concerned – to amend the Patent according to and in numerical order of the ARs. Further, Fujifilm requests that the value of the proceedings be set at EUR 10 million for the appeals (including the infringement action and counterclaim for revocation), and that Kodak be ordered to reimburse Fujifilm's costs of the proceedings and to bear the costs of the proceedings in both instances.
23. Kodak requests that the appeals be dismissed and the Patent be revoked in its entirety with effect for the territory of Germany, and that Fujifilm be ordered to pay the costs of the proceedings at both instances. In the alternative and further alternative, should the ARs be held to be admissible, (in short) to dismiss the claims in the infringement action. In the even further alternative, in case it would be held to provide information, it requests that such information be classified and treated as confidential and be deleted after a certain time period.
24. Kodak procedurally requests that Fujifilm's ARs be dismissed as late filed.

*Kodak's appeal from the 18 July 2025 decision and 4 September 2025 rectification order (UK designation)*

25. 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, 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.
26. Fujifilm requests the dismissal of the appeal and an order that Kodak must bear all costs of the proceedings.

*The patent at issue*

27. The Patent relates to a lithographic printing plate precursor, a method for manufacturing, and a printing method.
28. 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 14 July 2021.

It was filed on 31 May 2018, claiming the priority of Japanese patent applications of 31 August 2017 and of 19 March 2018.

29. Claims 1, 2, 3, 6 and 7 of the Patent as granted read as follows in the language of the patent:

“1. A lithographic printing plate precursor comprising:

- (i) an aluminum support including an aluminum plate and, formed thereon, an anodized film of aluminum, and
- (ii) an image recording layer,

wherein the anodized film

- is positioned closer to the image recording layer than the aluminum plate,
- has micropores extending in a depth direction of the anodized film from a surface of the anodized film on the image recording layer side, the micropores have an average diameter of 15-100 nm at the surface of the anodized film, each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth of 10-1000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20-2,000 nm from a communication position between the small-diameter portion and the large-diameter portion, the aperture average diameter of the large-diameter portion at the surface of the anodized film is 15-100 nm, and that of the small-diameter portion at the communication position is  $\leq 13$  nm; and
- has a surface on the image recording layer side having a lightness  $L^*$  of 70-100 in a  $L^*a^*b^*$  color system.

2. The lithographic printing plate precursor of claim 1, wherein the steepness  $a_{45}$  representing an area ratio of portions having an inclination of  $\geq 45^\circ$  at the surface of the anodized film on the image recording layer side as determined by extracting components with a wavelength of 0.2-2  $\mu\text{m}$  is  $\leq 30\%$ .

3. The lithographic printing plate precursor of claim 2, wherein the steepness  $a_{45}$  is  $\leq 20\%$ .

6. The lithographic printing plate precursor of any of claims 1-5, wherein the specific surface area  $\Delta S$  is  $\leq 20\%$ ,  $\Delta S$  being a value determined by the formula  $\Delta S = (S_x - S_o)/S_o \times 100(\%)$  (i), using an actual area  $S_x$  obtained, through three-point approximation, from three-dimensional data acquired by measurement at 512 x 512 points in 25  $\mu\text{m}$  square of the surface of the anodized film on the image recording layer side by means of an atomic force microscope and a geometrically measured area  $S_o$ .

7. The lithographic printing plate precursor of claim 6, wherein  $\Delta S$  is 20-40%

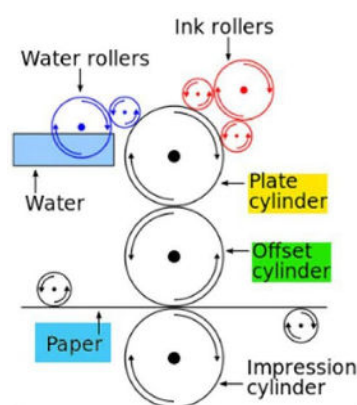
30. The independent procedural claims protect corresponding methods of manufacturing a lithographic printing plate (claim 13) and for printing with that plate (claim 14), with a specification indicating the printing plate being of an on-press development type.

### *Technical background of the Patent*

31. 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. 18-23.

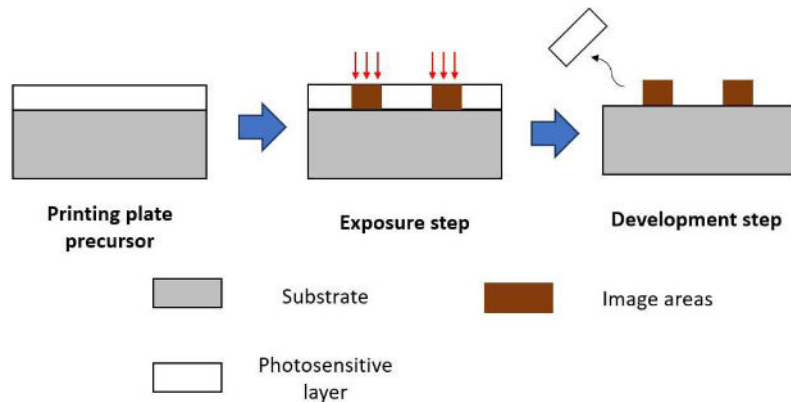
#### *Lithography and offset printing*

32. 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).
33. 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.



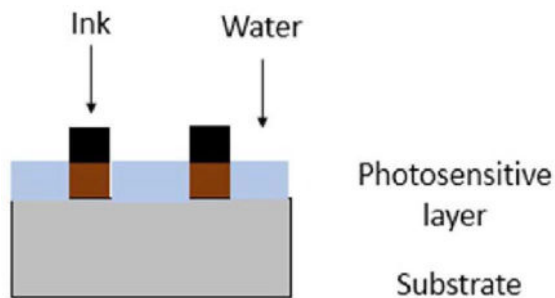
#### *Preparation of the printing plate by exposing and developing a plate precursor*

34. 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).
35. 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.
36. In a simplified overview, the production of a printing plate from a precursor can be summarized as follows.



### *Printing process*

37. 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.



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

### *On-press development*

39. 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.
40. 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.
41. When using on-press development, printers must be able to verify the accuracy and alignment of the image, before mounting the plate on the press. For that purpose, colour formers are conventionally used in the image recording layer, which change colour upon exposure, producing a visible print-out image.

### *The patent description and the technical problem*

42. The patent relates to a lithographic printing plate precursor, a lithographic printing plate manufacturing method, and a printing method.

43. According to the description of the patent-in-suit, lithographic printing plates can be obtained through the CTP (computer-to-plate) technology (para. [0002]).
44. State of the art lithographic printing plate precursors use a lithographic printing plate support including an anodized film having predetermined micropores. Well-known micropores have a large-diameter portion and a small-diameter portion, both of which have a predetermined shape, which includes a specific depth and/or a specific average diameter (para. [0003]).
45. The lithographic printing plates formed from such printing plate precursors are required to have further improved image visibility (visibility of an image portion) and a long press life (para. [0005] to [0007]).
46. Against this background, the technical problem the Patent seeks to solve is to provide a lithographic printing plate precursor that enables a lithographic printing plate formed therefrom to have excellent image visibility and a long press life (paras. [0008]). The printing plate precursor of the invention also has excellent scumming resistance and deinking ability (para. [0018], [0040], [0048]).
47. Image visibility refers to the visibility of an image portion of a lithographic printing plate (para. [0005]).
48. Press life relates to the duration of use without critical loss of quality and is evaluated by the number of impressions at the time when, after continuous printing, the decrease in density of a solid image became visually recognizable (para. [0369]).
49. Scumming resistance means the resistance to stains and is evaluated by the degree of staining after 10.000 impressions (para. [0370]). It is undisputed that scumming is a defect in offset lithography that occurs when the image recording layer is not fully removed from non-image areas during development.
50. Deinking ability relates to the number of sheets wasted when printing, after having been suspended, is resumed (para. [0018]) and is rated by the number of sheets required to obtain good unstained impressions (para. [0372]).

#### GROUND FOR THE DECISION

##### *The dependent claims and combinations encompassed thereby*

51. The MLD has only considered Fujifilm's defence against the counterclaim for revocation insofar as based on claim 1 and the auxiliary requests 1 and 2. It held that *"As far as Claimant [Fujifilm] wishes to defend dependent claims separately, such defence is inadmissible because Claimant did not file a proper application to amend the patent pursuant to R. 30 RoP in this regard"*.
52. On appeal, Fujifilm has rightly objected to the MLD's refusal to consider Fujifilm's defence of the dependent claims of the Patent.
53. It is a general principle underlying the UPCA as well as the European Patent Convention (EPC) that a patent should not be revoked in its entirety if it is only partially invalid. This is reflected in Art. 138(2) EPC and in similar wording in Art. 65(3) UPCA: *"Without prejudice to Article 138(3) of the EPC, if the grounds for revocation affect the patent only in part, the patent shall be limited by a*

*corresponding amendment of the claims and revoked in part*". The use of 'shall' indicates that the Court does not have discretion in this respect.

54. It follows that, since dependent claims add further features to the independent claim on which they depend, the invalidity of an independent claim does not necessarily lead to the conclusion that the dependent claims are invalid as well. If a patent is attacked in its entirety, the validity of the dependent claims needs to be considered.
55. This does, however, not mean that the Court would be required to investigate the validity of each and every dependent claim of its own motion, including the – possibly many – combinations of dependent claims. The Court's evaluation is based on the arguments and requests brought forward by the parties. A claimant is required to indicate the extent to which revocation of the patent is requested and is required to sufficiently substantiate this request for each of the claims covered by its request (see R. 25.1(a)-(d) RoP).
56. It follows from R. 29A(c) RoP that where the patentee requests that claimant's request for revocation of several or all claims of the patent is rejected, he is required (whether or not as a subsidiary defence) to identify in a sufficiently substantiated manner which dependent claims it considers to be valid should the independent claim be held invalid (see R. 29A(a)-(c) RoP). If the patentee wishes to rely on a combination of dependent claims that does not directly and specifically follow from their wording, such as where the dependent claims rely on several or even any of the previous claims, the patentee should clearly indicate which combination(s) it considers to be valid, (also) in the language of the patent, should the independent claim be held invalid. A patentee can only be considered to have an interest in maintaining his patent if and to the extent defended in a sufficiently substantiated manner.
57. It furthermore follows from the principles of due process – in a similar manner as provided for in R. 30.1 (c) RoP – that the number of such combinations that the patentee wishes to rely on must be reasonable in number, considering the circumstances of the case.
58. In the context of the assessment of the level of substantiation of the alleged invalidity of the various claims in the Statement for revocation, the Court must take into account that the patentee must indicate which combinations of dependent claims it wishes to defend (see para. 56 above). The claimant may therefore, in its Statement for revocation, focus its argumentation on the independent claim(s) and subject matter added by claims dependent thereon, and provide in its Statement of reply to the defence a more detailed argumentation relating to the further combinations of dependent claims defended by the patentee, if any.
59. Defending the claims as granted – including the dependent claims that either depend directly on claim 1, and/or combinations of dependent claims that are encompassed by the claims as granted – does not require any formalities. R. 29A(c) RoP merely requires that the Defence to the Counterclaim for revocation shall contain 'any argument as to why any dependent claim of the patent is independently valid'. This Rule does not require a formal request to that effect. Neither does this requirement of R. 29A(c) RoP reverse the burden of proof, rather it requires the patentee to substantiate its defence.
60. Neither does R. 30 RoP require that the patentee submit an auxiliary request as a prerequisite for defending dependent claims. An Application to *amend* the patent is only required if the patentee wishes to maintain its patent with amended wording, i.e. deviating from the wording of the claims as granted, or proposes combinations of dependent claims not explicitly included therein, thereby limiting the scope of the patent as granted. This is not the case where a patentee merely defends

the dependent claim(s), including combination(s) already encompassed thereby. This is so because even if the independent claim on which a dependent claim depends is considered invalid, the dependent claim is not altered thereby, since it incorporates the (exact language of the) features of the independent claim, adding further features to it, which may confer novelty and inventiveness.

61. The non-applicability of R. 30 RoP also follows from paragraph 1(b) thereof, requiring the patentee to explain *inter alia* why the amendments satisfy the requirements of Articles 84 and 123(2), (3) EPC. There is no need for the patentee to explain that the claims as granted comply with these requirements, as such compliance has already been examined during examination (see also the EPO Guidelines for Examination, in relation to requests for central limitation under Art. 105a EPC, Part D Ch. X, 4.3 (April 2026): “*The examining division is required to decide only whether the amended claims of the request constitute a limitation with respect to the claims as granted or amended (...), and whether the amended claims comply with the requirements of Art. 84, and Art. 123(2) and (3). (...) Claims as granted or as maintained are not examined anew.*”).
62. The fact that dependent claims are not separately examined for novelty and inventive step, as Kodak pointed out, does not lead to another conclusion. Articles 52 and 56 EPC are also (rightly) not referred to in R. 30.1(b) RoP. Examination of novelty and inventiveness of dependent claims is not required since that follows from the novelty and inventiveness of the independent claims. The lack of prior examination in that regard does, however, not lead to the necessity of submitting auxiliary requests under R. 30 RoP. It is already clear from the claims as granted which features are added to the independent claim by the dependent claims, and the counterclaimant knows what to attack.
63. In addition, the requirement of paragraph 1(c) of R. 30 RoP, that the proposed amendments, if conditional, must be reasonable in number in the circumstances of the case, also points in the direction of non-applicability of R. 30 RoP in a situation where a patentee merely defends the patent as granted. It is the claimant in the revocation action who sets the scope of the proceedings by indicating the extent to which revocation is requested. There are no restrictions for this – a claimant may request revocation of the patent in its entirety, even if the patentee does not assert all claims against it. Subsequently not allowing the patentee to defend its patent within the – possible broad – scope of the revocation action, or requiring the patentee to fulfil formalities as a prerequisite for doing so, is contrary to the principle of equality of arms.
64. Kodak’s complaint, that an evaluation of the validity of each and every dependent claim would be unduly burdensome in view of the large number of possible combinations of dependent claims, therefore cannot be accepted.
65. The fact that the European Patent Office may have another approach when considering amendments during opposition proceedings under their Examination Guidelines is of no relevance to the interpretation of R. 30 RoP of this Court.
66. Art. 76(1) UPCA, which provides that the Court shall decide in accordance with the requests submitted by the parties and shall not award more than is requested, does not lead to another conclusion. It does not require any formalities, such as submitting an auxiliary request if the patentee wishes to defend its dependent claims. It only requires that the parties make clear what they request and that the Court decides *within* the scope thereof. This, however, leaves open the possibility, and - even if not obligatory - it may be preferable in view of clarity, that the patentee submits one or more exhibits with one or more alternative sets of claims as defended by it.

67. Where necessary, the Court shall interpret what has been requested by a party, in view of the arguments brought forward, and taking into account the legitimate interests of the other party, in particular by considering how a request by a party is or should have been reasonably understood by the other party.
68. The Court is, however, not bound by the parties' request in the sense that it is allowed – and in the situation referred to in Art. 65(3) UPCA required – to award less than requested, without there being a need for a separate request or application to that effect. An application would only be required if a party wished to limit its request(s), which must always be granted and then sets a new, more limited, scope pursuant to Art. 76(1) UPCA.
69. Applied to the case at hand, Fujifilm's defence in relation to the dependent claims should have been considered by the MLD.
70. In its Statement of claim, Fujifilm explicitly asserted infringement of each of its claims 1, 2 and 3, 4, 5, 6 and 7, 9, 10, and 13 and 14 and requested the MLD as main request to hold that Kodak infringes the claims No. 1, 2, 3, 4, 5, 6, 7, 9, 10, 13 and 14 of the Patent. It argued that the Sonora plates infringe each of these claims, with reference to measurements (Exh. K15 - K19) showing presence of the additional features (SoC para 121 – 203). As such, Fujifilm showed the intention that it wished to rely on the infringement of any of the asserted dependent claims, should the main claim be held invalid in possible Counterclaim for revocation proceedings.
71. In its Defence, Kodak responded to the alleged infringement of claim 1 and of dependent claims 2 and 3, as well as of dependent claims 6 and 7. In the Counterclaim for revocation, Kodak requested the revocation of the patent in its entirety. Kodak extensively argued the invalidity of each and every dependent claim, thereby addressing claims 2 and 3 jointly, as well as claims 6 and 7 jointly.
72. In its Reply, Fujifilm reiterated and elaborated on its arguments that the Sonora plates infringe each of claim 1, and claims 2 and 3 as well as claims 6 and 7 (para. 62-71 Reply). It extensively discussed these dependent claims (para. 273 et seq Reply) specifically mentioning that these together with claim 1 constitute the invention underlying the Patent. Apart from defending the validity of claim 1, Fujifilm separately defended the validity of (particularly) the attacked claims 2 and 3 (para. 393 - 414 Reply) as well as claims 6 and 7 (para. 415 – 420 Reply). Fujifilm requested that the Counterclaim be dismissed in its entirety as a further main request. As a subsidiary request, insofar as the Court considered the claims to be anticipated, Fujifilm requested that the Patent be upheld in accordance with any of the Auxiliary requests submitted with its Application to amend the Patent ('AAP'). The Auxiliary requests did not pertain to (combinations of) the dependent claims, but were amendments of claim 1 by including a further feature based on a disclosure in the patent description.
73. In its Rejoinder, Kodak contested that the Sonora plates infringe features 1.3.3, 1.3.4 and 1.3.5 of claim 1 of the patent. In Chapter D.I of its Rejoinder, Kodak separately responded to the validity defences raised by Fujifilm in relation to claim 1 as well as (among other) subclaim 2 and 3 (Rejoinder para 411-439) and claims 6 and 7 (Rejoinder para 440-451), before discussing the auxiliary requests in Chapter D.II. In para 442 Rejoinder, Kodak states: *"In the discussion of claims 6 and 7, [Fujifilm] emphasises the combination of a45 and delta S. Since claims 6 and 7 refer not only to claims 2 and 3 (a45) but to any of claims 1 to 5, the respective arguments are not relevant"*.
74. In its CC-Rejoinder, under the heading of *"The inventive concept and the claims relied on in these proceedings"* Fujifilm stated in para. 63 and 64:

*“(63) The optimal balance according to the patent in suit is achieved, in particular, through the combination of lightness  $L^*$ , steepness  $a_{45}$ , and specific surface area  $\Delta S$ , for which the dependent claims in particular seek protection. Thus, independent claim 1 reflects an inventive step; dependent claim 3 adds a feature and therefore reflects an additional inventive step; and dependent claim 7, read in combination with claims 3 and 1, reflects even further inventive efforts. These claims and combinations of claims are separately defended by the claimant, as they have been in the Defence.*

