



**Mannheim Local Division**  
**UPC\_CFI\_365/2023**

## **Decision**

**of the Court of First Instance of the Unified Patent Court**

**Local Division Mannheim**

**delivered on 2 April 2025**

**concerning EP 3 511 174 B1**

### HEADNOTES:

1. The UPC has no jurisdiction over a European Patent with regard to those national parts of UPCA member states which have already lapsed before 1 June 2023. The same applies to national parts of non-UPCA-member states.
2. Also in the context of a prior use right, the according facts have to be presented in the Statement of Defense and the Counterclaim for Revocation. It is in those briefs that the defendant has to submit reasons why the action shall fail, R. 24(g) RoP and the grounds for revocation have to be presented comprehensively, R. 25(1)(b) and (c) RoP whereas the following briefs have to limit themselves to a response to matters raised in the Reply, R. 29(c) and (d) RoP.
3. Where German Law is applicable upon a private prior use right according to Art. 28 UPCA, it is necessary that a firm and final decision to use the form of alleged prior use took place before the priority date. For this the burden of presentation and proof regarding the underlying facts of a private prior use right lies on the defendant. It is therefore up to the defendant, to prove by submitting relevant documents and/or witnesses that by the date of the priority, he had possession of the invention and exercised the possession of the invention.

### CLAIMANT:

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

represented by:

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DEFENDANTS:

1. **Kodak GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs, at the same place,

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer  
Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz  
1, 40545 Düsseldorf, Germany

electronic address for service: elena.hennecke@freshfields.com

2. **Kodak Graphic Communications GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs, at the same place,

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer  
Rechtsanwälte Steuerberater PartG mbB,  
Maximiliansplatz 13, 80333 Munich, Germany

electronic address for service: elena.hennecke@freshfields.com

3. **Kodak Holding GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs, at the same place,

represented by: Elena Hennecke, Freshfields Bruckhaus Deringer  
Rechtsanwälte Steuerberater PartG mbB,  
Maximiliansplatz 13, 80333 Munich, Germany

electronic address for service: elena.hennecke@freshfields.com

PATENT AT ISSUE:

European patent EP 3 511 174

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This decision is delivered by the presiding judge Tochtermann as judge-rapporteur, the legally qualified judge Böttcher, the legally qualified judge Agergaard and the technically qualified judge Wismeth.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement

DATE OF THE ORAL HEARING: 11 and 12 February 2025

SUMMARY OF THE FACTS:

1. Claimant is suing Defendants for the alleged infringement of the EP 3 511 174 B1 which relates to a planographic printing plate original plate, a method for manufacturing, and a printing method. Claimant, a manufacturer of inter alia lithographic plates, is the registered proprietor of the patent-in-suit, which is still in force in Germany and the United Kingdom (cf. SoC, mn. 208; Reply, mn. 510) but elapsed in all other designated contracting member states before the entry into force of the UPCA on 1 June 2023. The mention of the grant of the patent-in-suit was published on 26 May 2021. It was filed on 31 May 2018, claiming the priority of two Japanese patent application of 29 September 2017 and 30 March 2018.
2. Claim 1, 15 and 16 of the patent-in-suit as granted read as follows in the language of the patent:

“1. A lithographic printing plate precursor comprising

an aluminum support; and

an image recording layer on the aluminum support,

wherein the aluminum support includes an anodized film on a surface of the image recording layer side,

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

the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01  $\mu\text{m}$  to 0.30  $\mu\text{m}$ , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,

an average pore diameter of the micropores in the surface of the anodized film is 90% or less of the maximum diameter of the micropores inside the anodized film,

a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

the image recording layer contains an acid color former.

15. A method of preparing a lithographic printing plate, comprising:

a step of imagewise-exposing the lithographic printing plate precursor of any of claims 1-14; and

a step of supplying at least any of printing ink or dampening water and removing an image recording layer in a non-image area on a printing

press.

16. A lithographic printing method comprising:

a step of imagewise-exposing the lithographic printing plate precursor according to any one of claims 1 to 4;  
a step of supplying at least any of printing ink or dampening water and removing a non-image area of an image recording layer on a printing press to prepare a lithographic printing plate;  
and  
a step of performing printing using the obtained lithographic printing plate.”

3. Claimant unconditionally amended claim 1 of the patent-in suit in accordance with its new Main request under R. 30.1 RoP (Exhibit K 34) as follows (with changes highlighted in yellow):

“1. A lithographic printing plate precursor comprising

an aluminum support; and

an image recording layer on the aluminum support,

wherein the aluminum support includes an anodized film on a surface of the image recording layer side,

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

the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01  $\mu\text{m}$  to 0.30  $\mu\text{m}$ , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,

an average pore diameter of the micropores in the surface of the anodized film is **90% or less in a range of 10% to 50%** of the maximum diameter of the micropores inside the anodized film,

a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

the image recording layer contains an acid color former.”

4. The court holds admissible to align the claims accordingly to the defense to the counterclaim for revocation by way of amendment acc. to R. 30.1. RoP (see infra).

5. Defendants, companies incorporated under German law, belong to a multinational group of companies producing and distributing inter alia printing plates. Defendant 1 acts as the German sales company purchasing the products from a UK based company of the group. Defendant 2 and its legal predecessor, respectively, own and operate a

manufacturing facility in Germany as contract manufacturer of printing plates for said UK entity. Defendant 1 is a wholly owned subsidiary of Defendant 2, which itself is a wholly owned subsidiary of Defendant 3 and subject to a control and profit and loss transfer agreement with Defendant 3.

6. In Claimant's opinion, printing plates marketed by Defendants under the product name "SONORA XTRA-3" (the claim having been limited to that "contested embodiment" in response to procedural order of 22 January 2025, ORD\_598567/2023, by brief of 4 February 2025) are falling within the scope of claim 1 of the patent-in-suit and are means relating to an essential element of the subject-matter of claims 15 and 16 of the patent-in-suit. With regard to the technical design of the contested embodiment, reference is made to exhibit K12, K13, K15, K18 to K21 submitted by Claimant.
7. Defendants challenge the validity of the patent-in-suit by relying on a public prior use right, on lack of novelty in relation to by EP 2 878 452 A1 (EP'452; T34) and WO 2018-160379 A1 (WO'379; T12). Inventive step is challenged by EP 2 878 452 A1 (EP'452; T34) in combination with common knowledge or EP 2 839 968 A1 (EP'968; T36) or US 2009/0047599 A1 (US'599, T40), in the alternative starting with EP 2 839 968 A1 (EP'968; T36). Additionally they put forward, that the patent-in-suit suffers from added matter as it extends beyond the disclosure of the application.