*(64) The claimant will focus on a combination of claims 1 and 3, and a combination of claims 1, 3, and 7, when discussing the inventive step of the patent in suit, since each of these claims adds one of the parameters that together constitute the optimal balance that the inventors have attained. Thus, claim 7 – which, read in conjunction with claims 3 and 1, combines all three parameters – seeks protection for the invention in its most preferred form and is therefore the most relevant claim when evaluating the inventiveness of the patent in suit. While the claimant fully maintains its position that all claims of the patent in suit are novel and inventive (and thus also independent claim 1 alone), it will focus on the combination of claims 1 and 3, and on the combination of claims 1, 3 and 7, in the remainder of its argumentation on inventive step. References to claim 3 should be read as references to a combination of claims 1, (2), and 3, while references to claim 7 should be read as references to a combination of claims 1, (2), 3, (6), and 7.”*

75. In a footnote thereto Fujifilm further explained that *“Claims 2 and 6 are bracketed, since they do not add limiting features to claims 3 and 7, but merely specify how steepness  $a_{45}$  and specific surface area  $\Delta S$  should be calculated. Since claims 3 and 7 refer back to claims 2 and 6 respectively, the additional claim features of the latter claims should be read into claims 3 and 7, respectively”*.
76. In the following paragraphs Fujifilm elaborated on its defence against the validity attack of claims 2, 3, 6 and 7, concluding in para. 98 *“Since inventive effort is needed to arrive at the printing plate according to claims 2 and (certainly) 3 of the patent in suit, these plates display inventive step”*, and in para. 103 *“Even if this were different, the documents on which the defendants rely cannot render obvious the subject matter claimed in claims 6 and 7 of the patent in suit”*.
77. In response thereto, Kodak objected to Fujifilm’s reliance on a combination of claim 1 with claims 2 or 3 and 6 or 7, alleging that Fujifilm relied on these combinations for the first time and that these should have been, but were not submitted in its R. 30 RoP request. Kodak responded to Fujifilm’s arguments ‘as a precaution’.
78. The above shows that it was clear from the outset that Fujifilm asserted that the Sonora plates incorporated all features of the independent claim and various dependent claims. In its Reply, in view of Kodak’s SoD, Fujifilm specifically focussed on the infringement and validity of claim 1, claims 2 and 3, both addressing the same feature (steepness  $a_{45}$ ) only differing in the percentage, as well as claims 6 and 7, again both addressing the same feature (surface value  $\Delta S$ ) only differing in percentage.
79. It was apparent that if infringement of claim 2 and/or 3 and of claim 6 and/or 7 would be established, the Sonora plates would automatically also infringe a combination of these claims. Such a combination was already encompassed by granted claim 6, or by claim 7 as being dependent only on claim 6, which in turn may be dependent on claim 2, which is dependent on claim 1. Explicitly asserting infringement of a combination of claim 1 with claims 2 or 3 and 6 or 7 in response to the arguments advanced by Kodak was therefore based on and already

encompassed by the arguments and evidence brought forward by Fujifilm in its Statement of claim. As such, there was no need to request an amendment of claim pursuant to R. 263 RoP.

80. In view of the asserted infringement of claims 2 and 3 as well as of claims 6 and 7, it was sufficiently clear that Fujifilm had an interest in defending the validity of the independent and dependent claims. Fujifilm showed this by explicitly defending each of these claims, including combinations encompassed thereby.
81. In para. 415 of its Reply, Fujifilm discusses claims 6 and 7 as being dependent on claim 3: *“The distinguishing feature between EP 452, JP 021 or EP 408 and the printing plate precursor disclosed in claim 6 of the patent in suit, in addition to having a lightness  $L^*$  of  $\geq 70$  and a steepness  $a_{45}$  of  $\leq 30\%$ , is that the specific surface area  $\Delta S$  is  $\geq 20\%$ . Claim 7 specifies that  $\Delta S$  should be in the range of 20-40%”*.
82. Kodak also understood from Fujifilm’s Reply that it defended the validity of dependent claims 2, 3, 6 and 7, including a combination of claims 6 or 7 with claims 2 or 3. In its Rejoinder, when arguing a public prior use, Kodak states that ‘Against the backdrop of the Plaintiff’s infringement allegation, these printing plate precursors disclose the teaching of the patent in suit’ and ‘Insofar as the Plaintiff disputes this in its Reply, we include below an overview of the respective measurements falling into the claimed ranges of the patent in suit’, followed by measurements in relation to features of claim 1, as well as of subclaims 2 and 3, and of subclaims 6 and 7. In para. 442 when discussing Fujifilm’s defence of its claims 6 and 7, Kodak confirms that *“In the discussion of claims 6 and 7, the Plaintiff emphasizes the combination of  $a_{45}$  and  $\Delta S$ .”* Kodak therefore was not unreasonably hindered in the conduct of its action by the fact that Fujifilm only *explicitly* argued the validity of combinations of claim 1 with claims 2 or 3 and with claims 6 or 7 in its Rejoinder CC.
83. From the formulation of its ‘further’ (i.e. in addition to the main request in the infringement action) main request in the counterclaim proceedings, to dismiss the Counterclaim in its entirety, it was also clear that Fujifilm wished to maintain the patent as granted in its entirety – thus the independent claims and the dependent claims and combinations encompassed thereby – since the attack was to the patent in its entirety as well. There is no justification for understanding a request to revoke the patent in its entirety to include all claims – independent and dependent claims – but to understand a request to dismiss this in its entirety in a different, more limited, manner, such as only relating to independent claim 1. Kodak’s assertion that Fujifilm did not request to maintain the dependent claims and combinations thereof must therefore be dismissed.
84. Under Art. 76 UPCA, where a defendant requests the counterclaim to be dismissed in its entirety, the Court may uphold the patent in its entirety, but where the patent as granted is not valid, may (and under Art. 65(3) UPCA even must, see para. 66 and 68 above) uphold the patent in a more limited form, such as a combination of claims 1, and 2 or 3, and 6 or 7.
85. Fujifilm’s intention to rely on the infringement and validity of (combinations) of dependent claims as part of the main request, *prior to* reliance on the auxiliary requests, is clear from the fact that the Auxiliary requests are only relied on as a *subsidiary* request. This order also follows from Fujifilm’s submissions, such as para. 2, 1<sup>st</sup> and 4<sup>th</sup> bullet of its Reply. The mere inconsistency in its Reply, where Fujifilm had defended the novelty of both claim 1 as well as claims 2 and 3 and 6 and 7 over US’952, concluding in para. 336 that ‘the claims of the patent in suit are novel’, followed by ‘Alternatively, and only in case the Court would come to the conclusion that US 952 is detrimental to the novelty of claim 1 of the patent in suit’ in para. 337, cannot serve to deny Fujifilm’s clear intention to defend the patent as granted, including the dependent claims as a

main request. In para 337 'Alternatively' refers back to 'the claims of the patent are novel'. The further reference only to claim 1 is to be understood in the context of auxiliary request 1 which proposes an amendment of claim 1.

86. The same applies to para. 392, where Fujifilm also refers to auxiliary request 1. In view of the further statements under the heading 'Conclusion: the claims of the patent in suit are inventive' that 'claim 1 and all dependent claims of the patent in suit are inventive' (para. 421) and 'And in particular with respect to dependent claims 2, 3, 6 and 7' (para. 428), it cannot be inferred that Fujifilm was not primarily interested in maintaining the patent as granted, including the dependent claims. This also already followed from the explicit assertion that Kodak infringes subclaims 2, 3, 6 and 7 (para. 62 et seq.).
87. That this had been Kodak's understanding too is clear from its Rejoinder, where under the heading of 'I. Main Request' it discusses the parameters of claim 1, as well as of claims 2, 3, 6 and 7 (para 206).
88. Failing a different indication by the patentee, the ranking, i.e. order in which the patentee wishes to maintain the claims as granted, follows the order (numbering) of the claims. Fujifilm's statements in its Rejoinder CC further confirmed and left no doubt about Fujifilm's intention to first and foremost defend the claims as granted, including the dependent claims and combinations thereof, prior to relying on the auxiliary requests. In its Rejoinder AAP Kodak further responded to Fujifilm's assertions based on the combinations of these independent claims.
89. The combinations of dependent claims as granted which Fujifilm has defended in a sufficiently substantiated manner were limited in number. Insofar Kodak alleges that examination of the validity of the dependent claims would vastly inflate the proceedings and lead to an excessive scope of the examination, this is not only exaggerated, but also due to Kodak's request to revoke the patent in its entirety, rather than as a consequence of Fujifilm's defence of its patent as granted and request to dismiss the counterclaim in its entirety.
90. It follows from the above that the MLD should have considered the validity of the dependent claims 2, 3, 6 and 7 as well as the combinations of claim 1 with either claim 2 or claim 3 and claim 6 or claim 7. These claims and combinations were both clearly invoked and defended in a sufficiently substantiated manner and within Fujifilm's main request. As mentioned above, there was no need to submit an auxiliary request as a prerequisite for defending these claims and claim combinations.

*The patent as limited pursuant to Art. 105b(2) EPC*

91. During the appeal proceedings, upon request by Fujifilm, the European Patent Office (EPO) limited claim 1 of the patent pursuant to R. 105b(2) EPC (Exh. KAP 23), as published in the European Patent Bulletin of 19 November 2025 (Exh. KAP22), to a combination of previous claims 1, 2 and 7 as follows:
  1. A lithographic printing plate precursor comprising:
    - (i) an aluminum support including an aluminum plate and, formed thereon, an anodized film of aluminum, and
    - (ii) an image recording layer,

wherein the anodized film

- is positioned closer to the image recording layer than the aluminum plate,
- has micropores extending in a depth direction of the anodized film from a surface of the anodized film on the image recording layer side,

the micropores have an average diameter of 15-100 nm at the surface of the anodized film, each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth of 10-1000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20-2,000 nm from a communication position between the small-diameter portion and the large-diameter portion, the aperture average diameter of the large-diameter portion at the surface of the anodized film is 15-100 nm, and that of the small-diameter portion at the communication position is  $\leq 13$  nm; and

- has a surface on the image recording layer side having a lightness  $L^*$  of 70-100 in a  $L^*a^*b^*$  color system;
- wherein the steepness  $a_{45}$  representing an area ratio of portions having an inclination of  $\geq 45^\circ$  at the surface of the anodized film on the image recording layer side as determined by extracting components with a wavelength of 0.2-2  $\mu\text{m}$  is  $\leq 30\%$ ;
- wherein the specific surface area  $\Delta S$  is 20-40%,  $\Delta S$  being a value determined by Formula (i)

$$\Delta S = (S_x - S_o) / S_o \times 100(\%)$$

using an actual area  $S_x$  obtained, through three-point approximation, from three-dimensional data acquired by measurement at 512 x 512 points in 25  $\mu\text{m}$  square of the surface of the anodized film on the image recording layer side by means of an atomic force microscope and a geometrically measured area  $S_o$ .

This limitation has retroactive effect.

92. Kodak's objection and its request to disregard this limitation is denied. It follows from the above that the claim as limited was already the subject of the proceedings at first instance and requesting a central limitation cannot be considered to be an abuse of process. The request for limitation was furthermore mentioned in the SoGA and Fujifilm stated that it was expected to be granted prior to the oral hearing, as has indeed been the case. Kodak has therefore not been unduly hindered in its defence.
93. Whether a request pursuant to Art. 105(a) EPC during the proceedings can be contrary to due process, as Kodak submits, can be left aside. The same goes for the question whether a request for central limitation is compatible with the UPC framework and in particular R. 30 RoP, since this Rule does not apply if the patentee merely relies on granted dependent claims and combinations encompassed thereby.

#### *Auxiliary requests on appeal*

94. As follows from the above considerations, the Auxiliary requests 1-2 submitted on appeal which reflect combinations of claim 1 with dependent claims 2 or 3, and 6 or 7 were not required and also not late filed or otherwise contravening due process, since they were already within the scope of the proceedings at first instance. Kodak's objections against these are dismissed.
95. In view of what will be considered below, there is no need to consider whether the further auxiliary requests (3-9) shall be allowed or disregarded on appeal.

*Feature breakdown claim 1*

96. All references to claim 1 hereinafter shall mean claim 1 as limited, unless otherwise indicated. Process claims 13 and 14 have been renumbered to claims 10 and 11.

97. The Court shall use the following feature breakdown of claim 1:

- 1 A lithographic printing plate precursor comprising
- 1.1 an aluminum support including an aluminum plate and,
- 1.1.1 formed thereon, an anodized film of aluminum, and
- 1.2 an image recording layer
- 1.3 wherein the anodized film
- 1.3.1 is positioned closer to the image recording layer than the aluminum plate;
- 1.3.2 has micropores extending in a depth direction of the anodized film from a surface of the anodized film on the image recording layer side,
- 1.3.3 the micropores have an average diameter of 15-100 nm at the surface of the anodized film,
- 1.3.4 each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth (D) of 10-1000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20-2000 nm from a communication position between the small-diameter portion and the large-diameter portion,
- 1.3.5 the aperture average diameter of the large-diameter portion at the surface of the anodized film is 15-100 nm, and that of the small-diameter portion at the communication position is  $\leq 13$  nm; and
- 1.3.6 has a surface on the image recording layer side having a lightness  $L^*$  of 70-100 in a  $L^*a^*b^*$  color system;
- 1.3.7 wherein the steepness  $a_{45}$  representing an area ratio of portions having an inclination of  $\geq 45^\circ$  at the surface of the anodized film on the image recording layer side as determined by extracting components with a wavelength of 0.2-2  $\mu\text{m}$  is  $\leq 30\%$ ;
- 1.3.8 wherein the specific surface area  $\Delta S$  is 20-40%,  $\Delta S$  being a value determined by Formula (i)

$$\Delta S = (S_x - S_o) / S_o \times 100(\%) \text{ (i)}$$

using an actual area  $S_x$  obtained, through three-point approximation, from three-dimensional data acquired by measurement at 512 x 512 points in 25  $\mu\text{m}$  square of the surface of the anodized film on the image recording layer side by means of an atomic force microscope and a geometrically measured area  $S_o$ .

*Skilled person*

98. 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*

99. 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*

100. Some features of claim 1 require interpretation.

#### *Feature 1*

101. According to feature 1, claim 1 relates to a precursor of a printing plate. The printing plate as such is mentioned in claim 13 relating to a manufacturing method thereof. Upon exposure and development, the precursor forms image and non-image areas and thereby forms the printing plate.

102. The precursor is not directed towards the use of a specific printing method. Both (originally granted) claims 13 and 14 contain features that are characteristic for a printing plate for on press development (hereinafter referred as 'DOP'). This is, however, not reflected in patent claim 1. The description addresses this technique as a preferable option only (cf. para. [0108] and, in the section regarding the plate's manufacturing, paras. [0236], [0241], [0242] with statements for both (conventional) developer treatment technique (paras. [0243] et seq.) and on-press development technique (paras. [0256] et seq.)). Neither is claim 1 restricted to a special type of image recording layer.

#### *Features 1.1, 1.1.1 and 1.2*

103. The printing plate precursor comprises an aluminium support including an aluminium plate (feature 1.1), with an anodised film of aluminium formed thereon (feature 1.1.1) (paras. [0022], [0212]). The precursor further comprises an image recording layer (feature 1.2) on which image areas are formed through exposure and development. Further layers like an undercoat layer (paras. [0051], [0052], claims 11 and 12) or a protective layer (para. [0158]) are optional and not reflected in claim 1. However, such or other additional layers are not excluded (cf. claim 1 'comprising').

#### *Feature group 1.3*

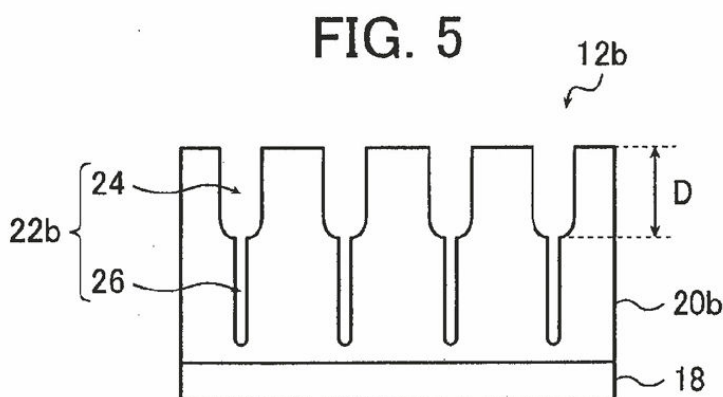
104. Feature group 1.3 refers to the characteristics of the anodized film, formed through an anodising treatment (para. [0030]), more in particular the presence of micropores extending in a depth direction of the anodised film from a surface of the anodised film on the image recording

layer side (feature 1.3.2), which have certain geometrical dimensions (features 1.3.3 – 1.3.5) and lightness of the surface according to feature 1.3.6.

105. The procedure of the anodising treatment is not particularly limited (para. [0195]), provided it leads to micropores according to features 1.3.3 – 1.3.5.

*Features 1.3.3 – 1.3.5*

106. Figure 5 of the patent specification depicted below shows a schematic embodiment of micropores within the anodized film according to the features 1.3.3, 1.3.4 and 1.3.5 (paras. [0212] et seq.).



107. The anodized film (20b) has micropores (22b) having a large-diameter portion (24) which extends from the surface of the anodised film to a depth (D) of 10 nm to 1000 nm (D) and a small diameter portion (26) which communicates with the bottom of the large-diameter portion (24) and extends to a depth of 20 nm to 2000 nm from the communication position between the small diameter portion and the large diameter portion (feature 1.3.4, para. [0213]).
108. The depth is determined by taking a cross-sectional image of the anodized film 20a (at a magnification of 150,000X), measuring the depth of at least 25 micropores 22a, and calculating the average of the measurements (para. [0036]).
109. The aperture average diameter of the large-diameter portion at the surface of the anodized film according to feature 1.3.5 coincides with the average diameter of the micropores at the surface of the anodized film according to feature 1.3.3, and is 15-100 nm. The aperture average diameter of the small-diameter portion at the communication position is  $\leq 13$  nm.
110. The average diameter of the micropores 22a at the surface of the anodised film is determined as follows: The surface of the anodized film 20a is observed with a field emission scanning electron microscope (FE-SEM) at a magnification of 150,000X to obtain four images (N = 4), in the resulting four images, the diameter of the micropores within an area of 400 x 600 nm<sup>2</sup> is measured at 50 places, and the average of the measurements is calculated. The equivalent circle diameter is used if the shape of the micropores 22a is not circular. The 'equivalent circle diameter' refers to the diameter of a circle assuming that the shape of the aperture is the circle having the same projected area as that of the aperture. (para. [0033]-[0034]).
111. The average diameter of the small-diameter portions 26 is determined as follows: The surface of the anodized film 20a is observed with FE-SEM at a magnification of 150,000X to obtain four

images ( $N = 4$ ), in the resulting four images, the diameter of the micropores (small-diameter portions) within an area of  $400 \times 600 \text{ nm}^2$  is measured, and the average of the measurements is calculated. When the depth of the large-diameter portions is large, the average diameter of the small-diameter portions may be determined by cutting out the upper region of the anodized film 20b (the region having the large-diameter portions; for example, cutting out the same by argon gas) and then observing the surface of the anodized film 20b with FE-SEM, as needed (para. 222)].

112. Provided the dimensions required by claim 1 are observed, the shape of the large-diameter and the small-diameter portions is not particularly limited. Exemplary shapes include a substantially straight tubular shape (substantially cylindrical shape) and a conical shape in which the diameter decreases in the depth direction, and a substantially straight tubular shape is preferred (paras. [0219], [0226]).

113. According to the patent description, the average diameter of the micropores at the surface of the anodized layer according to feature 1.3.3 - 1.3.5 leads to a longer press life and improved image visibility (para. [0017]). An average diameter of 10 nm or less, however, would lead to a short press life and a poor image visibility, an average diameter of more than 100 nm to a short press life (para. [0032]).

*Kodak's arguments in relation to features 1.3.2 -1.3.5 do not succeed*

114. Kodak argues in relation to features 1.3.2 to 1.3.5 that (i) large-diameter pores need to be distinguished from small-diameter pores based on the anodisation process; (ii) features 1.3.3 and 1.3.5 require opening portions with continuous boundaries; (iii) features 1.3.2 – 1.3.5 require that each micropore according to the claim has (exactly) one surface opening portion (SoR, para. 725 – 771). None of these arguments is successful.

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

115. Kodak alleges that the structural relationship between features 1.3.2 to 1.3.5 needs to be considered and particular how the micropores as claimed can be delimited from other void volumes in the anodised film, and more specifically how the large-diameter portions can be delimited from the small-diameter portions, which would be indispensable to measure the relevant dimensions. Kodak argues that feature 1.3.4 in particular presupposes the existence of two distinct portions within each micropore with the communication position (at the bottom of the large-diameter portion) marking where the large-diameter portion ends and where the small-diameter portion begins.

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

117. 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. In relation to the embodiment of the invention with large-diameter and small-diameter portions, para. [0227] states that "*The method of manufacturing the aluminum support 12b is not particularly limited*". The method described in the description and referred to by Kodak is only a preferred method, which the skilled person would not consider mandatory. The skilled person thus

appreciates that it is irrelevant how many distinct anodisation steps the micropores have been created. The measurements of the large-diameter and small-diameter portions of Examples 26-29, which have been manufactured according to the preferred manufacturing method, does not lead the skilled person to another conclusion.

118. Neither is reliance on the manufacturing method required in order to distinguish a large-diameter pore from a small-diameter pore, since the diameter of the small-diameter portion at the communication position in accordance with the invention is smaller ( $\leq 13$ ) than the diameter of the large-diameter portion at the surface (15-100 nm), which also forms the basis for the method of measuring the aperture average diameter of the small-diameter portion as described in para. [0222].

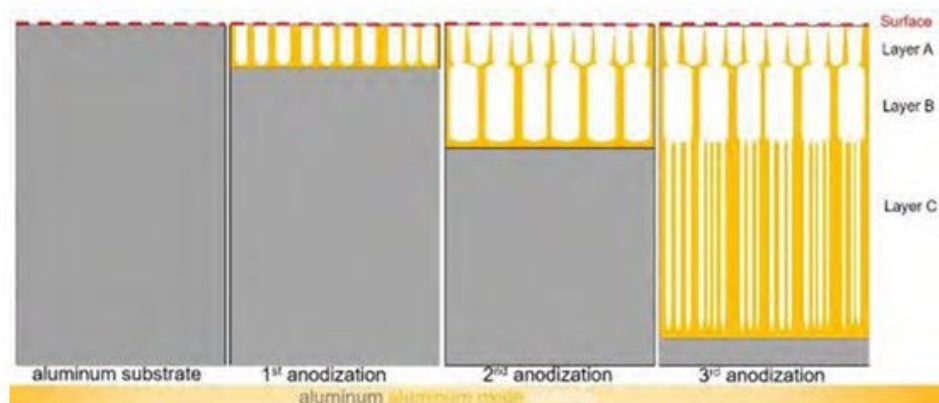
119. Kodak has stated that the skilled person would be aware that the clearly visible anodisation layers are in practice used as a way to determine a distinction between portions that can constitute parts of micropores (SoR para. 744) and that this would be 'standard practice in the field' (SoR para. 783) but failed to sufficiently substantiate this. The mere reference to two other patent applications (one of Kodak WO' 379 (Exh. T9) and the other of Fujifilm, EP'408 – Exh. T2) allegedly using this 'standard procedure' is insufficient, because patent applications are not generally considered to represent common general knowledge.

120. 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 1.3.3 – 1.3.5 only, and not based on the step within the anodisation process which created the pores.

*(ii) features 1.3.3 and 1.3.5 require opening portions with continuous boundaries*

121. Kodak rightly asserts that a pore diameter can only be measured if there is a boundary that delimits the opening, but wrongly draws the conclusion that features 1.3.3. and 1.3.5 cannot be realised (because they cannot be measured) if the surface of the anodised film consists only of spikes and protrusions due to certain anodisation conditions.

122. The skilled person understands that the 'surface' of the anodised film 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.



123. The skilled person knows that the opening of the micropore at the surface may not be perfectly circular. He does not consider this to be problematic, since para. [0034] states that in a case where the shape thereof is not circular an equivalent circle diameter is used.

124. As Fujifilm rightly noted (para. 42 SoGA) 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 roughening treatment and 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 Embodiments. This has not been contested. Fig. 5 does not lead to a different understanding since the skilled person will appreciate this is just a schematic representation showing a flat surface that in practice, for the reasons given, will be uneven.

125. 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 'at the surface' because – the surface being uneven – the 'valleys' in between the spikes are as much 'at the surface' (nothing else on top of it), as the top of the spikes. As Fujifilm rightly noted (para. 16 Reply) the diameter does not require a continuous boundary to be situated at the very top of the anodized film.

*(iii) features 1.3.2 to 1.3.5 require that each micropore according to the claim has (exactly) one surface opening portion*

126. 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. Rather, it follows from 'has micropores' in feature 1.3.2 that 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 effect envisaged by the Patent.

127. In addition, Feature 1.3.3/1.3.5 merely require that the micropores / the large-diameter portion thereof have an average diameter of 15-100 nm at the surface of the anodised film. This does not exclude that one micropore has two openings in the surface. Contrary to what Kodak asserts, this does not prevent the measurement of the average diameter. Naturally, for measuring the diameter of the opening at the surface, in case of two openings these shall be taken together.

128. The figures do not lead 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 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.

129. 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.

130. The description also makes clear that the shape of the large-diameter portions 24 is not particularly limited (para [0219]). The fact that the description does not explicitly describe the

possibility of two openings per micropore, does not lead the skilled person to an understanding that this would be excluded.

131. Since claim 1 is a product claim, any considerations relating to the manufacturing process, advanced by Kodak (para.736-745 SoR), do not lead the skilled person to the understanding advanced by Kodak either.

#### *Feature 1.3.6*

132. According to feature 1.3.6, the surface of the anodized film on the image recording layer side has a specific lightness  $L^*$  in a  $L^*a^*b^*$  colour system.

133. The lightness  $L^*$  refers to the  $L^*a^*b^*$  colour system, also known as the CIELAB colour space defined by the International Commission on Illumination (CIE). It expresses colour as three values:  $L^*$  for perceptual lightness and  $a^*$  and  $b^*$  for the four unique colours of human vision: red, green, blue and yellow. The lightness value  $L^*$  defines black at 0 and white at 100. According to feature 1.3.6,  $L^*$  shall be within the range of 70-100, i.e., at the lighter end between black and white. The lightness  $L^*$  is measured with SpectroEye colorimeter manufactured by X-rite Inc. (para. [0039]).

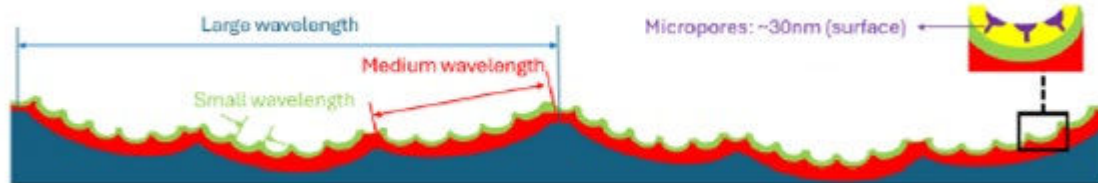
134. According to the description, the lightness  $L^*$  within the predetermined range leads to improved image visibility (para. [0017]). Image visibility refers to the visibility of an image portion of a lithographic printing plate (para. [0005]) after exposure (cf. claim 13) and allows for inspection of the plate before development. In the patent description, it is evaluated as the lightness difference  $\Delta L$  between the lightness  $L^*2$  of exposed image portions and the lightness  $L^*1$  of unexposed non-image portions in a  $L^*a^*b^*$  colour system (para. [0373]). A larger  $\Delta L$  value means higher visibility of exposed image portions and more excellent colour development of the image portions (para. [0373]).

135. As the wording of claim 1 suggests and the description confirms (paras. [0017], [0038], [0376]), lightness  $L^*$  according to feature 1.3.6 refers to the anodized film itself. Therefore, the lightness as claimed must be achieved by the surface itself. This follows from the fact that the surface mentioned in feature 1.3.6 is identical to the surface where the micropores and their large-diameter portion respectively have an (aperture) average diameter as claimed by features 1.3.3 - 1.3.5. Moreover, claim 11 underpins that an optional undercoat layer is part of the printing plate precursor, but not of the aluminium support, because it is positioned between the aluminium support (including the anodized film) and the image recording layer. This excludes an understanding that the lightness according to feature 1.3.6 may also be provided by an additional layer on top of the anodized film. This finding is further confirmed by the description.

136. The anodized film is formed by an anodization treatment, and its thickness is measured from its surface (para. [0030]), excluding any additional layer not stemming from the anodization process to be regarded as belonging to the surface. Furthermore, when describing the manufacturing process of the examples, which have an additional undercoat layer on top of the aluminium support, the lightness of the surface of the anodized film is mentioned just after the description of the surface treatment of the aluminium plate and the following anodization treatment, but before the description of the optional undercoat layer-forming (cf. paras. [0341] to [0344], [0346] et seq.). As far as the lightness is measured for printing plates having such optional undercoat layer, the description gives no indication that such layer may contribute decisively to achieving the lightness as claimed. On the contrary, in the relevant Examples, according to para. [0384] of the description, the undercoat layer improves scumming resistance and deinking ability but is not mentioned for establishing the lightness as claimed.

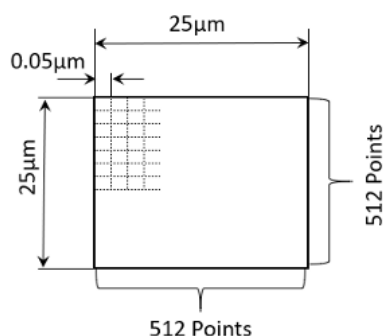
### Features 1.3.7 and 1.3.8

137. The aluminium plate is subject to multiple preparation steps (surface treatment) (para. [0261]) prior to the anodisation step leading to micropores (see below). Such treatment may include one or more cycles of graining (para. [0262] – [0263]), etching (para. [0264]), and/or desmutting (para. [0265]), as a result of which the surface of the aluminium plate becomes uneven to a certain degree, as illustrated below. The degree of roughness influences the performance of the printing plate.



### Feature 1.3.7

138. The range of steepness a45 – being a surface parameter for the roughness of the surface of the anodized film as defined in para. [0040] according to feature 1.3.7 – is  $\leq 30\%$ . The preferred ranges mentioned in paras. [0040] would lead to scumming resistance and deinking ability being more excellent.
139. Steepness a45 indicates the percentage of the actual three-dimensional surface area that has an inclination of at least 45 degrees, a low value indicating a rather smooth surface.
140. The measurement method for calculating steepness a45 is set out in para. [0042] – [0047]. Para. [0044] provides that “In the measurement, 512 x 512 points in 25  $\mu\text{m}$  square of the surface are measured. The resolution is 1.9  $\mu\text{m}$  in the XY direction and 1 nm in the Z direction. The scan rate is 60 mm/s.”. The resolution is the step size in which the cantilever scans the surface of a sample, resulting from the measurement range and the number of sampled points. This can be depicted in the following schematic drawing (Reply, para. 66):



141. It is immediately apparent to the skilled person that the resolution value of 1.9 is an obvious mistake. Fujifilm rightly argued that the skilled person knows that that the resolution is defined by dividing the measurement range in X and Y direction (here of 25 $\mu\text{m}$ ), by the number of measurement points (512), resulting in a resolution of 0,05  $\mu\text{m}$  (0,0488; rounded up). Kodak has

not disputed this in a sufficiently substantiated manner. Whether other patent specifications contain similar errors is not relevant for the skilled person's understanding of claim 1 of the Patent.

142. The skilled person also knew how to correct it. Fujifilm rightly submits (para. 325 FPF) that steepness is required to be determined extracting components with a wavelength of 0.2 to 2  $\mu\text{m}$ . A resolution of 1.9  $\mu\text{m}$  would however not provide data on surface structures between 0.2 - <1.9  $\mu\text{m}$ . The skilled person would therefore assume the (standard) number of points of 512x512 as well as the area of 25x25  $\mu\text{m}$  square to be correct, leading to a resolution of 0.05. This has not been contested by Kodak, it only unsuccessfully objects to it being late (see para 190 below).

#### *Feature 1.3.8*

143. The range of the specific surface area  $\Delta S$  – also being a further surface parameter for the roughness of the surface of the anodized film as defined in para. [0048] and feature 1.3.8. – is 20-40%, but even more preferred ranges mentioned in paras. [0048] would result in press life being longer and in more excellent scumming resistance, deinking ability and image visibility.

144. Surface area  $\Delta S$  indicates the ratio between the actual three-dimensional surface area (including all elevations and depressions)  $S_x$  and the two-dimensional geometric surface area (as it would appear on paper)  $S_o$ . Surface area  $\Delta S$  thus measures the difference between the actual surface area in three dimensions and the two-dimensional distance between start- and endpoint. Surface area  $\Delta S$  may compensate for a low steepness  $a_{45}$  and serves to improve press life, since it enhances the 'adhesive effect' of the surface.

145. The measurement method of surface area  $\Delta S$  is set out in para. [0048] – [0050] and refers back to the measurement method used to calculate steepness  $a_{45}$ .

#### *Effects of features 1.3.3 - 1.3.8*

146. It is undisputed that at the priority date, the skilled person was aware that not all characteristics of a printing plate precursor can be optimal, since certain conditions lead to contradicting results. For instance, an even surface leads to better scumming resistance, because the unexposed parts can be more easily removed, as well as improved image visibility (by increased reflection) but at the same time an even surface results in decreased press life, as the exposed parts are not as anchored to the aluminium support.

147. According to the patent description, characteristics within the scope of the features 1.3.3 - 1.3.8 lead to a *balance* among press life, scumming resistance, image visibility (paras. [0031], [0038]) and deinking ability (paras. [0017], [0018]). This is shown in Table 2 (reproduces below) and explained in paras. [0380] – [0385] of the description as follows:

*[0380] As shown in Table 2, the use of the lithographic printing plate precursor of the invention brought about the desired effects.*

*[0381] In particular, the comparison of Examples 2 to 10 revealed that, when the average diameter fell within the range of 15 to 60 nm, the balance among a press life, scumming resistance and image visibility was excellent.*

*[0382] The comparison of Examples 5 and 11 to 15 revealed that, when the steepness  $a_{45}$  was not more than 20%, scumming resistance and deinking ability were more excellent.*

*[0383] The comparison of Examples 5 and 16 to 20 revealed that, when the specific surface area  $\Delta S$  was not less than 20%, the press life was longer.*

[0384] The comparison of Examples 5 and 21 to 23 revealed that, when the undercoat layer was provided, scumming resistance and deinking ability were more excellent. When the undercoat layer contained a compound having the betain structure, scumming resistance and deinking ability were more excellent.

[0385] The comparison between Examples 26 to 29 and other Examples revealed that, when the anodized film had micropores each composed of the predetermined large-diameter portion and the predetermined small-diameter portion, the effects were further excellent.