#### REQUESTS OF THE PARTIES

8. The Claimant requests (cf. amended requests from the brief of 22 January 2025, main workflow,):
  - A. As main request,
    - I. To hold that Claimant has demonstrated that the contested printing plate precursor SONORA XTRA-3 reproduces OR implements claims No. 1, 2, 3, 4, 5, 6, 7, 8, 9, 14, 15 and 16 of new Main Request (Exhibit K 34);
    - II. Consequently, to grant the claims made by Claimants;
    - III. subject to a penalty to be determined by the Court for each case of infringement to refrain from:

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

a. A lithographic printing plate precursor comprising:

an aluminum support; and

an image recording layer on the aluminum support,

wherein the aluminum support includes an anodized film on a surface of the image recording layer side,

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

the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01  $\mu\text{m}$  to 0.30  $\mu\text{m}$ , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,

an average pore diameter of the micropores in the surface of the anodized film is in a range of 10% to 50% of the maximum diameter of the micropores inside the anodized film,

a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

the image recording layer contains an acid color former,

- direct infringement of claim 1 EP 3 511 174 B1 -

b. in particular, the lithographic printing plate precursor according to claim 1, wherein the micropores are micropores which further include small diameter pores communicating with a bottom of the large-diameter pores, extending in the depth direction from a communication position, and having an average pore diameter of 0.01  $\mu\text{m}$  or less and in which the pore diameters of the small-diameter pores in the communication position are smaller than the pore diameters of the large-diameter pores in the communication position

- direct infringement of subclaim 2 EP 3 511 174B1 -

and/or,

c. the lithographic printing plate precursor according to any one of claims 1 to 2, wherein the acid color former is a leuco dye

- direct infringement of subclaim 3 EP 3 511 174 B1 -

and/or

d. the lithographic printing plate precursor according to any one of claims 1 to 3, wherein the image recording layer further contains an acid generator

- direct infringement of subclaim 4 EP 3 511 174 B1 -

and/or

e. the lithographic printing plate precursor according to claim 4, wherein the acid generator contains an organic borate compound

- direct infringement of subclaim 5 EP 3 511 174 B1 -

and/or

f. the lithographic printing plate precursor according to any one of claims 1 to 5, wherein a value of a brightness  $L^*$  in an  $L^*a^*b^*$  color system of the surface of the anodized film on the image recording layer side is in a range of 70 to 100

- direct infringement of subclaim 6 EP 3 511 174 B1 -

and/or

g. the lithographic printing plate precursor according to any one of claims 1 to 5, wherein a value of a brightness  $L^*$  in an  $L^*a^*b^*$  color system of the surface of the anodized film on the image recording layer side is in a range of 72 to 90

- direct infringement of subclaim 7 EP 3 511 174 B1 -

and/or

h. the lithographic printing plate precursor according to any one of claims 1 to 7, wherein a steepness  $a_{45}$  representing an area ratio of a portion having an inclining degree of  $45^\circ$  or greater obtained by extracting a component with a wavelength of  $0.2 \mu\text{m}$  to  $2 \mu\text{m}$  in the surface of the anodized film on the image recording layer side in a frequency distribution based on fast Fourier transformation of three-dimensional data obtained by performing measurement using an atomic force microscope is 30% or less

- direct infringement of subclaim 8 EP 3 511 174 B1 -

and/or

i. the lithographic printing plate precursor according to any one of claims 1 to 8, wherein an amount of the image recording layer is in a range of  $0.5 \text{ g/m}^2$  to  $2.5 \text{ g/m}^2$

- direct infringement of subclaim 9 EP 3 511 174 B1 -

and/or

j. the lithographic printing plate precursor according to any one of claims 1 to 13, which is a lithographic printing plate precursor for on-press development.

- direct infringement of subclaim 14 EP 3 511 174 B1 -

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

lithographic printing plate precursors

which are suitable and intended to use with

a. method of preparing a lithographic printing plate, comprising

a step of imagewise-exposing the lithographic printing plate precursor of any of claims 1-14; and

a step of supplying at least any of printing ink or dampening water and

removing an image recording layer in a non-image area on a printing press.

- indirect infringement of claim 15 EP 3 511 174 B1 -

b. a printing method, comprising:

a step of imagewise-exposing the lithographic printing plate precursor according to any one of claims 1 to 4;

a step of supplying at least any of printing ink or dampening water and removing a non-image area of an image recording layer on a printing press to prepare a lithographic printing plate; and

a step of performing printing using the obtained lithographic printing plate.

- indirect infringement of claim 16 EP 3 511 174 B1 -

B. As further requests,

I. to hold that the Defendants shall pay damages to the Claimant compensating all losses caused by infringing acts referred to in A.III. above in

- Albania, Austria, Cyprus, Czechia, Denmark, Estonia, Finland, Italy, Lithuania, Latvia, Malta, Monaco, The Netherlands, North Macedonia, Poland, Romania, San Marino, Serbia, Slovenia, Spain, Sweden, Türkiye since July 17<sup>th</sup>, 2019 until May 26<sup>th</sup>, 2021;

- Belgium, Ireland, Liechtenstein, Luxembourg, Switzerland since July 17<sup>th</sup>, 2019 until May 31<sup>st</sup>, 2021,
  - France since July 17<sup>th</sup>, 2019 until July 26<sup>th</sup>, 2021,
  - Bulgaria, Norway since July 17<sup>th</sup>, 2019 until August 26<sup>th</sup>, 2021,
  - Greece since July 17<sup>th</sup>, 2019 until August 27<sup>th</sup>, 2021,
  - Iceland since July 17<sup>th</sup>, 2019 until September 26<sup>th</sup>, 2021,
  - Portugal since July 17<sup>th</sup>, 2019 until September 27<sup>th</sup>, 2021,
  - the United Kingdom since July 17<sup>th</sup>, 2019 and while EP 3 511 174 is in force,
  - and in Germany since July 17<sup>th</sup>, 2019;
- II. to order the Defendants to pay to the Claimant EUR 200,000 (two hundred thousand euros) in compensation for the moral prejudice suffered;
- III. to inform the Claimant to the extent of which the Defendants have committed the infringing acts of EP 3 511 174 referred to in B.I – stating
1. the origin and distribution channels;
  2. the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained;
- in particular
- manufacturing quantities and times;
  - 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;
  - the turnover, the gross margin and the contribution margin generated by the Defendants with the sale of these products;
  - 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;
  - 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;
  - 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;

whereby details requiring confidentiality may, at the discretion of the court, be redacted or made available only to certain persons;

within twenty-one days of the date of service of the decision, supported by evidence verified by an independent accountant, under a penalty of EUR 10.000 per delay day from the month following the date of service of the judgment to be handed down;