[Table 2]

| Table 2                                                        | Aluminum support |                       |          |                  |                                      | Undercoat layer-forming treatment or hydrophilizing treatment | Image recording layer | Evaluation                      |                     |                  |                                                           |
|----------------------------------------------------------------|------------------|-----------------------|----------|------------------|--------------------------------------|---------------------------------------------------------------|-----------------------|---------------------------------|---------------------|------------------|-----------------------------------------------------------|
|                                                                | Support          | Average diameter (nm) | L* value | Steepness 45 (%) | Specific surface area $\Delta S$ (%) |                                                               |                       | Press life (unit, ten thousand) | Scumming resistance | Deinking Ability | Plate inspection properties (image visibility) $\Delta L$ |
| EX 1 *                                                         | A                | 12                    | 81       | 23               | 28                                   | C                                                             | A                     | 3.8                             | 9                   | 9                | 4                                                         |
| EX 2                                                           | A                | 18                    | 81       | 23               | 28                                   | C                                                             | A                     | 4.2                             | 9                   | 9                | 5                                                         |
| EX 3                                                           | A                | 21                    | 81       | 23               | 28                                   | C                                                             | A                     | 4.6                             | 9                   | 9                | 5                                                         |
| EX 4                                                           | A                | 25                    | 82       | 23               | 28                                   | C                                                             | A                     | 4.7                             | 9                   | 9                | 6                                                         |
| EX 5                                                           | A                | 30                    | 82       | 23               | 28                                   | C                                                             | A                     | 5.0                             | 9                   | 9                | 7                                                         |
| EX 6                                                           | A                | 34                    | 82       | 23               | 28                                   | C                                                             | A                     | 4.9                             | 9                   | 9                | 7                                                         |
| EX 7                                                           | A                | 40                    | 84       | 23               | 28                                   | C                                                             | A                     | 4.7                             | 9                   | 9                | 8                                                         |
| EX 8                                                           | A                | 65                    | 86       | 23               | 28                                   | C                                                             | A                     | 4.0                             | 9                   | 9                | 8                                                         |
| EX 9                                                           | A                | 88                    | 90       | 23               | 28                                   | C                                                             | A                     | 3.9                             | 7                   | 9                | 9                                                         |
| EX 10                                                          | A                | 100                   | 94       | 23               | 28                                   | C                                                             | A                     | 3.7                             | 7                   | 9                | 9                                                         |
| EX 11                                                          | A                | 30                    | 82       | 27               | 28                                   | C                                                             | A                     | 4.9                             | 7                   | 8                | 5                                                         |
| EX 12                                                          | A                | 30                    | 82       | 21               | 28                                   | C                                                             | A                     | 4.7                             | 8                   | 8                | 8                                                         |
| EX 13                                                          | A                | 30                    | 84       | 19               | 28                                   | C                                                             | A                     | 4.7                             | 9                   | 10               | 8                                                         |
| EX 14                                                          | A                | 30                    | 86       | 12               | 28                                   | C                                                             | A                     | 4.5                             | 10                  | 10               | 9                                                         |
| EX 15                                                          | A                | 30                    | 91       | 7                | 28                                   | C                                                             | A                     | 4.3                             | 10                  | 10               | 9                                                         |
| EX 16                                                          | A                | 30                    | 83       | 23               | 17                                   | C                                                             | A                     | 3.0                             | 9                   | 9                | 5                                                         |
| EX 17                                                          | A                | 30                    | 83       | 23               | 20                                   | C                                                             | A                     | 3.7                             | 9                   | 9                | 5                                                         |
| EX 18                                                          | A                | 30                    | 81       | 23               | 26                                   | C                                                             | A                     | 4.1                             | 9                   | 9                | 5                                                         |
| EX 19                                                          | A                | 30                    | 79       | 23               | 33                                   | C                                                             | A                     | 4.8                             | 7                   | 8                | 5                                                         |
| EX 20                                                          | A                | 30                    | 71       | 23               | 42                                   | C                                                             | A                     | 5.0                             | 7                   | 7                | 4                                                         |
| EX 21                                                          | A                | 30                    | 82       | 23               | 28                                   | A                                                             | A                     | 4.6                             | 9                   | 9                | 5                                                         |
| EX 22                                                          | A                | 30                    | 82       | 23               | 28                                   | B                                                             | A                     | 5.0                             | 9                   | 9                | 5                                                         |
| EX 23                                                          | A                | 30                    | 82       | 23               | 28                                   | None                                                          | A                     | 5.1                             | 6                   | 5                | 5                                                         |
| EX 24                                                          | C                | 30                    | 82       | 23               | 28                                   | C                                                             | A                     | 5.0                             | 9                   | 9                | 7                                                         |
| EX 25                                                          | B                | 30                    | 82       | 23               | 28                                   | C                                                             | A                     | 5.0                             | 9                   | 9                | 7                                                         |
| EX 26                                                          | D                | 30                    | 82       | 23               | 28                                   | C                                                             | A                     | 5.8                             | 9                   | 9                | 7                                                         |
| EX 27                                                          | D                | 20                    | 82       | 23               | 28                                   | C                                                             | A                     | 5.4                             | 9                   | 9                | 6                                                         |
| EX 28                                                          | D                | 27                    | 82       | 23               | 28                                   | C                                                             | A                     | 5.5                             | 9                   | 9                | 7                                                         |
| EX 29                                                          | D                | 35                    | 82       | 23               | 28                                   | C                                                             | A                     | 5.6                             | 9                   | 9                | 8                                                         |
| EX 30                                                          | A                | 30                    | 82       | 23               | 28                                   | C                                                             | B                     | 5.0                             | 9                   | 9                | 5                                                         |
| EX 31                                                          | A                | 30                    | 82       | 23               | 28                                   | C                                                             | B                     | 5.0                             | 9                   | 9                | 5                                                         |
| EX 32                                                          | E                | 40                    | 83       | 23               | 28                                   | A                                                             | C                     | 5.2                             | 9                   | 9                | 7                                                         |
| EX 33                                                          | F                | 40                    | 83       | 23               | 28                                   | A                                                             | C                     | 5.2                             | 9                   | 9                | 7                                                         |
| EX 34                                                          | G                | 100                   | 83       | 23               | 28                                   | A                                                             | C                     | 6.1                             | 9                   | 8                | 7                                                         |
| EX 35                                                          | H                | 40                    | 83       | 23               | 28                                   | A                                                             | C                     | 5.2                             | 9                   | 9                | 7                                                         |
| CE 1                                                           | A                | 10                    | 82       | 23               | 28                                   | C                                                             | A                     | 2.5                             | 9                   | 9                | 3                                                         |
| CE 2                                                           | A                | 120                   | 82       | 23               | 28                                   | C                                                             | A                     | 2.4                             | 9                   | 9                | 8                                                         |
| CE 3                                                           | A                | 30                    | 67       | 32               | 28                                   | C                                                             | A                     | 4.6                             | 7                   | 8                | 3                                                         |
| EX: Example<br>CE: Comparative Example<br>*: Reference Example |                  |                       |          |                  |                                      |                                                               |                       |                                 |                     |                  |                                                           |

## Claims 10 and 11

148. The features of the independent claims 10 and 11 referring to claim 1 correspond largely to those of claim 1. The subject-matter of the independent claims 10 and 11 is therefore subject to

the same assessment as that of claim 1 without need for further interpretation. Manufacturing parameters which lead to a desired steepness and surface area are not exhaustively disclosed by the patent but are left to the knowledge of the skilled person.

## VALIDITY OF THE PATENT

### Added matter

149. At first instance, Kodak argued that there was added matter in claim 6 as granted, more in particular the claimed surface area  $\Delta S$  of  $\leq 20$ , there being no basis for a percentage lower than 20 in the original application. Claim 1 (as limited) does not rely on claim 6 in that respect, since it claims the  $\Delta S$  of 20-40% of granted claim 7. None of the dependent or independent claims of the patent as limited claims a surface area of  $\leq 20\%$ . In its SoGA (para. 71) Fujifilm therefore considered the alleged added matter issue to be no longer relevant, and this has not been contested by Kodak. The Court of Appeal agrees that there is no need to decide on this.

### Novelty

#### *Principles*

150. 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*).

151. 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.

152. 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.

153. For a claim that defines features of the claimed product by way of ranges – like the present claim 1 in features 1.3.3, 1.3.4, 1.3.5, 1.3.6, 1.3.7, 1.3.8 – 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*

154. Kodak asserts that the Patent lacks novelty because its T41 / Sonora X plates were publicly available before the priority date of 31 August 2017 and they disclose all the features of claim 1 of the Patent. The MLD rejected the novelty attack based on public prior use.
155. The MLD disregarded all submissions by Kodak regarding alleged public prior use after the filing of the SoD. 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.
156. Kodak has (as a subsidiary position) requested that the Court of Appeal uses its discretion in accordance with 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.
157. Kodak submitted new exhibits A-4 – A-8 on appeal. Fujifilm argues that each of these exhibits could have been submitted during the first instance proceedings and must therefore be refused. Kodak has not responded to this in its KFP.
158. There is no need to decide on Fujifilm's objection in the context of Kodak's novelty attack based on public prior use. The same goes for Kodak's request to admit into the appeal proceedings the relevant paragraphs of its statements and exhibits it lodged after its SoD, which were refused by the MLD due to late filing and which discuss the characteristics of the Sonora X plates. Even if it were established that the Sonora X plates had the same properties as protected by claim 1, this could not lead to a lack of novelty. The MLD rightly considered that Kodak has not submitted sufficient facts and evidence to establish that the subject-matter of the Patent is anticipated by printing plate precursors that were publicly available before the relevant priority date.
159. The relevant priority is that of the first priority claim to JP'624 of 31 August 2017 which has not been disputed by Kodak. Therefore, the only asserted public prior use that could lead to a lack of novelty is the alleged delivery to its customer [REDACTED] ([REDACTED]). The alleged delivery to Laserline GmbH took place on 12 October 2017 and hence after the first priority date. The delivery to [REDACTED] was already presented by Kodak in its SoD (para. 161 to 171) and was thus not disregarded by the MLD.
160. The MLD rightly held in para. 78-82 of the impugned decision – which the Court of Appeal fully endorses, and which must be considered reiterated herein – that the delivery to [REDACTED] was clearly a test (as confirmed by the witness declaration of [REDACTED] Exh. T6 para. 11) and must have been understood by [REDACTED] to be under an at least implied confidentiality agreement. Anything to the contrary would have needed to be proven by Kodak, for example by a statement from someone from [REDACTED], which Kodak failed to do. The fact that there were no clear instructions to [REDACTED] on how to further deal with the plates and the lack of an express confidentiality agreement, as [REDACTED] declared, is insufficient to show public availability under

the circumstances where the plates were clearly delivered for the purpose of testing a new product. The Court does not agree that the absence of (implied) confidentiality obligations between Kodak and [REDACTED] is impossible to prove, as Kodak argues. Furthermore, the fact that there may be difficulties in finding former employees of [REDACTED] as Kodak alleges, is a risk that falls on Kodak as the party who has the burden of proving the alleged public availability.

161. Nothing advanced by Kodak on appeal can lead to a different view. Kodak's suggestion that the number of plates delivered to [REDACTED], 300 of which only 70 were used on the first testing day, indicates that [REDACTED] could do with the rest of the plates as they deemed fit (SoR para. 268), is not supported by the conclusion in the test report (Exh. T13). There it is stated that *"Remaining plates will mainly use for Jobs with run length of more than 8.000 copies to confirm the better dot stability"* and that *"End of June the [REDACTED] Job, which comes periodically once a month, will require the rest of the T41 plates"*, which rather indicates that it was agreed that the plates would be used for further testing (on dot stability) and also on which job the remainder of the plates would be used. Kodak's submission that one of its employees was present 'only' during the first day of the testing indeed confirms that further testing with the remaining plates was envisaged. That this testing is done in the course of a regular commercial print job does not change the implied confidential character of the testing exercise.

162. In addition, Fujifilm has rightly noted (SoGA para. 104-106) that even when announcing the introduction of the new Sonora X plates to its customers with the [REDACTED] of December 2017 (Exh. T17) Kodak marked this as 'Kodak Confidential'. It is thus unlikely that Kodak did not wish to keep the Sonora X plates and its properties confidential half a year earlier.

163. It follows that it has not been established that the T41 / Sonora X plate was publicly available prior to 31 August 2017. Kodak's arguments based on public prior use fail.

WO'379

164. The MLD considered the Patent new in view of WO'379. Kodak maintains its novelty attack on appeal, but this is unsuccessful.

165. WO'379 (Exh. T9) was filed on 20 February 2018 and published on 7 September 2018, after the filing date of EP'616 (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.

166. It is undisputed that WO'379 describes a precursor with all features of claim 1 except 1.3.6, 1.3.7 and 1.3.8.

167. Kodak argues (para. 292 SoR) that 1.3.6, 1.3.7 and 1.3.8 are implicitly disclosed, with reference to a report by Merka (Exh. T27), one of the inventors of WO'379 and an employee of Kodak, which allegedly shows that reworking of example 7 by the skilled person leads to an embodiment with the values for lightness, steepness  $a_{45}$  and surface area  $\Delta S$  as required by features 1.3.6, 1.3.7 and 1.3.8 respectively, as shown in the measurement report (Exh. 28). This is rejected.

168. On page 43 of WO'379 it is described that the aluminium-containing substrates used in the Examples 1-31 were prepared according to the general processes described above (i.e. the description). It *inter alia* states that both pre-etch and post-etch steps were carried out in alkaline solutions under known conditions and that roughening (or graining) was carried out by electrochemical means in a hydrochloric acid solution at about 23°C to obtain an arithmetic average roughness (Ra) of 0.5  $\mu\text{m}$  on a planar surface of the aluminium-containing support. Kodak

has further referred to the teaching on page 15, lines 10-14 of the description of WO'379, that during roughening or graining, smut can be formed on the planar surface of the support and this smut can be removed in a post-etching step using a treatment with a highly acidic or highly alkaline solution, for example, to remove 0.01 - 5.0 g/m<sup>2</sup> of the support surface.

169. In Merka's report it is stated that three samples were prepared. In sample A 1.00 g/m<sup>2</sup> of the support surface was removed *"as it was done for example 7 described in WO 2018/160379 which was carried out under my supervision at that time"*; in sample B 0.01 g/m<sup>2</sup> was removed and sample C 5.0 g/m<sup>2</sup> was removed. The measurement report (Exh. 28) shows that the average values for surface area  $\Delta S$  for these samples was 25%, 51% and 9% respectively. Thus, only sample A falls within the claimed range of 20-40% and it cannot be concluded that reworking of example 7 necessarily leads to an embodiment within the scope of claim 1.

170. Kodak without success argues (para. 300 SoR) that the skilled person would choose a value in the center of the given range 0.01 and 5.0 g/m<sup>2</sup> of the support surface to be removed. However, that is not supported by the reworking of Merka who has not chosen to remove 2.5 g/m<sup>2</sup> of the support surface, but 1.0 g/m<sup>2</sup>. What the  $\Delta S$  value would be if 2.5 g/m<sup>2</sup> of the support surface were removed has not been shown by Kodak.

171. In addition, it is not clear how the post-etching step was performed, while WO'379 (p. 15, l. 10-24) mentions various parameters which may be considered:

*"During roughening or graining, smut can be formed on the planar surface of the support and this smut can be removed in a post-etching step using a treatment with a highly acidic or highly alkaline solution, for example, to remove 0.01 - 5.0 g/m<sup>2</sup> of the support surface. For example, post-etching can be carried out using a solution of sodium hydroxide, trisodium phosphate, or sulfuric acid. The amount of post-etching can be controlled by setting dwell time, concentration, and temperature of the etching solution. A suitable amount of post-etching also depends on the amount of roughening and the amount of smut formed in that step. The post-etching treatment should be sufficient to remove the smut, but it should not destroy too much of the surface structures formed in the roughening step. The post-etching treatment should be sufficient to remove the smut, but it should not destroy too much of the surface structures formed in the roughening step. Thus, there are many combinations of the parameters that a skilled artisan can consider during routine experimentation to find the optimum post-etching conditions."*

172. Since Merka performed the post-etching step how he had done this 'at the time' (i.e. when he made the invention) it has not been shown if and how the skilled person (with which Merka as the inventor cannot be equated) would necessarily do this.

173. The fact that roughening (or graining) must be carried out *"to obtain an arithmetic average roughness (Ra) of 0.5  $\mu$ m on a planar surface of the aluminum-containing support"*, as Kodak noted (para. 301 SoR) does not lead to a different conclusion. Arithmetic average roughness  $R_a$  measures the average absolute height of peaks and valleys relative to the main plane. Even though – like arithmetic average roughness  $R_a$  – steepness  $a_{45}$  and specific surface area  $\Delta S$  define surface roughness, these are different parameters (see para. 139 and 144 above) that are not related such that a certain  $R_a$  value necessarily leads to a certain value of  $a_{45}$  and  $\Delta S$ . Kodak has also not shown that if a  $R_a$  value of 0,5  $\mu$ m is achieved, this necessarily leads to  $a_{45}$  and  $\Delta S$  values within the claimed ranges.

174. The novelty attack based on WO'379 thus already fails for the lack of a direct and unambiguous disclosure of feature 1.3.8.

#### US'952

175. The MLD regarded further substantiation of the lack of novelty arguments based on US'952 filed after the SoD as too late but nevertheless discussed them (para. 99 et seq. impugned decision). There is no reason to disregard these arguments on appeal.

176. US'952 was published on 28 January 1986 and hence prior to any of the priorities claimed by the Patent. US'952 is state of the art according to Art. 54 (2) EPC.

177. It is undisputed that US'952 does not explicitly disclose features 1.3.2 to 1.3.8. For these features, Kodak relies on reworking of example 2 of US'952.

178. Kodak argues (para. 308 SoR) that (among other) features 1.3.7 and 1.3.8 are implicitly disclosed, with reference to a report by Merka (Exh. T31), which allegedly shows that reworking of example 2 by the skilled person leads to an embodiment with the values, steepness  $\alpha_{45}$  and surface area  $\Delta S$  as required by features 1.3.7 and 1.3.8 respectively, as shown in the measurement report (Exh. 28). This is rejected.

179. These parameters depend on the roughness of the surface area, which on its turns depends on the surface treatment performed. Merka in his report stated he performed a pre-etching step, EC graining and then two anodisation steps, after which he sent the sample for measurement taking. After each of these steps, the sample was "*rinsed with water and squeezed*". This is not described in example 2, but according to Kodak a "*standard laboratory measure*".

180. In its Reply, Fujifilm (para. 335 Reply) brought forward that "*Example 2 of US 952 does not describe any treatment step after the electrochemical roughening step and prior to the first anodizing step. Yet, it is well-known that electrochemical roughening results in the formation of smut deposits which need to be removed, since otherwise no uniform anodic layer will form. The formation of smut and its removal is e.g. described in US 952, col. 6.*" There it is stated that "*In addition to an abrading treatment stage between the roughening stage and the anodizing stages, non-electrochemical treatments are also known, which have a rinsing and/or cleaning action and serve, for example, to remove deposits ('smut') which have formed in the roughening procedure or simply to remove electrolyte residues. For these purposes, dilute aqueous alkali-metal hydroxide solutions or water, for example, are employed.*".

181. In its Reply, Fujifilm further stated that "*Whilst it can be argued that the skilled person, in the absence of an explicit teaching regarding the removal of smut, could fill in the gap and could apply a post-etching step, there is no direct and unambiguous disclosure on how to perform such step and which conditions to apply.*" This was not disputed by Kodak. In its Rejoinder it considered Fujifilm's arguments in para. 335 Reply irrelevant for claim 1 – despite the fact that it had also attacked claims 2, 3 6 and 7 based on anticipation by example 2 of US 952 in its SoD (para. 295-298 and 305-306) – and further noted that Merka correctly reproduced Example 2 so that the  $\alpha_{45}$  and  $\Delta S$  values as measured were correct.