- IV. to order the Defendants to pay the Claimant interim awards on damages in the amount of EUR 10.000.000 (ten million euros) as provided under Rule 119 of the Rules of Procedure pending the communication of the requested accounting information, the Claimant retaining the right to bring an action at a later date for the determination of the damages;
- V. to order the Defendants to destroy at their own expense the products, material and/or implements referred to under A. III. which are in their possession and/or ownership within Germany and the United Kingdom, and to provide the Claimant with proper evidence certified by an independent bailiff as to how and when the destruction was carried out;
- VI. to order the Defendants to recall the products referred to under A. III. which have been placed on the market from the channels of commerce, with reference to the infringement determined by a court of law (judgement of [...] on [...]) and with the binding promise to reimburse any fees 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,

whereby an exhaustive list of all recipients is to be provided to the Claimants;

- VII. to order the Defendants to definitively remove the products referred to under A. III. from the channels of commerce, specifically taking the following measures at their own expense:
  1. the Defendants shall take all possible and reasonable measures to identify the locations and owners of the products referred to under A. III;
  2. to the extent that the Defendants themselves have legal or actual control over the products referred to under A. III., such measures as are legally permissible and reasonable shall be taken to ensure that such products come into and remain in the Defendants' immediate possession;
  3. to the extent that the Defendants do not have legal or actual control over the products referred to under A. III., they shall take all legally permissible and reasonable steps to induce the persons holding claims for restitution against the holders of the control of the products to assert such claims and/or to assist such persons in asserting such claims;

VIII. to order for each defendant

1. to place on its website, within seven days from the date of the decision and for a continuous period of at least two weeks, the following statement (or a statement as the Court deems appropriate), to be displayed in a manner visible directly on the website's home- or landing page, in a text box separate from the website's other content having a white background and black letters, set in typeface Arial and having at least 12pt size, and to provide the Claimant with evidence when and how the statement was placed:

*"On [date of decision], the Unified Patent Court has ruled that Kodak GmbH, Kodak Graphic Communications GmbH and Kodak Holding GmbH infringed European Patent No. 3 511 174 held by Fujifilm Corporation by manufacturing, selling, and offering for sale SONORA XTRA-3 printing plate precursors. As a consequence, Kodak GmbH, Kodak Graphic Communications GmbH and Kodak Holding GmbH were ordered to terminate all commercial activities related to these products in Germany and the United Kingdom immediately. We apologize for any inconvenience this may cause and will be reaching out directly to clients to offer an appropriate solution."*

2. to send to its clients, within seven days from the date of the decision, in the national language of the client, a letter with the following contents only (or such contents as the Court deems appropriate) and without caption, and to provide the Claimant with copies of all letters sent:

*"Kodak GmbH, Kodak Graphic Communications GmbH and Kodak Holding GmbH have infringed Fujifilm's European Patent No. 3 476 616 with its products SONORA XTRA-3. Those products may no longer be offered for sale or sold in Germany and the United Kingdom, either on- or offline. We hereby request you to remove (images of) these products from your websites, from your shops and from other promotional and sales channels, to cease all sales and offers for sale of these products, and to return to us these products within seven days from the date of this letter. We will refund the purchase price and all costs associated with the return of the products to you."*

- IX. In any case, to order the Defendants to pay the Claimant the sum of EUR 300.000 as an interim award on the legal costs and other expenses as provided under Article 69 of the Unified Patent Court Agreement and Rule 118(5), 119 and 150(2) of the Rules of Procedure.

[For requests C. to F., see infra under "Counterclaim for revocation"]

- G. As a **further subsidiary request**, insofar as the Court considers the evidence submitted by the Defendants insufficient to hold Defendant 2) liable for infringement of the patent in suit in the UK, to **order** Defendant 2) to produce,

- I. the Manufacturing Toll Agreement of 1 January 2017 between Defendant 2) and Kodak Ltd. referred to on page 10 of Exhibit K 3;
  - II. only if this does not become clear from the Toll Manufacturing Agreement, other documents, including purchase orders, invoices, agreements, or terms and conditions, that clarify when title to the SONORA plates manufactured by Defendant 2) intended for the UK market passes, in the case of (a) supplies to Kodak's UK entity and in the case of (b) direct shipments to distributors such as Intuprint.
- H. As a further request,
- I. to dismiss the Defendants' request for an enforcement security,
  - II. if the Court were to consider an enforcement security at all, to limit it to much lower proportions at the discretion of the Court.
9. In the event the Court should find any reason to stay the proceedings as they relate to infringing acts carried out in the UK, or not to grant a permanent injunction for the United Kingdom (UK) until further conditions are fulfilled, the Claimant further requests that the Court grant a provisional injunction for the UK, pending the stay and/or so long as no permanent injunction is granted (cf. SoC, mn. 209).
10. The Defendants filed a preliminary objection rejecting the international jurisdiction and competence with regard to UK. The judge-rapporteur informed the parties that the Court will deal with the preliminary objection in the main proceedings in the light of the forthcoming opinion of the Advocate General in re ECJ C-339/22 (BSH Hausgeräte GmbH v. Aktiebolaget Electrolux). That part of the dispute is now subject to separate proceedings.
11. The Defendants request (with regard to the updated amount for the enforcement security, cf. brief of 12 February 2025, workflow App\_6928/2025):
1. dismissal of the action (Rules 23, 24 lit. (g) RoP UPC);
  2. reimbursement of the Defendants' costs of the infringement action provisionally (Rule 150.2 RoP UPC);
- in the alternative,
3. to make the enforcement of the decision subject to the prior provision of security by the Plaintiff of at least [...] (Rules 352.1, 354.2 RoP UPC), which can be provided by a written, irrevocable, unconditional and unlimited guarantee from a credit institution authorized to do business in the territory of a member state of the UPC;

4. to permit the Defendants to avert enforcement of the decision by providing security, which can be made by way of a written, irrevocable, unconditional, and indefinite guarantee of a financial institution in the territory of a member state of the UPC authorized to conduct business in the Federal Republic of Germany, irrespective of a provision of security by Plaintiff (Rule 9.1 RoP UPC);

COUNTERCLAIM FOR REVOCATION

12. With regard to their counterclaim for revocation (CC\_3097/2024, CC\_3099/2024, CC\_8809/2024), the Defendants request:

5. revocation of the European patent EP 3 511 174 B1 in its entirety with effect in the territory of all Contracting Member States in which the patent has effect (Rule 25 RoP UPC);
6. without prejudice to our primary position that the court either cannot or should not determine the claim so far as it concerns the United Kingdom for the reasons set out in our Preliminary Objections,

and on the basis that if the court were to assume jurisdiction for the EP 3 511 174 B1 (UK) 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 EP 3 476 616 B1 (UK) in line with decision handed down by this court,

a decision that the EP 3 511 174 B1 (UK) is also invalid in its entirety; and

7. reimbursement of the Defendants' costs of the counterclaim provisionally (Rule 150.2 RoP UPC).