182. Kodak, however, failed to explain whether Merka performed any post-etching (de-smutting) step and if so under which conditions. If he did not, it has not been clarified why not, while it was not disputed that it was well known and needed. The mere fact that it has not been explicitly described in example 2 cannot be a sufficient reason, given that Merka did perform the rinsing

step as being a standard procedure, which – like the removal of smut – was mentioned in the description, but not explicitly in example 2. If with ‘rinsing’ Merka actually meant ‘removing smut’, then it has not been sufficiently explained how this was performed, given the relevance of the amount of removed surface for the  $a_{45}$  and  $\Delta S$  values. Importantly, since Merka cannot be equated with a skilled person, it has not been shown how the skilled person would approach this when reworking example 2 of US’952 in view of the fact that US’952 does not provide any guidance in this respect.

183. This leads to the conclusion that the reworking of example 2 as performed by Merka cannot serve to convincingly show that features 1.3.7. and 1.3.8 are inevitably disclosed thereby. Thus, US’952 cannot destroy the Patent’s novelty.

### Inventive step

#### *Principles*

184. 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*

#### *Reasonable starting points and combination documents – procedural objections*

185. Kodak based its inventive step attacks for claim 1 on starting points EP’452, EP’408 or JP’021 (hereinafter also referred to as the ‘starting documents’) and argued that feature 1.3.6 (L\*) was obvious in view of common general knowledge, or in combination with either EP’968, EP’541 or JP’090 and in its R30-Rejoinder also with JP’459 (previously only argued in view of feature 1.3.7). For claim 2, now feature 1.3.7 ( $a_{45}$ ), Kodak initially relied on combinations with EP’968 and JP’459, in its Rejoinder also with JP’264 and in its R30-Rejoinder also with Sawada. For claim 7, now feature 1.3.8 ( $\Delta S$ ), Kodak initially relied on combination with JP’264, in its R30-Rejoinder also with JP’459 and Sawada.
186. Fujifilm has objected to reliance on new prior art documents filed after the Rejoinder, since it was clear by then that Fujifilm defended the combination of claims 1 with steepness  $a_{45}$  (2/3) and  $\Delta S$  (6/7).
187. Reliance on JP’264 and JP’459 shall be allowed since these documents were already part of Kodak’s invalidity attacks and Fujifilm cannot be considered to be negatively affected by Kodak’s reliance on these documents where it concerns features 1.3.7 and 1.3.8, as these were already part of the inventive step debate.
188. However, Fujifilm rightly objects (para 458 SoGA) to Sawada being used in an inventive step attack. In its SoD Kodak only referred to Sawada (Exh. T5) to dispute the accuracy of the measurements (to deny infringement). Also in the Rejoinder, Sawada is used in the context of the question of ‘whether any of the AFM data presented by the Plaintiff is credible at all’. Only in its R.30-Rejoinder, Kodak argues the lack of inventive step of the alleged combination of dependent claims based on a combination with Sawada (para 238 et seq) and used it as a starting point in the SoR. Kodak justifies this by referring to Fujifilm’s alleged new reliance on the combination of dependent claims, but as Fujifilm rightly notes this was already clear from the Reply. That Kodak considered this to be ‘irrelevant’ is a procedural choice made by Kodak that cannot justify the late

introduction of new prior art as a basis for its inventive step attack. In accordance with R. 222.2 RoP the arguments based on Sawada shall be disregarded.

189. This also applies to Kodak's inventive step attack based on commercial products on the market prior to the priority date of the patent, which was brought for the first time on appeal. Kodak has not convincingly explained why this could not have been brought in the Rejoinder. This attack introduces new facts and opens up a whole new debate, which obviously negatively affects Fujifilm's position.

190. Insofar as the parties brought forward one or more new legal arguments on appeal, either in their initial or further pleadings, such is allowed insofar as based on the facts and evidence already introduced at first instance and not disregarded due to late filing (cf *Meril v Edwards*, CoA 511/2024, 21 November 2024, first headnote).

*Inventive step starting from EP'452 (Exh. T2), EP'408 (Exh. T41) or JP'021 (Exh. T42/42a)*

#### *Objective problem*

191. According to Kodak (para. 354 SoR), the objective problem should not be formulated as the provision of a printing plate with precursor having excellent image visibility and a long press life, since that would contain pointers to the solution and is not justified by the technical effects achieved. Rather the objective problem should be the provision of a printing plate precursor which is suitable for lithographic printing methods which can be developed either on-press or off-press. This cannot be followed. As Kodak itself accepts, printing plate precursors were well known in the art at the priority date, as well as the desired properties, including image visibility and long press life (para. 24-31 SoD). The invention is thus not about the development of printing plate precursors as such.

192. A long press life requires that the image recording layer is sufficiently attached to the printing plate substrate, therefore a certain roughness of the surface of the substrate is required. Image visibility requires a high contrast between the image areas and non-image areas. As is seen in Table 2 of the Patent, there is a trade-off between press life and image visibility, in that properties of the surface of the printing plate support which define its roughness (pore structure in the anodized layer, steepness  $a_{45}$  and specific surface area  $\Delta S$ ) have a reverse impact on press life (improved with increased roughness) and image visibility (decreased with increased roughness). A similar inverse effect, but to a much lesser extent, is seen with scumming resistance and deinking ability.

193. Table 2 shows in examples 1-10 the effect of the micropore dimensions at the surface (average diameter) on the printing plate properties. The Examples 1-10 show that by an increasing average pore diameter, the value for  $L^*$  increases, leading to a clear positive effect on image visibility, but that press life first improves up to the optimum average diameter of 30, but deteriorates thereafter. On scumming resistance, it has a mild negative effect at the higher end, and there is no visible effect on deinking ability. The optimum which provides a good balance between the effects on all printing plate precursor properties is in the middle range (Example 5).

194. Examples 11-15 show with varying values for steepness  $a_{45}$ , that a lower value for  $a_{45}$  leads to a higher  $L^*$  value, leading to increased image visibility, but decreased press life. Comparison with CE3 shows that in terms of press life, the optimum value for steepness is around 27 with a press life of 4.9, while a further increase to 32 leads to a lower press life. Within the claimed ranges for steepness  $a_{45}$ , pore dimensions and specific surface area  $\Delta$ , a (very) good balance can be found

between press life, and image visibility and also for scumming resistance and deinking ability, the optimum balance between all properties being given by examples 12-14, thus showing a technical effect of all of the features of claim 1 in combination.

195. With examples 16-20, using different values for specific surface area  $\Delta S$ , it is shown that a higher  $\Delta S$  leads to a lower  $L^*$  value, leading to increased press life, but a lower image visibility, and that especially within the claimed range shown in examples 17-19 (examples 16 and 20 being outside the scope of claim 1), as well as pore dimensions and steepness  $a_{45}$  within the claimed ranges, a (very) good balance can be found between press life and image visibility, as well as scumming resistance, deinking ability, thus once more showing a technical effect of the features of claim 1 in combination.

196. Where Kodak (in para. 500 SoR) argues that the steepness  $a_{45}$  value required by the patent should be disregarded because it does not have a technical effect since it does not have a lower limit and is only measured in the 0.2 to 2  $\mu\text{m}$  wavelength, without requirements for the surface structures having a different size, it wrongly considers steepness  $a_{45}$  in isolation, rather than together with the other features of claim 1, in particular feature 1.3.8 which claims a specific surface area of 20-40% measured over the *entire* surface, which counterbalances the relatively low steepness and indeed prevents an overly smooth surface. Where Kodak argues that specific surface area  $\Delta S$  does not provide a technical advantage and should be disregarded when assessing inventive step (para. 512 SoR), again it wrongly considers feature 1.3.8 in isolation, rather than together with the other features of claim 1.

197. Given the profound reverse effect of surface structure on press life and image visibility, it is clearly the object of the invention to find a good balance between these two properties in particular. This is correctly reflected in para. [0008] of the patent. As is also clear from para. [0018], [0040] and [0048], the values for steepness  $a_{45}$  and  $\Delta S$  have been chosen such that the scumming resistance and deinking ability properties would not be impaired as a result. The objective problem is to improve image visibility while not impairing press life and also maintaining good scumming resistance and deinking ability.

#### *No juxtaposition of features*

198. Kodak has argued that the different features of the two-portion structured micropores, lightness, steepness  $a_{45}$  and specific surface area  $\Delta S$  were independently known in the prior art and that such mere aggregation of known features could not comprise an inventive step and, at any rate, these should be considered separately for each of the parameters.

199. As considered above, Fujifilm is right to argue that the pore structure of the anodised film, its light value  $L^*$ , a certain (rather low) steepness  $a_{45}$  in medium wavelengths and a (rather high) specific surface area  $\Delta S$  of the entire surface (comprising small, medium and large wavelengths) each influence the different required properties of a printing plate precursor properties in sometimes conflicting manner. It is at the core of the invention that the claimed ranges are chosen to balance in the best possible way the conflicting characteristics of a printing plate precursor, in particular leading to excellent image visibility *and* long press life, but also still having excellent scumming resistance and deinking ability.

200. The fact that the micropore dimensions and macroscopic surface structures defined by lightness  $L^*$ , steepness  $a_{45}$  and specific surface area  $\Delta S$  are controlled independently of each other in different manufacturing steps, as Kodak advances (para. 497 SoR) does not alter that each of these parameters have an influence on the same properties, in a sometimes conflicting manner,

in particular press life on the one hand and image visibility, scumming resistance and deinking ability on the other hand. Thus, for example, where one solution to improve press life and another solution to improve image visibility were applied independently from each other, applying them both at the same time does not necessarily lead to the same improvement of each of these properties.

201. This is confirmed in the Examples in Table 2, as considered above. The Examples clearly show the interrelation between the various parameters, influencing the same properties (including press life and image visibility) in different ways (improving one property may be detrimental to another) and also not always linear. When assessing inventive step, the parameters and the values as claimed therefore need to be considered in combination, and not separately as Kodak asserted.

202. There is therefore no indication to deviate from the general principle that a claim should be looked at as a whole.

#### *TBA Case Law on optimisation of parameters*

203. The TBA Case Law referred to by Kodak on optimisation of parameters (Case Law of the TBA of the EPO, 10<sup>th</sup> edition, para. 9.17, page 284/285) does not lead to a finding of lack of inventive step. This line of case law on optimisation of parameters relates to situations where two opposing parameters need to be balanced. In the case at hand, at least four different parameters influencing four desired properties are involved.

#### *Combination with common general knowledge*

204. Each of the starting documents is primarily concerned with printing durability (long press life) and on-press developability. They all describe lithographic printing plate precursors with an aluminium plate and an anodized aluminium film with micropores having certain dimensions. Neither of the starting documents discloses Lightness, steepness  $\alpha$  45 and specific surface area  $\Delta S$ . Kodak's allegation (para. 115 KFP) that "*it is not unlikely that they will be inherently fulfilled*" has not been substantiated and can therefore not lead to a finding of obviousness.

205. Kodak as a second line of defence asserts that starting from the starting documents the Lightness  $L^*$  of feature 1.3.6 was obvious in combination with common general knowledge of the skilled person as at the priority date.

206. It can be accepted that it was common general knowledge that image visibility generally was beneficial in on-press development and that it was possible to measure lightness of surfaces using the  $L^*$  value in the  $L^*a^*b^*$  colour system. This must, however, be distinguished from knowledge *how* a certain degree of Lightness  $L^*$  (of 70-100 as claimed) may be achieved. Whilst it can also be accepted to be general common knowledge that image visibility could be achieved when the contrast and therefore the lightness *difference* between exposed and unexposed portions of the image recording layer is increased, it has not been shown that it was common general knowledge to obtain increased image visibility in the manner as claimed by the Patent, i.e. by adjusting the surface of the anodized film on the aluminium substrate such that a lightness value of  $L^*$  70-100 is obtained. Whether this alternative (e.g. to the use of colour formers) was inventive is another matter, contrary to what Kodak suggests (para. 133 KFP).

207. To substantiate common general knowledge of feature 1.3.6, Kodak has referred to an expert opinion of Dr. Jung (Exh. T32). He has declared that it was common general knowledge that it was common practice to use an aluminium substrate which has an aluminium oxide layer on its

surface, which is as light (grey) as possible. He has only referred to one document (ISO/IEC 11664-4), which was however not submitted in the proceedings, and only in relation to the statement that the L\*a\*b\* colour system has been used since 1976. In addition, Dr. Jung has not explained how this 'as light (grey) as possible' surface would commonly be achieved. Dr. Jung's statement therefore cannot support Kodak's allegation that common general knowledge would lead to feature 1.3.6. Hearing Dr. Jung – as offered – cannot alter that insufficient facts have been brought forward to prove the alleged common general knowledge.

208. The declarations of [REDACTED], a Kodak employee (Exh. T34, T75), are about the correlation between L\* and O.D. (optical density) values, being two parameters to measure lightness of a surface, as well as the measurement of lightness of existence commercial printing plate precursors at the priority date, including Sonora plates, having a – retrospectively measured – lightness L\* in the required range (para. 381 SoR). It has, however, not been shown how that was achieved, nor that the skilled person has been aware of that.

209. Even if it were industry practice since at least 2002, as asserted by Kodak (para. 365 SoR), it has not been shown that this industry practice included the knowledge to obtain increased image visibility in the manner as claimed by the Patent, i.e. by adjusting the surface of the anodized film on the aluminium substrate such that a lightness value of L\* 70-100 is obtained. Also commercial printing plate precursors known at the priority date cannot show common general knowledge, as it is not substantiated that the skilled person was aware of these properties and their effects, neither that the skilled person would employ the claimed parameters in the claimed combination as a matter of course.

210. Insofar as Kodak wished to maintain that the alleged common general knowledge is shown by the patent documents EP'262 (Exh. T36), EP'541 (Exh. 37), JP'090 (Exh. 38), EP'968 (Exh. T39) and JP'459 (Exh. 45/45a), this must be rejected. Common general knowledge does not normally include patent documents. However, common general knowledge may be considered to exist if a series of patent specifications provides a consistent picture that a particular technical procedure was generally known and belonged to the common knowledge. That is not the case here. EP'262 cannot support the alleged common general knowledge as it does not refer to lightness of the anodised film. JP'459 only discusses lightness in the context of laser energy efficiency and not image visibility. The remaining three documents are insufficient to constitute a series of patent documents providing a consistent teaching that image visibility may be improved by adapting the anodized film such that its surface has the required L\* value of 70-100.

#### *Motivation*

211. It follows that the skilled person requires a pointer that would lead the skilled person to implement the missing features of 1.3.6 as well as 1.3.7 and 1.3.8.

212. The MLD rightly considered that in EP'452, EP'408 and JP'021 there is no motivation to modify the lightness of the aluminium substrate in order to enhance image visibility. Contrary to the MLD, a general motivation for considering visibility of a print-out image based on common general knowledge that image visibility could be achieved when the contrast and therefore the lightness *difference* between exposed and unexposed portions of the image recording layer is increased does not alter that.

213. Each of the starting documents already contain suggestions how to achieve image visibility.

214. EP'452 (Exh. T41) in para. [0224] suggests that the image recording layer may contain other ingredients, including colorants. It states that *"In particular, addition of colorants such as dyes or pigments which provide a visible color to the image recording layer and remain in exposed areas of the image recording layer after the processing step is advantageous. Thus, image areas which are not removed during the processing step form a visible image on the printing plate, and examination of the printing plate developed already at this stage becomes feasible."*
215. EP'408 (Exh. T2) similarly in para. [0301] suggests that *"Various other compounds than those mentioned above may optionally be added to the image recording layer. (...) such as colorants, printing-out agents, (...) may be used. "*
216. JP'021 (Exh. T42 and 42a) likewise in para. [0116] teaches that *"The image recording layer may further contain other components. (...) Particularly advantageous is the addition of colorants, such as dyes or pigments, which give the image-recording layer a visible color and which remain in the exposed areas of the image-recording layer after the processing step. The image areas that are not removed during the processing step thus form a visible image on the printing plate, making it possible at this stage to inspect the already developed printing plate."*
217. The suggested solution for image visibility as an advantageous property in on-press development thus concerns additions to the image recording layer to create a better contrast. There is no indication that the skilled person would consider the measures suggested in these starting documents to be insufficient, and would be motivated to enhance image visibility even further in another way, let alone be motivated to consider amendments to the aluminum surface of the substrate. Documents like EP'452, as Fujifilm argues (para 310 FFP), teach that the image recording layer can be modified, for example in order to achieve a contrast, but do not teach or suggest that the aluminum surface of the substrate can be modified, or that lightness of the support can be modified.
218. Kodak with reference to para. [0008] of EP'541 states (para. 428 SoR) that at the priority date, known agents produced only weak colour changes and very few were in use. However, this document is from 2005, long before the priority date (2017) and it has not been shown that this was (still) common general knowledge of the skilled person at the priority date of the Patent; common general knowledge – as indicated above – in any case generally not being established by reference to a patent document (here EP'541). Kodak's allegation is also contrary to its statements on the fundamentals of offset printing that belonged to the skilled person's common general knowledge (para. 179 et seq SoR) where Kodak stated that for producing a print-out image colour formers are *conventionally* used (para. 184 SoR). [REDACTED]
219. A 'commonly felt need in the prior art' to improve image visibility at the priority date, as suggested by Kodak (para. 376 SoR), beyond the measures suggested in the starting documents, has not been shown. Reference to the object of two patent applications (para. 378 SoR) cannot prove a *commonly* felt need in the technical field.
220. Kodak's argument that the skilled person would find motivation to further enhance image visibility in EP'968, EP'541, JP'090 and/or JP'459 cannot be accepted. Starting from one of the starting documents, the skilled person first requires a reason / pointer to consult EP'968, EP'541, JP'090 and/or JP'459 in his search for the solution to his problem. The pointer / reason to consult must find its basis in the starting document, also considering the skilled person's common general knowledge, but cannot be derived from EP'968, EP'541, JP'090 and/or JP'459 themselves. As will

be explained below, there is no pointer / reason to combine the starting documents with EP'968, EP'541, JP'090 and/or JP'459. Therefore, a motivation to further enhance image visibility cannot be derived from the content of such a document. Doing so would amount to a hindsight analysis, as it presupposes that the skilled person already knows which solution he has to find. The same reasoning applies to Kodak's suggestion that the skilled person would find motivation to employ the steepness  $a_{45}$  of feature 1.3.7 and/or specific surface area  $\Delta S$  of feature 1.3.8 from these combination documents (para. 455 SoR).

*Combination with EP'968, EP'541, JP'459, JP'090 or JP'264*

221. The starting documents EP'452, EP'408 and JP'021 teach that the two-portion shape of the micropores in the anodised film, with certain dimensions, enhance press life, while still achieving a balance with other printing plate properties scumming resistance (JP'090) and deinking ability (EP'408) or both (EP'452). None of them is particularly concerned with image visibility, beyond the paragraphs stated above in para. 214-216.