13. The Claimant having filed an Application to amend the patent (App\_35678/2024) requests:

C. As a further main request,

to **dismiss** the Counterclaim for Revocation of EP 3 511 174 B1 to the extent of the new Main request;

D. As a **subsidiary request**, insofar as the Court considers the claims of EP 3 511 174 B1 to be anticipated by any of the prior art documents invoked as contended in the Counterclaim for Revocation under Articles 54(2), 54(3) EPC and/or Article 56 EPC,

I. to hold that the Application to Amend EP 3 511 174 B1 submitted as Auxiliary Request 1 is admissible;

II. to hold that the Claimant has demonstrated that the contested printing plate precursor SONORA XTRA-3 reproduces or implements claims No. 1, 2, 3, 4, 5, 6, 7, 12, 13 and 14 of Auxiliary Request 1;

III. to consequently order the injunctive measures requested under request A.;

IV. to consequently order the corrective measures requested under request B. of the Statement of Claim;

E. As a **further subsidiary request**, if the Court considers the claims of EP 3 511 174 B1 to be anticipated by any of the prior art documents invoked in the Counterclaim for Revocation under Articles 54(2) or 54(3) EPC,

I. to **hold** that the Application to Amend EP 3 511 174 B1 submitted as Auxiliary Request 2 is admissible;

II. to **hold** that the Claimant has demonstrated that the contested printing plate precursor SONORA XTRA-3 reproduces or implements claims 1, 2, 3, 4, 5, 6, 7, 12, 13 and 14 of Auxiliary Request 2;

III. to consequently **order** the injunctive measures requested under request A.;

IV. to consequently **order** the corrective measures requested under request B.;

F. As a **further subsidiary request**, if the Court considers claim 1 of the Main Request or of Auxiliary Request 1 and/or 2 of EP 3 511 174 B1 to be violating Article 123 (2) EPC as invoked in the Counterclaim for Revocation,

I. to **hold** that the Application to Amend EP 3 511 174 B1 submitted as Auxiliary Request 3 is admissible;

II. to **hold** that the Claimant has demonstrated that the contested printing plate precursors SONORA XTRA-3 reproduce or implement claims No. 1, 2, 3, 4, 5, 6, 7, 8, 13, 14 and 15 of Auxiliary Request 3;

III. to consequently **order** the injunctive measures requested under request A.;

IV. to consequently **order** the corrective measures requested under request B.

14. The Defendants request to dismiss the Claimant's requests to amend the patent.

15. The panel separated the proceedings with regard to the United Kingdom by order of 2 April 2025 because the decision of the ECJ in re C-339/22 (BSH Hausgeräte) had not been delivered until the end of the oral hearing but only thereafter on 25 February 2025. With regard to Albania, Cyprus, Czechia, Spain, Croatia, Monaco, North Macedonia, Poland, Serbia, Slovakia, San Marino, Norway, Greece, Iceland, Liechtenstein, Switzerland, Türkiye and Ireland, being UPCA non-member states and UPCA member state without the UPCA being in force respectively, a separation was not necessary because the territorial national parts of the patent-in-suit have already lapsed before 1 June 2023 so that the UPC has no jurisdiction insofar regardless of the outcome of ECJ in re C-339/22 as further discussed infra.

## POINTS AT ISSUE

16. The parties are in dispute about different aspects of the case at hand.

## INFRINGEMENT

17. According to Defendants, Sonora XTRA-3 has no micropores in the meaning of the patent-in-suit. In their view its anodized film has a three-layer structure due to corresponding anodization steps instead of a two-layer-structure as required by the patent-in-suit. Moreover, Defendants consider Sonora XTRA-3 not to have continuous boundaries on the topmost layer of the anodized film, but spikes, thus not allowing to find pores having a certain diameter at the film's surface in accordance with the patent-in-suit. Furthermore, they regard Claimant's infringement allegation relating to subclaims 2 and 3 to be inconclusive insofar as Claimant relies on Atomic Force Microscope (AFM) measurements.

18. Moreover, the Defendants allege a private prior use right pursuant to Sec. 12 German Patent Act (PatG) in conjunction with Art. 28 UPCA allowing them to manufacture and distribute the contested embodiments in Germany.

19. Claimant seeks a permanent injunction, a right to prevent the indirect use of the invention, corrective measures, an order to communicate information and to pay damages as well as an interim award of damages and costs. The arguments exchanged in this context will be addressed below in more detail.

20. For further details on the points at issue, reference is made to the briefs and the accompanying exhibits.

## COUNTERCLAIM FOR REVOCATION

21. The Defendants base their identical counterclaims for revocation on the following grounds of Art. 138 EPC in conjunction with Art. 65 (2) UPCA.

- lack of novelty (Art. 138(1)a) in conjunction with Art. 54(1), (2) and (3) EPC) due to public prior use, or over WO 379, or over EP 452, and
- lack of inventive step (Art. 138(1)a) in conjunction with Art. 56 EPC) in the light

of EP 452 and common general knowledge, or in combination with pre-published patent applications EP 968, US 599,

- added matter (Art. 123(2) EPC).

#### GROUNDS FOR THE DECISION

22. The infringement action is admissible and founded as the attacked embodiment infringes upon the validated national part of the patent-in-suit in Germany and the respective counterclaim for revocation is admissible but unfounded.

#### A. ADMISSIBILITY OF THE INFRINGEMENT ACTION AND OF THE COUNTERCLAIM FOR REVOCATION

23. The infringement action, however, is inadmissible with regard to the national parts of the patent-in-suit validated for member states of the European Patent Convention other than Germany. The UK-part of the bundle patent is now subject to a separated proceeding and will have to be decided upon in that separate proceeding.

#### I. RELEVANT REQUESTS CONCERNING THE INFRINGEMENT ACTION

24. The Claimant's amendments to the infringement action are admissible.

#### Amendments by Claimant's reply

25. By its brief containing its reply to the statement of defence and to the counterclaim for revocation and its application to amend the patent, Claimant submitted auxiliary requests with regard to the infringement proceedings taking into account a potential partly revocation of the patent-in-suit. Such consequential adjustments to the infringement action are covered by R. 30 RoP without the necessity to formally apply for leave to change the claim or amend the case in accordance with R. 263 RoP. Such adjustments do not constitute a change or amendment in the meaning of R. 263 RoP, but only clarify that the Claimant also seeks relief to a corresponding lesser extent if the patent-in-suit is partly revoked in accordance with the application to amend the patent. Apart from that, R. 30 RoP is the *lex specialis* which would override R. 263 RoP in this regard. Anyway, the panel believes that such adjustments would have to be regarded as implicit application under R. 263 RoP and that leave would have to be

granted accordingly in order not to frustrate the possibility to amend the patent-in-suit in accordance with R. 30 RoP so as to obtain a judgment against the defendant for infringement of the patent-in-suit in a version partially maintained according to the amendments applied for.

Amendments by Claimant's brief of 4 February 2025

26. As far as Claimant has amended its requests for the infringement action by its brief of 4 February 2025, the panel has no concerns under R. 263 RoP either.
27. With regard to the injunctive relief sought, the Claimant dropped its original main request under A., designating the contested embodiments in general terms, and now solely relies on the original auxiliary request under B. as the new main request designating the contested embodiments by their product names. In the absence of any indication to the contrary, on a regular basis, both such requests have to be interpreted so as to encompass any embodiment implementing the same features, which a Claimant relies on for the alleged infringement regardless of the product name. Therefore, said transition from the original main request to the original auxiliary request as the new main request relates to the mere wording only, not to the substantive content of the request. In the opinion of the panel, R. 263 RoP does not address such amendments concerning a request's wording only.
28. The fact that, in the proceedings at hand, the designation of the contested embodiments by their product names may also serve the purpose to indicate that Claimant wishes the court to adjudicate on all designated contested embodiments explicitly does not lead to another result. Such clarification again does fall into the ambit of R. 263 RoP.
29. If one were of a different opinion, the transition from the main request to the auxiliary request as the new main request would also be admissible. Since the new main request already was part of the original requests, the transition does not unreasonably hinder Defendants in the conduct of their action (R. 263.2 (b) RoP). Even if one considered the transition to be a partial withdrawal of the statement of claim in the meaning of R. 265 RoP, such partial withdrawal would have to be granted under R. 265 RoP. Defendants did not bring forward any facts and interests necessitating the dismissal of such partial

withdrawal. In particular, no further embodiment is apparent, which would fall into the scope of the original, but not the scope of the current main request. As far as Claimant explicitly decided not to attack SONORA X and SONORA XTRA-2 plates anymore but limit this infringement claim to SONORA XTRA-3 plates, such amendment is to be interpreted as a partial withdrawal of the claim, which is admissible pursuant R. 265 RoP as Defendants did not forward any interest in a decision on the action with regard to these products.

30. The amendments under requests D. to F. as amended by brief of 4 February 2025 concern mere consequential linguistic adjustments after dropping the original main request A. and, thus, have to be assessed accordingly.

31. In its statement of claim, under the original request C., Claimant sought remedies pertaining to “infringing acts of EP 3 511 174 in any country where and while it has been and/or is still in force, since July 17<sup>th</sup>, 2019 – for Germany since May 15<sup>th</sup>, 2021”. By its brief of 4 February 2025, Claimant responded to judge-rapporteur’s order of 22 January 2025 by designating the national states concerned explicitly. Contrary to Defendants’ view in the oral hearing, such amendment is admissible. An amendment in response to concerns raised by the Court does not constitute a change or amendment in the meaning of R. 263 RoP if the lack of specificity and the amendment responding to it concern the wording only but not the content of the request. Even if the lack of specificity and the amendment concerned the substance of the requests, it would serve the purpose of removing a potential lack of substantive specificity only after having been addressed by the court. Such amendment would have to be admissible under R. 263 RoP on a regular basis if it does not unduly hinder the defence of defendant. Otherwise, an originally unspecified request would be inadmissible without any remedy, resulting in limiting a Claimant’s legal protection. In the proceedings at hand, the amendment does not hinder Defendants’ defence because the court lacks jurisdiction for the requests as amended as discussed *infra*. For Defendants’ legal position, it does not make a difference whether a request is dismissed on the grounds of lack of jurisdiction or lack of substantive specificity.

## II. NO JURISDICTION OVER NATIONAL PARTS LAPSED BEFORE 1 JUNE 2023

32. The UPC has no jurisdiction over the patent-in-suit with regard to those national parts of UPCA member states which have already lapsed before 1 June 2023. The same applies to national parts of non-UPCA-member states. All national parts of the patent-in-suit except the German part and the UK part, which is now subject to separate proceedings, had elapsed before the entry into force of the UPCA.
33. Without prejudice to Art. 83 UPCA, Art. 3 (c) UPCA vests upon the UPC jurisdiction over any pre-existing European patent which has not yet lapsed at the date of the UPCA's entry into force, i.e., 1 June 2023. The provision has to be interpreted autonomously in accordance with the Vienna Convention on the Law of Treaties (VCLT) (cf. Court of Appeal, Order of 16 January 2025, UPC\_CoA\_30/2024, GRUR-RS 2025, 213 mn. 41; W. Tilmann, GRUR Patent 2025, 51 mn. 107) and the Union law in its entirety (cf. Art. 20 UPCA, Art. 326 Treaty on the Functioning of the European Union (TFEU), cf. further Local Division Mannheim, decision of 11 March 2025, UPC\_CFI\_159/2024 mn. 99, UPC\_CFI\_162/2024 mn. 103). Therefore, in particular, a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose (cf. Art. 31 (1) VCLT). For the purpose, aspects as laid down in Art. 31 (2), (3) VCLT have to be taken into account. Further relevant aspects are laid down in Art. 31 (4) VCLT, Art. 32 et seq. VCLT.
34. In this context, the term "any European patent" in Art. 3 (c) UPCA has to be construed as meaning "any national part thereof". Like the national laws of the member states to the European Patent Convention (EPC), the substantive law as laid down in the UPCA deals with the phase following the grant of a traditional European bundle patent only. After its grant, apart from opposition and limitation proceedings before the European Patent Office (EPO), the effect and existence of the national parts of a European bundle patent are independent from each other and follow national laws. Accordingly, recital 3 to the UPCA sees the purpose of the EPC as providing for a single procedure for granting European patents. The UPCA further acknowledges said legal structure by harmonizing in part the substantive law of its member states applicable to then existing national parts for infringing acts committed after its entry into force (cf. Local Division Mannheim, decision of 11 March 2025, UPC\_CFI\_159 mn. 91 et seq.,

UPC\_CFI\_162/2024 mn. 95 et seqq.). Said acknowledgement also follows from the fact that the UPCA leaves some legal aspects of infringing acts committed after its entry into force to the substantive national laws of its member states without further harmonization (cf. Art. 29 UPCA (exhaustion), Art. 28 UPCA (private prior use right)). Therefore, Art. 3 (c) UPCA cannot be read as a basis to transfer the national parts of a traditional European bundle patent into a single uniform international patent. Art. 3 (c) UPCA cannot be interpreted so as to establish the UPC's jurisdiction over national parts having lapsed before the UPCA's entry into force provided that one single national part is still in force at that date. Otherwise, in extreme cases, such single national part would suffice to establish the UPC's jurisdiction over infringing acts with regard to lapsed national parts, even if said single national part is not part of the infringement action and all infringing acts reside in periods before the UPCA's entry into force. This would also be true if said single national part was the national part of a UPCA non-member state because Art. 3 (c) UPCA in general speaks of a European patent without differentiating between UPCA member and non-member states so that the UPC would have jurisdiction over national parts of UPCA non-member states to the same extent as a national court of the UPCA member states would have under the Brussels Ia Reg. In the absence of any indication to the contrary, it cannot be assumed that the member states to the UPCA intended to transfer the jurisdiction to the UPC for their national parts that had already lapsed before its entry into force.