222. Even if the skilled person would combine any of the starting documents with any of the prior art documents EP'968, EP'541, JP'459, JP'090 or JP'264, it would not lead to the invention as claimed in claim 1, even if the (alleged) difference in manufacturing conditions disclosed in the various documents would not be a reason to prevent a skilled person from combining them. This will be explained below.

*EP'968*

223. The skilled person would have an interest in EP'968 in view of the problem it sets to solve, being excellent image visibility (para. [0016]). The solution presented is a white substrate having a reflection density value of 0.25 or less and the image recording layer contains an infrared absorbing agent, an onium salt polymerisation initiator, a polymerizable compound and a colour-forming compound and is capable of being removed with at least any one of printing ink and dampening water (para. [0019]). It has not been disputed by Fujifilm that a reflection density of 0.25 or less will be understood by the skilled person as an  $L^*$  value of more than 80%.

224. Para. [0022] describes two examples of a white substrate. The first example is a substrate having a white layer provided on an aluminium support. The second example provides for the white substrate to be an aluminium support, which is subject to a roughening treatment and anodizing treatment so as to have a steepness  $a_{45}$  value of 30% or less.

225. When presented with the options in EP'968 – which both have advantages and disadvantages, as is clear from the parties' statements in this respect – in view of the skilled person's objective to provide a printing plate precursor with excellent image visibility *and* a long press life, he wishes to improve image visibility without impairing the improved press life (while maintaining on-press developability) as achieved by the specific aluminium support with a pore structure suggested by the starting documents. The skilled person would therefore not wish to adjust the surface of the image recording layer according to example 2 that would impact the surface structure, but rather follow up on example 1, which also obtains good results in terms of image visibility. Consequently features 1.3.7 and 1.3.8 would not be achieved already for that reason. The fact that EP'968 presents the examples as equal alternatives does not alter that; EP'968 is not concerned with press life, but the skilled person is.

226. Even if the skilled person would select the second example to follow-up, it would not lead to the invention of the Patent. Para. [0026] of the description of EP'968 states that for measurement

of the surface, and thus for steepness a45, 512 x 512 points on the surface of 50 x 50 µm are measured, which the skilled person understand leads to a resolution of 0.1 µm (and the skilled person understands that the stated resolution of 1.9 µm is an obvious mistake, see para. 142 above). In the Patent, the 512x512 points are measured in the smaller area of 25x25 µm, with a resolution of 0.05 µm (see para. 142 above). As Fujifilm has rightly noted (para. 533 SoGA et seq) this means that the distance between the 512 x 512 points in the measurement according to the patent (the resolution) is  $25\mu\text{m} / 512 = 0.05\mu\text{m}$ , which is half of the distance compared to EP'968, which is  $50\mu\text{m} / 512 = 0.1\mu\text{m}$ . This indicates that the printing plate precursor disclosed in EP'968 can have and generally has a rougher / less smooth surface than that obtained with the steepness of 30% or less when measured with a resolution of 0.05 µm, as required by the invention. That is because no measurements are available over a larger distance between the measurement points, so peaks in between those points will not be picked up, while they would be if measured at a higher resolution – i.e. a smaller distance between measurement points. The same steepness a45 percentage at a higher resolution thus ensures a smoother surface, than when measured at a lower resolution. In other words, the printing plate precursor disclosed in EP'968 can have and generally has a higher steepness a45 when measured at a resolution of 0.05 µm and thus can have and generally will have a rougher surface. Consequently, Kodak has not convincingly shown that combining any of the starting documents with EP'968 would lead the skilled person to the claimed invention.

227. Kodak's allegation that the resolution with which the steepness must be measured is not in claim 1 of the patent and therefore the claim is not limited in this respect is rejected. The claim must be read in light of the specification. The skilled person is well aware that the numerical values provided by steepness a45 (and  $\Delta S$ ) depend on the resolution used when measuring these values, as it has itself argued in relation to infringement with reference to Sawada (Exh. T5/5a) and in para. 511 SoR. The skilled person will therefore understand the steepness a45 and  $\Delta S$  values required by claim 1 to be as measured with the resolution given in the description.

228. Kodak's further argument (para. 173-175 KFP) that inventive step cannot reside in the chosen size of measurement field of 25x 25 µm square rather than 50x50 µm square as disclosed in EP'968 is beside the point and flawed. The steepness a45 value measured at a certain resolution – which is determined by the number of measurement points in a certain area – indicates a certain degree of roughness of the measured surface. Thus, claim 1 does not protect the size of measurement field, but the degree of roughness of the surface as defined by the steepness a45 value of  $\leq 30\%$  as measured with a resolution of 0.05 µm. The surface of the substrate disclosed in EP'968 is defined by a steepness value of  $\leq 30\%$  measured with the different resolution of 0.1 µm and thus has a different degree of roughness than the surface of the precursor of claim 1 the Patent. The degree of roughness of a surface indeed has a technical effect, as shown in Table 2 of the Patent.

229. The skilled person also has no motivation to alter the steepness value given in EP'968, since this is the very parameter that provides the Lightness that was the solution to the problem that EP'968 was to solve.

230. In EP'968 there is furthermore no disclosure of feature 1.3.8 and neither a pointer to implement it.

#### *EP'541*

231. Kodak has advanced that the skilled person alternatively combines any of the starting documents with EP'541. This document has as its object to provide a method for making a lithographic printing plate by means of a heat-sensitive precursor which forms a high contrast

print-out image immediately after exposure to infrared light and would thus be of interest to the skilled person.

232. EP'541 proposes a combination of three measures, being (1) the support of the plate precursor is an aluminium support with a grained and anodized surface that appears essentially white, i.e. which has lightness values  $L^*$  higher than 70; (2) the visible light absorption of the coating on said support is low, so that the complete material (i.e. support + coating) has a lightness value  $L^*$  which is not less than 50; (3) a visible colour is formed or changed by the exposure, whereby a print-out image is formed of which the lightness difference  $DL^*$  is at least 5;  $DL^*$  being the lightness value  $L^*$  at non-exposed areas minus the lightness value  $L^*$  at exposed areas.
233. The skilled person learns that image visibility can be improved by a combination of these features, which includes adjusting the anodised film as protected in feature 1.3.6. The additional other measures that are suggested to improve image visibility do not prevent that the combination could lead to the lightness as required by feature 1.3.6. Even so, EP'541 is not concerned with either steepness  $a_{45}$  or specific surface area  $\Delta S$ . It has not been shown how this route would lead the skilled person to features 1.3.7 and 1.3.8, which have not been disclosed in EP'541, failing any pointer in that direction.

#### *JP'459*

234. JP'459 is concerned with image formability by infrared exposure, which requires improvement (para. [0005]). The object of JP'459 is to provide a positive-working lithographic printing plate precursor that has high sensitivity and can be directly processed by infrared scanning exposure based on digital signals, and is excellent in the reproducibility of an image portion, particularly a high-definition image (para. [0006]). Image visibility in the context of improved contrast between the image and non-image areas is not discussed in JP'459, it only discusses lightness in the context of laser energy efficiency (in para. [0009]).
235. The skilled person would not consult this document when searching for a solution to his problem of achieving excellent image visibility and press life. The mere fact that JP'459 (in para. [0092]) mentions that a print-out agent for obtaining a visible image immediately after heating by exposure or a dye or pigment as an image colorant can be added to the photosensitive layer according to the present invention, would not change that, since the skilled person would realise this solution is the same one as already applied in the starting documents and it would not help him any further. There is no incentive to apply the measures suggested in JP'459, as these provide a solution to a problem that the skilled person does not try to solve.
236. The JP'459 document is also not a document that the skilled person would consult because that document deals with scumming resistance, as Kodak asserts (para 488/489 SoR). The object of the Patent is not to improve scumming resistance, but to improve image visibility while maintaining other properties, in particular press life, but also scumming resistance and deinking ability in view of the balancing of the required properties of a printing plate (see para. 190 et seq. above). Insofar as it is mentioned in the patent description that scumming resistance is excellent, that would rather be a confirmation that it is not impaired, or if improved it is at most a bonus effect. Thus, JP'459 cannot be considered a document that the skilled person would consult and cannot lead to obviousness.
237. In addition, even if JP'459 would be consulted, it suggests roughening of the surface of the aluminium substrate, leading to a considerably smoother surface, which impairs press life. JP'459 is not concerned with press life but it would be a concern for the skilled person who wished to

improve image visibility and a long press life, thus withholding him from applying the surface treatment suggested in JP'459.

238. Even if the skilled person would nevertheless consider JP'459 because it discloses that the whiteness of the support surface is high and the light reflectivity is excellent – albeit in the context of infrared laser used for image-wise exposure not being easily absorbed by the support, and being reflected by the surface and absorbed by the photosensitive layer – then still it would not lead to the invention according to the Patent.

239. The surface treatment according to JP'459 leads to a lightness  $L^*$  value of 80 to 94, which discloses feature 1.3.6. However, features 1.3.7 and 1.3.8 are not disclosed. JP'459 teaches that the required steepness  $a_{45} \leq 20\%$  is obtained by extracting the components of wavelengths 0.02-0.2  $\mu\text{m}$  (para. [0007]) while feature 1.3.7 claims steepness  $a_{45}$  as determined by extracting components with a wavelength of 0.2-2  $\mu\text{m}$ . This means that different surface structures are considered for measuring steepness  $a_{45}$  and which thus indicate a different surface roughness than that protected by claim 1. Extracting the components of wavelengths 0.02-0.2  $\mu\text{m}$ , more unevenness is detectable, and the surface appears rougher. The required  $\Delta S$  value of 5% or more (rather than 20-40% as required by claim 1 of the Patent) in JP'459 also relates to the wavelength of 0.02-0.2  $\mu\text{m}$  and not to the *entire* surface area, and thus is a different parameter, again indicating a different surface roughness.

240. The steepness  $a_{45}$  and  $\Delta S$  being measured at different wavelengths and thus indicating different roughness of the surface, Kodak's assertion (para. 176 KFP) that in JP'459 "the observed effects and trends are again the same" must be rejected, for lack of substantiation.

#### *JP'090*

241. JP'090 mentions that it has been required more than ever to improve plate performance such as sensitivity and exposed image visibility (para. [0005]). The object of JP'090 is to have a plate having a uniform grain with high whiteness, excellent plate-making performance such as sensitivity, fine line reproducibility, exposure visible image performance, and stain resistance (para. [0009]). This is solved by combining specific conditions for treatment with alkali before and after electrolytic surface roughening treatment in an electrolytic bath mainly containing nitric acid (para. [0010]). According to Table 1 showing the results of the examples, with a "Grain Color  $L^*$  value" between 78 and 79.5 the "Exposed Image Visibility" is valued as "The pattern of the chart can be clearly seen" (para. [0051]), thus well within the range of feature 1.3.6.

242. However, JP'090 mentions neither steepness  $a_{45}$  nor specific surface area  $\Delta S$ , so it cannot be seen and has not been explained how this document would lead the skilled person to features 1.3.7 and 1.3.8.

#### *JP'264*

243. The object of JP'264 is to provide a lithographic printing plate precursor that, when used as a lithographic printing plate, has excellent printing durability and stain resistance, and is less likely to cause ink entanglements and inking defects in solid areas when a coated recycled paper is used.

244. It is not concerned with image visibility. Kodak has not convincingly explained why the skilled person would be motivated to consult this document when trying to solve his problem of obtaining image visibility and a long press life. Even if it would be clear to the skilled person from para. [0003] of JP'264 that 'staining' would cover 'scumming' and the document thus covers

scumming resistance, as Kodak asserts (para 198 KFP), then it would still not be a document that the skilled person who tries to solve his problem of improving image visibility would consult, for the same reasons as set out above (para. 236).

245. Even if JP'264 would be consulted, it would not lead the skilled person to claim 1 of the Patent.

246. JP'264 discloses a printing plate support subjected to roughening treatment with a certain  $\Delta S$  and steepness  $a_{45}$ . These are however measured at a resolution different from the patent in suit, where 512x512 points in 25  $\mu\text{m}$  square of the surface are measured (thus with a resolution of 0.05  $\mu\text{m}$ ). The support of claim 1 of JP'264 has a  $\Delta S$  of 20 to 35% and steepness  $a_{45}$  obtained by extracting components with a wavelength of 0.2 to 2  $\mu\text{m}$  of 10-30%, both obtained by measuring 512 x 512 points of 50  $\mu\text{m}$  square, thus with a resolution of 0.1  $\mu\text{m}$ . As explained above, the printing plate support disclosed in JP'264 thus has a rougher / less smooth surface than that obtained with the steepness of 30% or less when measured with a resolution of 0.05  $\mu\text{m}$ , as required by the invention. This applies similarly to the  $\Delta S$  value.

247. The embodiment according to claim 2 has a steepness  $a_{45}$  of 5 to 20% and  $\Delta S$  obtained by measuring 512 x 512 points of 5  $\mu\text{m}$  square, thus with a resolution of 0.01  $\mu\text{m}$ . The embodiment of claim 3 has a  $\Delta S$  obtained by extracting components with a wavelength of  $\geq 0.02 \leq 2 \mu\text{m}$ . The steepness  $a_{45}$  and  $\Delta S$  as disclosed in JP'264 therefore do not amount to a disclosure of steepness  $a_{45}$  and  $\Delta S$  as required by claim 1 of the patent in suit, while the  $\Delta S$  in the embodiment of claim 3 is not measured over the entire surface area as in the Patent. Since the  $\Delta S$  is also differently, it is not apparent, and Kodak has not shown, that the values as defined in JP'264 are within the range claimed by the Patent.

248. A combination with JP'264 therefore would not lead the skilled person to a printing plate precursor with all features of claim 1. Kodak has not substantiated its allegation that despite the difference in resolution indicating different surface roughness "the effects and trends are the same". This cannot be seen in JP'264 already because it does not report the effects on image visibility.

249. While Kodak has also not explained why the skilled person after combining with JP'264 is motivated to still perform 'routine optimisation following the principles which are taught in JP'264' with a reasonable expectation of success – given the different and conflicting effects that changing the parameters may have – and why he would arrive at the claimed ranges without inventive skill.

250. Finally, JP'264 does not disclose lightness  $L^*$  with a value of 70 to 100 (feature 1.3.6). Kodak has not explained how the skilled person would arrive at this feature, it not being common general knowledge.

#### Conclusion on validity

251. None of the added matter, novelty and inventive step attacks by Kodak are successful. Claim 1 of the Patent must be considered to be valid. This means that a decision on the validity of the claims dependent on claim 1 is not required for lack of legal interest on the part of the revocation counterclaimant (cf. UPC-CoA-302/2025, 305/2025, 17 February 2026, Rematec v @ para. 91). It also follows from the validity of claim 1 that the novelty and inventive step attacks against method claims 10 and 11 of the set of claims as limited, that incorporate the features of claim 1, fail as well. There is thus no need to discuss the ARs. Consequently, Kodak's requests in the counterclaim

for revocation are not successful and shall be dismissed. The patent is to be upheld in the version that results from the the central limitation proceedings.

## **INFRINGEMENT**

### German designation

#### Direct infringement of claim 1

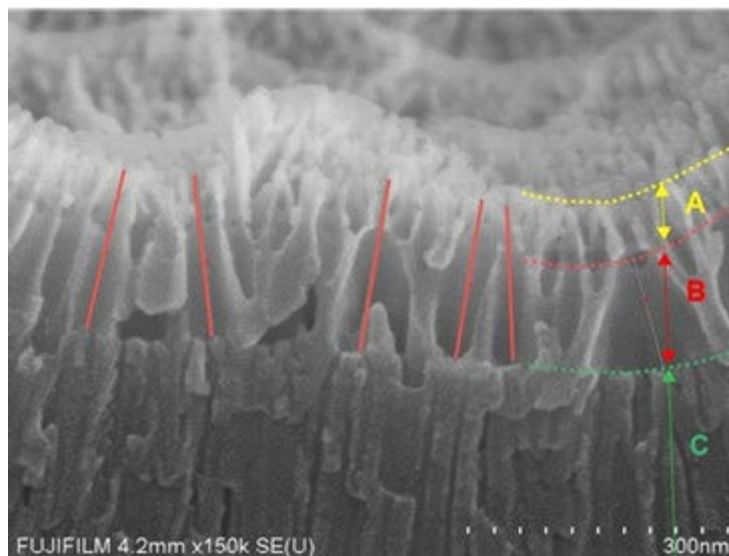
##### *Measurements in relation to all Sonora plates*

252. For proof of infringement, Fujifilm relies on Analysis Report EP 3 476 616 filed with its SoC as Exh. K15. In this report, the Attacked Embodiments are Samples #1-3. Regarding the analysis of the average diameter of micropores at the surface of the anodised film, Exh. K15 on page 13 to 24 explains how the analysed samples were taken from the sample product and prepared for analysis. An FE-SEM at a magnification of 150,000X was used to obtain 4 images, the quality of which was enhanced by using image analysis software ImageJ. For each image a total of 50 micropores in a measurement area of 400 x 600 nm were measured, by calculating equivalent circular areas. The measurements resulted in average diameters at the surface of 23 nm, 21 nm and 24 nm for each of the attacked embodiments respectively.
253. Kodak (para. 802 SoR, with reference to SoD para. 74-76 and Rejoinder 65-89) criticises the measurements in the Analysis Report (Exh. K15) because Fuji has used image processing and remastering which was not specified in the patent, and asserts that the processed images cannot be used as proof of infringement. This must be rejected.
254. The fact that the patent specification only prescribes that the surface of the anodized film 20a is observed with a field emission scanning electron microscope (FE-SEM), does not exclude the use of image processing/treatment software that is customary in the technical field to improve the quality of the obtained images, as indeed shown by the fact that this software is mentioned in connection with FE-SEM measurements in (also older) patent applications in this field.
255. Kodak noted that the ‘possibilities for alteration’ are virtually endless and any result is possible, but has neither stated nor shown that any actual modification or manipulation of the images has occurred, or that the measurements would be different if the non-processed images were used. It can clearly be seen by comparing the non-processed and processed SEM images that Fujifilm has only improved the contrast and sharpness in the images. The original surface data is not altered. There is therefore no reason to disqualify these images as valid proof of infringement.
256. Kodak furthermore argues that the measurements of feature 1.3.7 (steepness  $\alpha_{45}$ ) and of feature 1.3.8 (surface area  $\Delta S$ ) are not correct, because these are performed at a resolution of 0.05  $\mu\text{m}$  instead of 1.9  $\mu\text{m}$  (SoR para. 817-825). This is without merit since – as considered above – the skilled person understands that the resolution of 1.9  $\mu\text{m}$  is an obvious mistake and that a resolution of 0.05  $\mu\text{m}$  was meant. Fujifilm therefore rightly measured with the resolution of 0.05  $\mu\text{m}$ .
257. Apart from the quality enhancement, resolution used and measured positions, which will be discussed below, Kodak has not criticised the measurement methodology used by Fujifilm in its Analysis Report K15 for the measurement of the average diameters of the large- and small-diameter portions of the micropores.

258. There not being any further defences against the infringement by the Sonora X and Sonora Xtra-2 plates, the conclusion is that these fall within the scope of claim 1.

#### *Sonora Xtra-3*

259. The first line of Kodak's attack on infringement of the Sonora Xtra-3 plates (SoR para. 774-779) is that the Sonora Xtra-3 anodised film is divided into three layers (as shown in the figure in para. 122 above) prepared by three anodisation steps, whereby the portions formed in the first anodisation step are partially dissolved in the subsequent anodisation step to remain as spikes in layer A. According to Kodak, the large-diameter and small-diameter portions are incorrectly measured in Fujifilm's Analysis Report, because the portions should be assigned in accordance to the layer structure caused by the manufacturing process, so that for the depth of the large-diameter portion of feature 1.3.4 it was wrong to measure the depth of layers A and B as shown below in Exh. K15 Annex 1c p.33 (with indication of the layers A, B and C added by Kodak).



260. As considered under claim construction, the manufacturing process is irrelevant to claim 1 (see above, para. 114-120). There is therefore no reason to distinguish a separate layer A and layer B in the Sonora Xtra-3 plate based on the anodisation process. The only relevance is that the depth should be measured from the surface to the bottom of the large-diameter portion, where the small-diameter portions begin. Kodak has rightly not disputed that the pores in layer C can be considered the small diameter pores. As discussed under claim construction, the 'spikes' must be considered as being part of the large-diameter portions which indeed extend from the surface of the anodised film. It follows that what Kodak refers to as layers A and B must together be considered to form the large-diameter portion.

261. Consequently, Fujifilm's measurements for depth D in feature 1.3.4, spanning across the layers identified by Kodak as Layers A and B are correct. It is clear from Exh. K15 that Fujifilm measured both the average diameter of the (large-diameter portion of the) micropores at the surface of the anodised film (1.3.3 / 1.3.5), as well as the aperture average diameter of the small diameter portion at the communication position (1.3.5) at the right positions, see pages 20-24 and 28-31 respectively. Kodak's arguments that Fujifilm did not measure at the right positions of the micropore (SoR para. 812-815) must thus be dismissed.

262. As is clear from the image shown above, the depth of the large-diameter portion is clearly distinguishable from the depth of the small-diameter pores. It cannot be seen that Fujifilm

arbitrarily allocated separate void volumes at its own discretion to arrive at the value of feature 1.3.4, as Kodak submits (para. 780, 782 SoR).

263. Neither can it be seen if layers A and B together would be considered to form the large-diameter portion. Because of the largely dissolved pore walls in layer A there would not be a continuous void volume extending from the surface of the anodised film specified in feature 1.3.4 (SoR para. 748, 780, 787, 792) 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 film and thus have no opening in the surface (SoR para. 792). As explained under claim construction, the spikes form part of the large-diameter portion 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. 125 above).
264. 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 (SoR para. 788-791), 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.
265. Kodak's allegation that the spikes are not extensions of the core structure below (of layer B) but distributed independently of the pore walls below (SoR para. 795) 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, spikes do in fact extend from the material surrounding an opening of a pore.
266. It further follows from what has been considered under claim interpretation (see para. 121-125) 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 (SoR 793, 796-797), is flawed.
267. That it is required but impossible to unambiguously recognize the original form of the pores in layer A of the attacked embodiment before their walls are dissolved, and that the distance between the peaks of two spikes is not necessarily a diameter as Kodak submits (SoR para. 798-801) 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.
268. Kodak's suggestion (para. 802) that Fujifilm's measurements do not equate the distance between two opposing spikes but rather 'the alleged diameters of artificially created geometrics via image manipulation of the SEM micrographs', has not in any way been substantiated by pointing to any of Fujifilm's measurements that would allegedly be incorrect, or by submitting any measurements of its own, showing results different from those relied on by Fujifilm.
269. 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 further submits (SoR para. 803 et seq) is not relevant because the claim does not require that one large-diameter pore can have only one opening (see under claim construction para. 126-131 above). Kodak has also not shown

that in Analysis Report (Exh. K15) pores associated with more than one opening in the attacked embodiment exist, let alone have been part of the measurements.

270. It follows that neither of Kodak's defences against infringement by the Sonora Xtra-3 plates is successful.

### *Conclusion*

271. The above leads to the conclusion that all Sonora plates fall within the scope of claim 1 of the Patent.

### Indirect infringement of claims 10 and 11

272. Pursuant to Art. 26 UPCA, a patent shall confer on its proprietor the right to prevent any third party not having the proprietor's consent from supplying or offering to supply, within the territory of the Contracting Member States in which that patent has effect, any person other than a party entitled to exploit the patented invention, with means relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or should have known, that those means are suitable and intended for putting that invention into effect.

273. In its SoC (para. 198-202) Fujifilm showed that in the "*White Paper 'Kodak's Press Ready Technology in SONORA Process Free Plates'*" (exh. K20), Kodak describes for potential costumers how the Sonora plates are to be used. Kodak has not disputed this.

274. Since it follows from the above (para.251-270) that the Sonora plates fulfil all features of claim 1, Fujifilm rightly argues that the Sonora plates are means relating to an essential element of the invention. It is obvious that Kodak knows that the Sonora plates are suitable and intended for use in accordance with the method of manufacturing a lithographic printing plate according to claim 10 and the printing method of claim 11 of the Patent.

275. Fujifilm furthermore undisputedly stated that it follows from Exh. K20 that the customers when preparing printing plates from Sonora plates and using these when printing in accordance therewith inevitably carry out the methods of claims 10 and 11 and that Kodak was aware that it was the purpose of the Sonora plates - and even recommended - that these were being used by costumers in accordance with the methods of claims 10 and 11 of the Patent, which basically describe the preparation for and carrying out of the on-press development process.

276. The conclusion is that Kodak is therefore also indirectly infringing claims 10 and 11 of the Patent.

### Private prior use

#### *Principles*

277. 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.*"

278. 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.

279. 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.. (...).*

280. 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*).

281. 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*).

282. 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*).

283. 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).

284. 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.

285. 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).

286. 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).

287. 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).

288. 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*

289. Kodak claims a private prior use right for all Sonora plates (including Sonora Xtra-2 and Xtra-3) based on the possession of the Sonora X plates before the relevant priority date.

#### *Sonora X plates*

290. 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 Fujifilm's infringement analysis (Exh. K15), witness statements, various documents and measurements of retained plates originating from batches produced prior to the priority date.

291. With its Rejoinder, Kodak uploaded experimental reports containing measurements of pore diameters and surface characteristics of 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 among other Laserline).

292. These exhibits and written declarations in relation thereto were disregarded by the MLD, but the Court of Appeal uses its discretion in accordance with 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.

293. Kodak in its SoD, as substantiation of its private prior use defence, relied on the measurements of a Sonora X plate presented by Fujifilm (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 (K15) and that consequently, the Sonora X plates produced prior to the priority date, had all the features of claims 1 as granted.

294. 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.

295. The same reasoning applies to para. 91-200 of Kodak's Rejoinder and Exh. T55-T72 and T14.2 filed with the Rejoinder, as well as Exh. A4-A6 filed on appeal, with which Kodak responded to Fujifilm's challenges of Kodak's private prior use defence.

296. The following can be derived from the evidence presented by Kodak.

[illegible]

[REDACTED]

[REDACTED]

298.

[REDACTED]

[REDACTED]

[REDACTED]

299.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

300.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

301. In an e-mail exchange dated [REDACTED] (Exh. T15), [REDACTED] approval for the renaming of the printing plate precursors developed under the project name [REDACTED] to 'Sonora X'.

302. As Exh. T16 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]*".

303. Kodak submits that it has distributed among its customers a [REDACTED] (Exh. T17). They are informed that:

[REDACTED]

[REDACTED]

304. The Bulletin also mentions [REDACTED]

305. As Exh. T68 and T69, 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's 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. T70 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).

306. From this evidence thus follows that on 18/19 April 2017, printing plate precursors were produced consisting of the [REDACTED] substrate, coated in-line with [REDACTED] of an image recording layer containing IR absorber [REDACTED] as an acid color former (batch #239185). About 2 months later, on 12 June 2017, 10 packages (300 plates) of this batch were sent to [REDACTED] for test purposes. Another two months later, on 28 August 2017, another batch (#253299) was produced, with the same [REDACTED] substrate and image recording layer, but this time with the IR absorber [REDACTED] (shown in column F in the laboratory journal of project T58, Exh. 11). A little less than 2 months later, on 12 October 2017, 12 packages of this batch (360 plates) were delivered to another customer, Laserline. Yet another 2 months later, the customers were informed [REDACTED]

307. 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 (see [REDACTED]). It cannot be accepted that this batch was already manufactured with the intention of selling the plates of this batch to customers under regular commercial conditions. Instead, the facts indicate that it was rather the intention to first test this composition with the IR absorber [REDACTED] before deciding in which composition the product would be commercialised. That is especially so since, [REDACTED]

[REDACTED] (see [REDACTED], para 300 above).

308. Clearly, the customer testing was this time by Laserline. The time line of the first customer testing, i.e. a period of about two months after production of batch # 239185, during which presumably internal testing was done, then delivery and testing by [REDACTED] and another two months before the next step was taken (the production of the next batch), is very similar to the time line of about two months after the production of batch # 253299 before delivery to Laserline, and then two months later the next step (the decision to commercialise the product in this

composition). The Court sees confirmation for the test character of the delivery to Laserline in the customer order number on the Laserline invoice, “[REDACTED]”, which refers to the [REDACTED] development project, rather than a customary order number or order date, as well as the similar number of test plates delivered to it (360; 300 to [REDACTED]).

309. From this it must be concluded that the manufacture of batch #253299 on 28 August 2017 was done within the framework of the development project [REDACTED] with a view to further testing for the purpose of being able to decide on the composition of the product to be commercialised. This is insufficient for it to qualify as actual commercial use of the invention. The fact that plates from this batch were later sold to customers, after the firm and final decision to commercialise this product had been taken, once all test results were (apparently) considered satisfactory, cannot change that. A later decision to commercialise cannot retrospectively qualify the manufacture on 28 August 2017 as a commercial use of the subject-matter of the Patent, as Kodak contends (para. 854-856 SoR).

310. That such a firm and final decision was taken and put into practice only thereafter is evidenced by the [REDACTED] of mid-December, announcing the market launch of the new plates [REDACTED] and by [REDACTED]: “[REDACTED]”. This is also confirmed by the billing list, which contains invoices as from mid-November 2017. The fact that the list of billing documents (Exh. T70) and further invoices presented by Kodak (T68 and T69) all relate to the same customer number /payer, and that the invoices do not have a customer order number but rather refer to the ‘Entnahme’ (withdrawal) during the previous two weeks, indicates that these deliveries do not relate to external customers but rather to internal deliveries within the Kodak Group, indicating stock piling of the new product that according to the [REDACTED] [REDACTED] will replace the Sonora UV plates [REDACTED].

311. An earlier decision to bring the Sonora X plates to the market in its final composition cannot be inferred from the [REDACTED] [REDACTED] (Exh. T61). Even though it appears that Kodak was certain that it would use the [REDACTED] substrate in the new Sonora X product, it is clear from the above that other components (in particular the IR absorber) had not been decided upon as these were still being tested. [REDACTED]  
[REDACTED] This implies that a decision to commercialise the Sonora X plate in its final composition was not made by then.

312. The [REDACTED] (Exh. T 14.2) does not lead to a different conclusion either. This is clearly a forward looking view on Kodak’s business development between 2017 and 2022. Where it states:

- [REDACTED]
- [REDACTED]

313. It cannot be inferred that commercialisation of a final product had already been decided. Rather, the first ‘[REDACTED]’ indicates that the project [REDACTED] had not yet been finalised [REDACTED], and only thereafter ‘[REDACTED]’ comes into play, since naturally commercialisation can only take place once a final product has been developed. This is

confirmed by the fact that [REDACTED]  
resistance are firmly men [REDACTED]  
[REDACTED]

314. This fits with further evidence submitted by Kodak. [REDACTED] in his second statement (Exh. A5) declared [REDACTED]  
[REDACTED]

315. Contrary to what Kodak argues (para. 893 SoR 2<sup>nd</sup> and 3<sup>rd</sup> bullet) it is not sufficient for the creation of a private prior use right that it had been decided to commercialise the XLT *substrate* with *an* image recording layer with *an* IR absorber, as [REDACTED] declared. Failing actual commercial use of the invention, this would require that before the priority date a firm and final business decision to commercialise a product implementing the invention had been taken *and* serious steps have been taken to put that decision into effect in the near future. Kodak has not shown the existence of such firm and final decision before the priority date. Even though [REDACTED], his statement is silent on when the decision was taken to commercialise the final Sonora X product, consisting of the [REDACTED] substrate and image recording layer with the IR dye [REDACTED], which were only brought together on 28 August for the first time.

316. The same considerations as those regarding the [REDACTED] (Exh. 14.2) apply to the [REDACTED] (Exh A6; para., 886-891 SoR), which is also a forward looking document. Use of wording such as [REDACTED] in the slides do not necessarily imply that the [REDACTED] project had been completed, as Kodak suggests. Clearly, a non-finalised project requires execution and investments too. [REDACTED] is mentioned under the heading of [REDACTED] and the same [REDACTED] slide is included as in Exh. 14.2, indicating that the improvements associated with the image recording layer had not yet been finally established.

317. Kodak has further referred to an earlier decision [REDACTED] but as Kodak itself said (para. 868 SoR), this was based on the decision to commercialise the [REDACTED] substrate component, not on the decision to commercialise the final product.

318. Kodak has referred to [REDACTED], but has not submitted this into the proceedings and therefore the assertion that [REDACTED] (para. 875 SoR) remains unsubstantiated. In addition, it does not find support in the witness statement of [REDACTED] (Exh. T57), General Manager of [REDACTED], who stated that [REDACTED] (emphasis added). This shows an expectation that [REDACTED] would be used, but does not support that a final decision to do so had already been taken by that time, as Kodak submits (para. 875 SoR).

319. Furthermore, [REDACTED]  
[REDACTED]

It also contradicts the testing of the [REDACTED] substrate with another IR dye ([REDACTED]) by [REDACTED] months thereafter, in June 2017, which would have been unnecessary had the final decision already been taken to use the IR dye [REDACTED] instead.

320. In addition, a firm and final decision on the use of the [REDACTED] substrate with an image recording layer containing [REDACTED] even before testing had shown that combination to be satisfactory cannot be reconciled with the extensive testing Kodak performed on both the [REDACTED] substrate, the IR dyes as well as the previous combination of [REDACTED] substrate with IR dye [REDACTED] by [REDACTED], which despite promising first results proved to be unsatisfactory with time. It is not credible that after such extensive testing and the disappointing results with the testing with IR dye [REDACTED] which only became apparent over time, Kodak would have decided to commercialise a new combination of [REDACTED] substrate and IR dye without having done any testing to confirm its proper performance over a certain period of time.

321. The conclusion from the above considerations is that Kodak cannot rely on a private prior use right in relation to the Sonora X plate and therewith neither in relation to the Sonora Xtra-2 and Xtra-3 plates.

#### Conclusion on infringement

322. It follows from the above that all Sonora plates fall within the scope of claim 1 and Kodak cannot rely on a private prior use right in relation to any of these plates. Kodak has not contested that under these circumstances all Kodak companies are infringing the German designation of the Patent.

#### UK designation

#### Accepting Jurisdiction

323. The MLD did not accept jurisdiction to decide on the validity of the UK designation 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.

324. 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*

325. 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 without success argues 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.

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

327. Article 71a Br I provides that for the purposes of the Br I 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 regulation, the UPC is a Common Court (Article 71a (2)(a) Br I).
328. Pursuant to Article 71b(1) 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.
329. 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, as will be explained below.
330. According to Art. 3 (c) UPCA, among the matters 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).
331. The fact that Art. 34 UPCA is not meant to confine the UPC’s jurisdiction to UPC territory only, also follows from Article 71b(3) Br I, which explicitly provides the UPC with long arm jurisdiction (see also COM/2013/0554 final at 1.2 and 3.3).
332. 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.
333. The MLD was therefore right to consider that Art. 34 UPCA did not exclude its jurisdiction over the UK designation of the Patent.
334. The CJEU has recognised that the Brussels Regulation should be applied consistently with international law principles including comity.
335. 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 Brussels 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.
336. Where a court has jurisdiction under Article 4 Br I because the defendant is domiciled in its territory, as is the case in the present proceedings, the Br I 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).

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

338. This approach has recently been endorsed by the CJEU in *BSH v Electrolux*. In that judgment it ruled that Article 24(4) Br I 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.*

339. 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.

340. 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.

341. These arguments must also be dismissed.

342. Accepting jurisdiction in the infringement action vis-à-vis a defendant domiciled in the UPC’s territory based on Article 4 Br I 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 does not subsequently lose that due to a later invalidity defence. 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, 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*

343. 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. This argument is rejected.

344. 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 71b(1) of Br I). 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).

345. 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.

346. 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*

347. 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.

348. 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*

349. As considered above, accepting jurisdiction if and when conferred on it by Art. 4 Br I, 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*

350. From the above considerations, it follows that the MLD was right to reject Kodak's preliminary objection and to accept jurisdiction vis-à-vis the Kodak companies in relation to the alleged infringement of the UK designation. Kodak's appeal from this decision must be dismissed.

### Exercising Jurisdiction

351. 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*

352. 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 Article 24(4) Br I bis and Article 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.

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

354. 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 invalid, but the attacked embodiment or process would infringe if it were valid*

355. 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.

356. 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(I) 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.

357. 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 valid and infringed in the UPC territory*

358. Where it concerns either EU/LC EPs (in view of Article 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 decision 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.

#### *Assessment*

#### *Alleged infringement of the UK designation*

359. Fujifilm is allowed to rely on its centrally limited claim, for the reasons set out above. The Court allows the newly filed exhibits in relation to jurisdiction and the UK designation of the Patent from both parties in the appeal proceedings.

360. 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 combination 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.

361. 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 others:

- 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.