35. The finding that the UPC has no jurisdiction over national parts lapsed before its entry into force is also confirmed by the purpose of the UPCA facilitating the enforcement of founded and the defence against unfounded claims for infringement. According to its recital 2, the member states to the UPCA consider the *"fragmented market for patents and the significant variations between national court systems ... detrimental for innovation, in particular for small and medium-sized enterprises which have difficulties to enforce their patents and to defend themselves against unfounded claims and claims relating to patents which should be revoked."* This purpose clearly aims at the future. Again, there is no indication that this purpose is also directed to national parts lapsed before the UPCA's entry into force and that the member states intended to establish a new court with jurisdiction over infringement cases which, due to the lapsed national part, exclusively reside in the past before the UPCA's entry into force without having

any effect for the period thereafter. On the contrary, the member states intended to mitigate the fragmentation considered by them to be negative for the future only by establishing the UPC's jurisdiction over patents still in force on 1 June 2023 and accepted the fragmentation for the past. Against this backdrop, it cannot be assumed that the contracting member states wished to give up the jurisdiction of their national courts over national parts lapsed before the UPCA's entry into force.

36. Therefore, the UPC has no jurisdiction under Art. 3 (c) UPCA over national parts of a European bundle patent which elapsed before the UPCA's entry into force regardless of being a national part in relation to a UPC member state or not.

37. The Defendants' objection against the UPC's jurisdiction with regard to the lapsed national parts of the patent-in-suit is not precluded by R. 19.7 UPCA or Art. 26 (1) Brussels Ia Reg., although Defendants did not base their preliminary objection on the lack of jurisdiction under Art. 3 (c) UPCA, but raised an objection insofar in the oral hearing only.

38. It can be left open whether a lack of jurisdiction under Art. 3 (c) UPCA falls within the scope of R. 19 RoP. Since the Claimant has designated the countries explicitly for which it seeks damages, provision of information and corrective measures in its brief of 4 February 2025 only, Defendants were not obliged to raise their objection up-front but could rely on criticizing the lack of specificity as done in their statement of defence. Neither the court nor the defendant were obliged to investigate with regard to unnamed member states to the EPC whether the patent-in-suit might have been in force for a period residing before the UPCA's entry into force only. Since the Defendants raised their objection within less than a month after Claimant having designated the relevant EPC member states, it can be left open whether R. 19 RoP applies accordingly from the date when the original deficiency in the statement of claim was corrected.

39. Art. 26 (1) Brussels Ia Reg. does not bar the objection either. First, Art. 26 (1) Brussels Ia Reg. relates to the international and – according to a predominant view – local jurisdiction. However, it does not address the subject-matter jurisdiction between different courts within a single EU member state. Accordingly, it is not applicable to

the demarcation of the subject-matter jurisdiction of a court common to EU member states such as the UPC and the national courts of these member states either. When applied pursuant to Art. 71a, 71b Brussels Ia Reg., the scope of Art. 26 (1) does not change insofar. On the contrary, Art. 71a (1) Brussels Ia Reg. explicitly stipulates that, for the purposes of the Brussels Ia Regulation, a court common to several member states as specified in Art. 71a (2) Brussels Ia Reg. including the UPC shall be deemed to be a court of a EU member state when, pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of the Brussels Ia Regulation, thereby confirming that Art. 26 (1) Brussels Ia Reg. applies in the same way between national courts and a common court as between national courts, i.e., dealing with the international and at most local jurisdiction, but not with the subject-matter jurisdiction.

### III. FURTHER ASPECTS OF ADMISSIBILITY

40. In all other respects, both the infringement action and the counterclaim for revocation are admissible. In particular, Claimant did not raise any objection against the jurisdiction and local competence of the Local Division Mannheim with regard to the counterclaim.

### B. SCOPE OF THE PATENT-IN-SUIT

41. The patent-in-suit relates to a lithographic printing plate precursor. According to the description of the patent-in suit, a lithographic printing plate precursor includes an aluminium support and an image recording layer as well as an anodized film being formed on a surface of the aluminium support in order to suppress its dissolution [0002].

42. Before using a lithographic printing plate and attaching it to a printing press, the image thereupon is inspected and identified in order to verify whether it is recorded on the plate in an intended manner [0004]. In a case of an on-press development type lithographic printing plate precursor it is difficult to confirm an image on the precursor and thus the image cannot be sufficiently inspected in some cases [0005], as the plate had already been mounted on the press before it being developed thereon. In this case means for confirming an image already at a stage after the exposure (but before

development), a so-called print-out image, can be examined by coloring or decoloring an exposed region [0007]. An acid color former can be used for this purpose [0008]. However, unintended coloring, also referred to as “appearance failure”, may occur with time in a case where an aluminium support on which an anodized film is formed is used for a lithographic printing plate precursor. Said appearance failure occurs in a case where an aluminium support on which the anodized film is formed is used and an image recording layer or even is not exposed [0009], [0026]. The description of the patent speculates about the reasons for such appearance failures. A reason may be that a component, particularly an anion containing a halogen atom, in the image recording layer infiltrates into the anodized film so that a part of the aluminium base of the aluminium support is dissolved. Due to the consequential presence of a proton  $H^+$ , i.e., an acid being formed during that dissolution process, the acid color former may develop color in spots where no image is intended [0027].

43. Against this background, the patent-in-suit is based on the technical problem to provide a lithographic printing plate precursor that suppresses occurrence of appearance failure [0010] as well as addressing that sufficient scratch resistance of the plate should be high [0032].

44. As a solution, the patent-in-suit proposes in claim 1 a lithographic printing plate precursor, the features of which can be structured as follows (numbering according to Claimant’s feature analysis, but reordered for the sake of better comprehensibility). The Claimant defends its patent-in-suit only with the following limited feature **1.7’**.