362. 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.

363. 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.

364. 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.

365. Only in its Reply Fujifilm submitted a declaration on UK law by Myles Jelf (‘Jelf’; Exh. K45) 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. K46) dated 12 October 2023 which suggests that Kodak Graphic supplies the attacked embodiments directly to customers throughout Europe.

366. 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*

367. 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.

368. Pursuant to section 60(1)(a) Patents Act 1977, importing a product embodying the invention into the UK is an infringing act. Jelf in his report explained that in respect of importing, the key question is often who has title in the sense of ownership to the products when they are imported in the UK.

369. 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.

370. 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 in fact 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 in Jelf's report, 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.

371. Fujifilm has requested (in its Reply) that Kodak be ordered to submit the toll manufacturing agreement into the proceedings according to Art. 59 UPCA, R. 190 RoP. Insofar as this request must be considered maintained on appeal, 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.

372. Fujifilm 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.

373. It follows that Kodak is right that the MLD's conclusion in the parallel EP'174 proceedings, referred to by Fujifilm, 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, cannot hold. 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.

374. Neither the Mintz report nor the press release referred to by Fujifilm (Exh. K46) 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.

### *Joint tortfeasorship*

375. 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.

376. 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, a more recent decision on this issue than the decisions referred to in Jelf’s report). 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.

377. 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 also explained in the Jelf report, joint tortfeasorship arises when multiple entities jointly commit a tort by acting pursuant to a common design.

378. 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.

379. Given that there is no finding of infringement of the UK designation of the Patent, Kodak’s submissions regarding comity and remedies available under UK law do not require consideration.

380. The above leads to the conclusion that Fujifilm’s appeal against the impugned decision regarding the UK designation is not successful.

### Remedies regarding the infringement of the German designation

381. Since the Court of Appeal, contrary to the MLD, found the Patent to be valid and infringed, the impugned decision of 2 April 2025 must be set aside.

### *Declaration of infringement*

382. Fujifilm has not explained why it has an interest in a declaration of infringement next to an injunction. This shall therefore be denied.

### *Injunction and penalties*

383. The infringing acts of Kodak justify an injunction, enforced with a recurring penalty in case of non-compliance payable to the Court pursuant to Art. 63 UPCA. The amount of the penalty was left to the Court's discretion and has not been commented on by Kodak. The amount is set at up to € 50 per square meter printing plate or up to € 10.000 per day, at the choice of Fujifilm.

384. Fujifilm has rightly argued that in view of the central limitation of the Patent, which it has been allowed to rely on in the appeal proceedings, the amended wording of the injunction accordingly must be allowed. This was not disputed.

385. Kodak has unsuccessfully argued that an injunction would be disproportionate. Kodak in this respect (in para. 797 et seq. SoD) mainly relies on arguments submitted to argue a private prior use right and invalidity of the patent which have, however, been considered and rejected. It can also not be accepted that the public interest in a functioning market with competing offerors and reliable supply chains generally overrides the interest of Fujifilm by enforcing its patent rights. Patent rights are an accepted and lawful limitation of free competition and the patentee has a right to prevent others from using its invention, unless there are exceptional circumstances which would make an injunction a disproportionate measure. Such exceptional circumstances cannot be established on the facts of this case. The fact that Kodak has developed its printing plate precursors on its own and considerably invested in that development is insufficient to deny an injunction. An injunction naturally has a negative impact on the business of the infringer. Kodak has further submitted [REDACTED] but failed to substantiate this in a sufficient manner. There is also no indication that Fujifilm enforces its patent rights in bad faith, as Kodak suggests.

### *Damages*

386. Given the infringing acts, Fujifilm is entitled to compensation for damages caused by past infringements pursuant to Art. 68 UPCA. The effective date from which damages are to be paid in respect of the German designation of 7 July 2021 has not been disputed. The determination of the amount of damages is reserved for subsequent proceedings under R. 125 et seq. RoP. Whether this includes compensation for moral prejudice caused to Fujifilm will have to be dealt with in the damages proceedings. There are insufficient grounds for awarding any amount for this particular type of damages, which pursuant to Art. 68 (2) UPCA is part of all appropriate aspects to be taken into account when the Court sets the damages, at this stage of the proceedings.

387. Given the period during which the infringing acts have taken place, an interim award of damages of € 300,000 as requested, bridging the period between this decision and a decision in damages proceedings that Fujifilm may initiate following receipt of the requested communication of accounting information, is considered justified and allowed under R. 119 RoP.

388. It is not appropriate and proportionate to impose a penalty in case of non-fulfilment of an enforceable monetary obligation.

### *Communication of information*

389. Fujifilm is entitled to receive information about past infringements as from 7 July 2021 (the date as from when Fujifilm claims payment of damages) pursuant to Art. 67 UPCA. Kodak's request for confidential treatment of this information is justified and shall be allowed. The protection of confidential information under Art. 58 UPCA is not limited to information contained in pleadings and submitted evidence but extends to information provided pursuant to an order under Art. 67 UPCA.
390. The confidentiality orders already issued in these proceedings and still in force between the parties shall be declared equally applicable to any and all information provided by Kodak pursuant to the order to communicate information and identified as confidential or highly confidential by Kodak. The Court of Appeal does not see sufficient reason to restrict access to the information to be communicated to less and/or other persons than those named in the existing confidentiality orders. Having the same persons as recipients of confidential information ensures consistency and efficiency of dealing with confidential information related to these proceedings, the infringing products and activities relating thereto within Fujifilm's organization. Since the information is still encumbered with confidentiality obligations, it cannot be seen and Kodak has not convincingly explained why a further limitation in this regard would be necessary to protect its interests and why it would outweigh the interests of Fujifilm in this regard.
391. The same applies to a restriction of use of the information to provided for the purposes of calculation of damages and subsequent enforcement proceedings against Kodak and/or potential third parties identified based on the information provided, and an obligation for Fujifilm to destroy this information after a certain period of time, as requested by Kodak. The Court of Appeal cannot see why this would – in addition to the confidentiality obligations – be necessary to safeguard to legitimate interest of Kodak by protection of its confidential information.
392. The time period within which the information shall be provided starts from the date of service of notification of enforcement under R. 118.8 RoP, as Kodak rightly noted. A period of 28 days is considered reasonable where it concerns the Sonora Xtra-3 plates, since this information should already have been provided under the first instance decision regarding EP 3 511 174 (EP'174) of 2 April 2025, and it should be sufficient to allow for a report by an independent accountant to be delivered. Regarding the Sonora X and Sonora Xtra-2 plates, the Court shall set the time-period at 45 days, as requested by Kodak.
393. The requested evidentiary support by an independent accountant serves procedural efficiency and economy, as it serves to prevent disputes about the completeness and correctness of the information provided.

### *Destruction, recall, removal from the channels of commerce*

394. Kodak unsuccessfully advances that Fujifilm has failed to provide a sufficient reasoning why these measures are appropriate. The ordering of these measures pursuant to Art. 64 UPCA constitutes the rule rather than the exception. The infringer therefore bears the burden of pleading and proof with respect to the lack of proportionality (cf UPC\_CoA\_534/2024 3 October 2025 *Belkin v Philips*, para. 236). These measures are not disproportionate under the circumstances of this case.
395. In relation to destruction, the Court of Appeal sees no reason to exclude 'evidentiary printing plates' from this obligation. Kodak has not properly argued how 'printing plates for evidentiary

purposes' should be defined, while Fujifilm has an interest that all printing plate precursors falling within the scope of claim 1 will be destructed.

396. Where recall is concerned, there is no reason to exclude products that are beyond their shelf life. Whether or not a product has reached its shelf life is not relevant for infringement. Outdated products could still be used, especially if only shortly after the expiration date. An exclusion as suggested by Kodak would thus entail the risk of continued infringement. On the other hand, Kodak assumes that there are not many outdated plates in the market anyway, since buyers will have destroyed / recycled them after expiry (para. 945 SoR). It therefore cannot be accepted that including infringing plates beyond their shelf life in a recall order would be disproportionate and outweighs Fujifilm's interest in preventing infringement of its patent rights.

397. There is equally no reason to exclude the recall of Sonora Xtra-3 plates. The decision of 2 April 2025 with regard to patent EP 3 551 174 contained an order to recall these plates, as Kodak notes, but that does not make a second recall unnecessary. The proper compliance with that recall order is still subject to enforcement proceedings. In addition, the order to desist from delivering Sonora Xtra-3 plates in this decision has been set aside by decision of the Court of Appeal of 2 June 2026. Sonora Xtra-3 plates could have been delivered thereafter, and these cannot have been covered by the previous order to recall these plates.

398. The requested penalty in case of non- or improper fulfilment of any of these orders is justified to ensure timely and full compliance. The Court of Appeal considers an amount of up to € 10.000,- per day (or part thereof) a sufficient threat to ensure compliance.

#### *Publication on the website*

399. Even though a publication of an own declaration by the infringer on its webpage may find its basis in Art. 80 UPCA, such a measure is justified only in the event of special circumstances which call for such a publication as corrective measure due to ramifications of an infringement which cannot be undone or sufficiently compensated otherwise. Fujifilm has not convincingly shown such special circumstances to be present in this case.

#### Kodak's appeal from the 18 July 2025 decision and 4 September 2025 rectification order (UK designation)

#### *The initial Order could be rectified in respect of the counterclaim*

400. Kodak has objected to the rectification order of 4 September 2025 in which the MLD ordered that *"The decision of the Local Division Mannheim, dated 18 July 2025, UPC\_CFI\_359/2023, is rectified in its operative part to the effect that, after point A., the following new point B. is inserted and the original point B. is renumbered as point C. "B. The Defendants' request to declare that the EP 3 476 616 B1 (UK) is also invalid in its entirety is dismissed."*

401. 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.

402. 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.

403. 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)*

404. 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 if the court were to assume jurisdiction for the UK designation of the Patent, 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, already because the MLD did not accept jurisdiction to decide on the validity of the UK designation of the Patent. The rectification order must therefore be set aside.

405. Kodak's appeal against the rectification order under 1. is thus successful and thus the application for rectification should have been dismissed in full.

#### Costs and value of the dispute

406. Since the decisions insofar as the infringement action and the counterclaim for revocation regarding the German designation shall be set aside, Kodak is the unsuccessful party in the infringement action. It shall be ordered to bear Fujifilm's costs of litigation in those actions both at first instance and on appeal. Insofar as Fujifilm's requests have not been allowed or not in full, including its initial request to uphold the patent as granted, the importance of these issues and costs associated therewith (where it concerns limited claim 1, given the initial alleged infringement of and validity attacks against claims, 2, 3, 6 and 7) are of such relative minor importance in relation to the entire dispute that equity does not require an apportionment thereof.

407. Kodak has also been unsuccessful in its objection to the Court's jurisdiction to hear the infringement of the UK designation and the condition under which the counterclaim for revocation concerning the UK designation has not been fulfilled. Kodak shall be therefore ordered to bear Fujifilm's costs of litigation in the Preliminary objection and the counterclaim for revocation action, both at first instance and on appeal. Fujifilm is the unsuccessful party in relation to the infringement action in relation to the UK designation of the Patent and shall be ordered to pay Kodak's costs of litigation in that regard.

408. Under R. 150.2 RoP an interim award of costs may be ordered. The amount of € 300,000 as requested by Fujifilm amounts to not more than 50% of the recoverable costs according to the scale of ceilings determined by the Administrative Committee on 24 April 2023 and shall be awarded.

409. The Court does not see reason to adjust the value of the dispute, which has been set at €4,000,000 for each of the infringement and revocation action in relation to the German

designation. The value of dispute in relation to the UK designation has been set at € 3,500,000. Neither of the parties has forwarded convincing reasoning why this determination was wrong.

## DECISION

The Court of Appeal:

in UPC\_CoA\_473/2025 and UPC\_CoA\_474/2025

- A. sets aside the impugned decision of 2 April 2025;
- B. orders Kodak subject to a penalty of € 50 per square meter printing plate or up to € 10.000 per day – at the choice of Fujifilm – with which the order is not complied with, to refrain from:

1. making, offering, placing on the market, using or storing it for those purposes a lithographic printing plate precursor within Germany, that has the following features:

A lithographic printing plate precursor comprising:

an aluminum support including an aluminum plate and,

formed thereon, an anodized film of aluminum, and

an image recording layer,

wherein the anodized film

is positioned closer to the image recording layer than the aluminum plate,

has micropores extending in a depth direction of the anodized film from a surface of the anodized film on the image recording layer side,

the micropores have an average diameter of 15-100 nm at the surface of the anodized film,

each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth of 10-1000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20-2,000 nm from a communication position between the small-diameter portion and the large-diameter portion,

the aperture average diameter of the large-diameter portion at the surface of the anodized film is 15-100 nm, and that of the small-diameter portion at the communication position is  $\leq$  13 nm; and

has a surface on the image recording layer side having a lightness  $L^*$  of 70-100 in a  $L^*a^*b^*$  color system,

wherein the steepness  $a_{45}$  representing an area ratio of portions having an inclination of  $\geq 45^\circ$  at the surface of the anodized film on the image recording layer side as determined by extracting components with a wavelength of 0.2 to 2  $\mu\text{m}$  is  $\leq 30\%$ ,

wherein the specific surface area  $\Delta S$  is 20-40%,  $\Delta S$  being a value determined by Formula (i)

$$\Delta S = (S_x - S_o) / S_o \times 100 (\%) \quad (i)$$

using an actual area  $S_x$  obtained, through three-point approximation, from three dimensional data acquired by measurement at  $512 \times 512$  points in 25  $\mu\text{m}$  square of the surface of the anodized film on the image recording layer side by means of an atomic force microscope and a geometrically measured area  $S_o$ ;

2. supplying and/or offering to any person other than a party entitled within the territory of Germany with

lithographic printing plate precursors

which are suitable and intended to use with

- a) method of manufacturing a lithographic printing plate, comprising the steps of
  - imagewise exposing the lithographic printing plate precursor according to item 1. to form exposed portions and unexposed portions; and
  - removing the unexposed portions of the lithographic printing plate precursor having been imagewise exposed;
- b) a printing method, comprising the steps of:
  - imagewise exposing the lithographic printing plate precursor according to item 1. to form exposed portions and unexposed portions; and
  - performing printing by supplying at least one of printing ink and fountain solution to remove the unexposed portions of the lithographic printing plate precursor having been imagewise exposed, on a printing press.

- C. orders Kodak to pay damages to Fujifilm compensating it for all losses caused by its infringing acts referred to in B above in Germany as from 7 July 2021 in accordance with Art. 68 UPCA;
- D. orders Kodak to pay to Fujifilm as an interim award of damages as provided for under R. 119 RoP an amount of € 300,000 (three hundred thousand euros);
- E. orders Kodak to inform Fujifilm, to the extent of which Kodak has committed the infringing acts referred to under B, and in relation to the period as from 7 July 2021, of:
  - 1. the origin and distribution channels;
  - 2. the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained; in particular
    - a. manufacturing quantities and times;
    - b. the individual deliveries, broken down by delivery quantities, times and prices and the respective product designations as well as the names and addresses of the customers;
    - c. the turnover, the gross margin and the contribution margin generated by the Defendants with the sale of these products;
    - d. the individual offers, broken down by quantities, times and prices and product designations as well as the names and addresses of the commercial offer recipients;
    - e. the advertising carried out, broken down by advertising media, their circulation, distribution period and distribution area, and in the case of Internet advertising, the domain, access figures and placement periods of each campaign;
    - f. the identity of all third parties involved in the distribution, in particular the names and addresses of the commercial buyers and the sales outlets for which the products were intended;

where it concerns the Sonora X and Xtra-2 plates within forty-five days, and where it concerns the Sonora Xtra-3 plates within twenty-eight days of the date of service of the notification of enforcement of this decision pursuant to R. 118.8 RoP, supported by evidence by an independent accountant, under a penalty of up to € 10,000 per day of delay from the month following the date of service of this decision;

- F. orders that the confidentiality orders issued in these proceedings and still in force between the parties equally apply to any and all information provided by Kodak pursuant to the order under E. and identified as confidential or highly confidential by Kodak;

- G. orders Kodak to destroy at their own expense the products, material and/or implements referred to under B. which are in their possession and/or ownership within Germany;
- H. orders Kodak to recall the products referred to under B. which have been placed on the market from the channels of commerce, with reference to the infringement determined by the Court of Appeal of the UPC in this decision and with the binding promise to reimburse any price paid and to assume any necessary packaging and transport costs as well as customs and storage costs associated with the return and to take back the products;
- I. orders Kodak to definitively remove the products referred to under B. from the channels of commerce;
- J. orders Kodak to pay a penalty sum to the Court in the event of any breach and/or non-fulfilment of any of the orders set out under E, G, H and I after the expiry of a period of 30 days after the date of service of the notification of enforcement of such order pursuant to R. 118.8 RoP, of up to € 10,000 per day of delay and/or non- or incomplete fulfilment, with partial days counting as full days;
- K. dismisses Kodak's requests in the counterclaim for revocation;
- L. sets the value of the dispute in the infringement action and the counterclaim for revocation action at € 4,000,000 each;
- M. orders that Kodak shall bear the costs of litigation both in the infringement action and the revocation action, both at first instance and on appeal;
- N. orders Kodak to pay to Fujifilm the amount of € 300,000 as an interim award on the legal costs and other expenses;
- O. dismisses all further requests;

in UPC\_CoA\_881/2025 and UPC\_CoA\_873/2025:

- P. dismisses Fujifilm's appeal against the decision of 18 July 2025;
- Q. sets aside the rectification order dated 4 September 2025 under 1 and the wording "2. In all other respects" of its operative part shall consequently be disregarded, so that the operative part reads: "The application for rectification is dismissed";
- R. dismisses Fujifilm's requests in the infringement action;
- S. declares that the condition under which Kodak's counterclaim for revocation was filed was not fulfilled;
- T. sets the value of the dispute in the infringement action and the counterclaim for revocation action at € 3,500,000 each;
- U. orders that Fujifilm shall bear the costs of litigation in the infringement action, both at first instance and on appeal;
- V. orders that Kodak shall bear the costs of the objection to the Court's jurisdiction, and the counterclaim for revocation, both at first instance and on appeal.

Issued on 13 July 2026

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Rian Kalden

Rian Kalden, presiding judge and judge-rapporteur

Patricia  
Ursula  
Rombach

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Ingeborg Simonsson, legally qualified judge

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Lorenzo Parrini, technically qualified judge



Max Tilmann, technically qualified judge

SARA MARIA  
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Sara Almeida, on behalf of the Registry