**1** A lithographic printing plate precursor comprising:

**1.1** an aluminum support (10),

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

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

**1.4** the anodized film has micropores (30) extending in a depth direction from the surface of the anodized film on the image recording layer side,

- 1.5** the micropores (30) include at least large-diameter pores (130) whose maximum diameter inside the anodized film (34, 122) is in a range of 0.01  $\mu\text{m}$  to 0.30  $\mu\text{m}$  [= 10 nm to 300 nm],
  - 1.6** and wherein an average value of depths of the large-diameter pores (130) to the bottom from the surface of the anodized film (D) is in a range of 100 nm to 1500 nm,
  - 1.7'** an average pore diameter of the micropores in the surface of the anodized film (124) is ~~90 % or less~~ in a range of 10 % to 50 % of the maximum diameter of the micropores inside the anodized film; and
- 1.2** an image recording layer on the aluminum support (10),
  - 1.9** the image recording layer contains an acid color former.

45. The independent procedural claims protect corresponding methods of manufacturing a lithographic printing plate (claim 15) and for printing with that plate (claim 16), with a specification indicating the printing plate being of an on-press development type, which feature is not subject of claim 1.

#### CONSTRUCTION OF CLAIM 1

46. Some features require explanation. The responsible person skilled in the art, 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, will understand the relevant features being in dispute amongst the parties as follows.

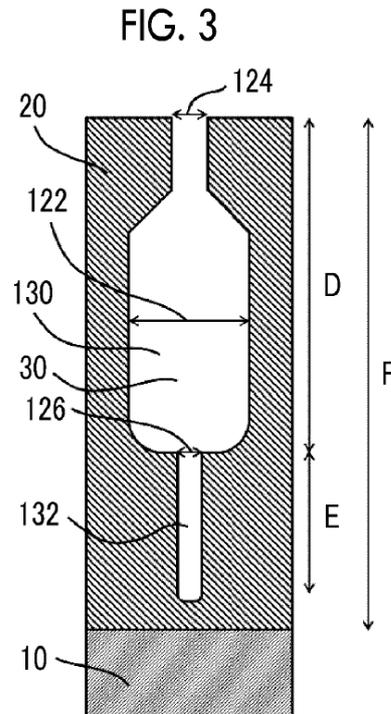
47. Feature **1** relates to the precursor of a printing plate. The printing plate as such is mentioned by claim 15 relating to a manufacturing method. The precursor is not directed towards the use of a specific photoresist or printing method. Insofar as the patent refers to the removal of the image recording layer in a non-image area on a printing press by claim 15, and on the removal of a non-image area by printing ink or dampening water by claim 16, both features being characteristic for a printing plate of an on-press development type, this is not reflected in patent claim 1. Neither is claim 1 restricted to a special type of image recording layer. It may be of the positive or

negative type [0094].

48. The printing plate precursor according to feature **1.1** comprises an aluminium support and according to feature **1.2** an image recording layer. Feature **1.3** sets out that an anodized film is arranged inbetween. Further layers like an undercoat layer [0293 et seqq.], an overcoat layer [0299 et seqq.] or a protective layer [0327 et seqq.] are optional and not reflected in patent claim 1.
49. The image recording layer contains according to feature **1.9** an acid color former. The acid color former according the description is a compound that exhibits a color-developing property by being heated in a state of accepting an electron-accepting compound, for example, a proton such as an acid [0100]. The type of acid color former is not limited within the scope of the claim. It can be a compound having structures being rapidly opened or cleaved, whereby a leuco dye is preferable [see paras. [0100] et seqq.).
50. The acid color former enables the formation of a print-out image by coloring an exposed region [0007]. However, it is assumed that in a case where an aluminium support with an anodized film is used together with an image recording layer containing an acid color former, appearance failure may occur. The occurrence of appearance failure is suppressed according to the lithographic printing plate precursor of the patent-in-suit, particularly by the micropore structure in the anodized film according to features **1.4** to **1.7'** [paras. 29 to 31].
51. Therefore, features **1.4** to **1.7'**, which refer to the anodized film, are of importance. The anodized film is characterized by the geometrical dimensions of the micropores, that is the spatial design of the anodized film. In a case where large-diameter micropores are included whose maximum diameter inside the anodized film is in a range of 0.01 mm and 0.30 mm and the average pore diameter in the surface of the anodized film is 90 % or less of the maximum diameter of the micropores inside the anodized film, dissolution of the anodized film is unlikely to be promoted even in a case where the component in the image recording layer infiltrates into the micropores [0031]. Further, scratch resistance of the precursor is considered to be improved [0032], whereby stain is unlikely to be generated on the scratched sites after a

lithographic printing plate is obtained [0033].

52. Figure 3 below shows a schematic embodiment of micropores within the anodized film according to the features **1.4** to **1.7'** [0055 et seqq.].



53. Figure 3 illustrates an example of a cross-sectional view obtained by enlarging one micropore (30) [0057]. The micropores (30) may be distributed in the entire surface of the anodized film or in at least a portion thereof [0043]. A maximum diameter (122) of the large-diameter pore (130) inside the anodized film is in a range of 0.01 mm to 0.30 mm [0058]. The average pore diameter (124) of the large-diameter pores (130) in the surface of the anodized film (20) is 90 % or less of the maximum diameter (122) of the micropores inside the anodized film, preferably in a range of 5 % to 70 % and more preferably in a range of 10 % to 50 % from the viewpoint of suppressing the appearance failure [0059, 0064]. Thus, the amended main request with its feature **1.7'** refers to the more preferably range.

54. The thickness F of the anodized film (20) of figure 3 is in a range of 550 nm to 2850 nm, which is directly covered by feature **1.8**, preferably in a range of 600 nm to 2500 nm and more preferably in a range of 700 nm to 2500 nm [0075]. And the average depth D of the large-diameter pores (130) from the surface of the anodized film to the bottom

is preferably in a range of 100 nm to 1500 nm and more preferably in a range of 200 nm to 1000 nm [0076]. Optionally the large-diameter pore (130) has communicating from its bottom a small-diameter pore (132) [0062].

55. According to the description the average diameter of the small-diameter pores is determined as follows. The average diameter of the small-diameter pores (132) is calculated as an arithmetic average value obtained by observing 4 sheets ( $N = 4$ ) of the surfaces of the anodized film (20) using a field emission scanning electron microscope (FE-SEM) at a magnification of 150,000, measuring the diameters of micropores (small-diameter pores) present in a range of 400 nm  $\times$  3600 nm in the obtained four sheets of images, and averaging the values. In a case where the depth of the large-diameter pores is large, the average pore diameter of small-diameter pores (132) may be acquired by cutting – for example, cutting the upper portion using argon gas – the upper portion (a region where large-diameter pores are present) of the anodized film (20) as necessary and observing the surface of the anodized film (20) using the FE-SEM [0071].

56. The patent-in-suit does not describe how to determine the average diameter of large-diameter pores on the surface of the anodized film, nor does it describe how to determine the respective maximum diameter or the average depth of the large diameter pores. Insofar, as the void volume of the micropore, which is not subject of any claims, is calculated as an arithmetic average value obtained by observing 4 sheets ( $N = 4$ ) of the cross sections of the anodized film (20) using a field emission scanning electron microscope (FE-SEM) at a magnification of 150,000, measuring the void volume in a range of 400 nm  $\times$  3600 nm in the obtained four sheets of images, and averaging the measured values [0042], the skilled person will understand that this measurements are used generally for the determination of other diameters and depths as well.

57. Features **1.6** and **1.7'** are directed to average values of depths or pore diameters, respectively. The patent-in-suit does not disclose the number of measured values to build the average and its standard deviation. Thus, a single measured value may deviate significantly from the average value.

58. The shape of the large diameter and the small-diameter pores is not particularly limited. Exemplary shapes include a substantially straight tubular shape (substantially cylindrical shape), a conical shape whose diameter decreases toward the depth direction (thickness direction), and an inverse conical shape whose diameter increases toward the depth direction (thickness direction). Further, the shape of the bottom portion of both pores is not particularly limited, but may be a curved shape (depression) or a planar shape [0067, 0074].
59. According to this, in the case where large-diameter micropores include small-diameter micropores, the micropore comprises one pore with different diameters in depth consisting in that scope of a two-part structure.
60. Insofar, as the patent-in-suit relates to the measurement of selected portions of the anodized film, it is for the scope of protection sufficient that as much of the micropores comprise said geometrical dimensions to ensure the above-described characteristics of suppressing the occurrence of appearance failure. In other words, the existence of other micropores differing from the claimed geometrical dimensions does not lead out of the scope of protection. This is to be understood before the background of the anodization process, which will not produce micropores with an ideal shape throughout the whole layer as displayed in the schematic drawings.
61. Contrary to defendants' opinion the shape of the micropores at the surface of the anodized film is not limited. Therefore, an uneven structure where, for example, partial recesses at the very top of the micropores and thus at the surface of the anodized film are present and protrude in a spike-like structure, are neither excluded by claims, nor description, nor the schematic figures. In particular, such structure does not hinder the determination of the average pore diameter in the surface.
62. The features of the independent claims 15 and 16 correspond largely to those of claim 1. The subject-matter of the independent claims 15 and 16 is therefore subject to the same assessment as that of claim 1 without need for further interpretation.

#### B. COUNTERCLAIM FOR REVOCATION

63. The counterclaim, being directed against the remaining German part of the patent-in-

suit (see supra admissibility), is to be dismissed. Neither can the Defendants rely on public prior use, nor does the patent-in-suit lack novelty or inventive step, nor does it contain added matter.

#### NO PUBLIC PRIOR USE

64. The Defendants cannot successfully rely on public prior use. The Defendants were not able to submit sufficient facts to establish that the subject-matter of the patent-in-suit is anticipated by printing plate precursors available before the relevant priority date of 29 September 2017 as the first priority claimed.

65. Insofar as the Defendants argue that the priority of JP 2017190837 (JP '837) cannot be claimed (SoD paras. 32 et seqq.) without the Claimant specifically addressing this argument in its further briefs, the grounds submitted are insufficient so as to deny the priority claimed. In essence the argument submitted is that claim 1 of JP '837 only relates to one aspect A of two separate aspects A and B which, according to the Defendants, had been separately claimed by the application protecting those distinct aspects in two independent claims 1 and 3. Only claim 3 of the application was upheld and corresponds to claim 1 of the patent-in-suit. That argument is inconclusive as the disclosure of the priority document is not limited to its claims. According to Art. 87(1) EPC, a European patent application is only entitled to priority in respect of the same invention as was disclosed in the previous application. The subject-matter of the invention must be clearly identifiable as a whole. This means that all essential elements of the invention must be directly and unambiguously apparent from the prior application. In this context it is decisive what is being disclosed by the priority document as a whole and the same test as for novelty applies (see only EPO G 2/98 No.6; further established case law of the German FCJ applying the same standards: BGH, 11.9.2009, BGHZ 148, 383 – Luftverteiler, BGH, 14.10.2003, GRUR 2004, 133 (135) – Elektronische Funktionseinheit, BGH 30.01.2008, GRUR 2008, 597 (598) - Betonstraßenfertiger). Therefore, there is no sufficient argument being presented that JP '837 lacks disclosure of aspect B, as Defendants limit the disclosure counter to these principles to the claims of the priority document and do not elaborate on the disclosed technical teaching in the document as a whole. Therefore, the relevant priority date is 29 September 2017.

66. In this context, the further analysis is to be limited to the facts which had been presented in the Statement of Defense and the Counterclaim for Revocation. It is in those briefs that the defendant has to submit reasons why the action shall fail, R. 24(g) RoP and the grounds for revocation have to be presented comprehensively, R. 25(1)(b) and (c) RoP whereas the following briefs have to limit themselves to a response to matters raised in the Reply, R. 29(c) and (d) RoP. In the proceedings lying before the panel, however, the Defendants submitted abundant new facts in their rejoinder and reply to the counterclaim alone. If that were allowed, this would call for additional briefs by the Claimant so as to be able to respond to such fresh arguments and allegations leading to a new round of briefs not foreseen in the front-loaded procedure enshrined in the RoP. In case a defendant needs more time to clarify facts it will have to submit a request to extend the time limits for the respective brief, which hasn't been the case here. Otherwise submitting fresh facts and arguments in the rejoinder alone would amount to a welcome opportunity to hold back points and avoid the Claimant having an opportunity to respond in the written procedure.
67. The facts which had been submitted in the Statement of defense and counterclaim are insufficient to substantiate that the printing plate precursors of Defendants, on which their prior public use argument is based, were publicly available. Rather the allegations and documents show that before the relevant priority date such plates had been protected by an at least implicit confidentiality regime. Therefore, the highly contested question, if the plates delivered possessed the properties according to the invention and had been reproducible can be left open.
68. Defendants submit as facts to support their argument that the development of the so-called [...] substrate had started under the project name [...] in early [...] at the German premises in Osterrode, Germany. Commercial scale production had started in [...] with plates being sold to customers in [...], i.e., after the relevant priority date of 29 September 2017. Since [...] such plates had been manufactured "on the production line", using the "same substrate and same settings of the manufacturing line" as employed later. Defendants, however, did not set out any details of said manufacturing settings. One sample of the batch of printing plate precursors

manufactured on [...] (batch #[...]) had been retained. Plates from that batch had been delivered to [...] in [...].

69. Furthermore, according to Defendants' allegations, more plates had been produced "for sale" on [...] under badge number #[...]. 360 plates (12 packs of 30 plates) from that batch had been delivered to [...] on [...], i.e., after the relevant priority date of 29 September 2017.

70. In support of these allegations a witness declaration exhibit T-10 had been presented. Defendants further relied on a witness declaration exhibit T-09 and referred to the document presented in exhibit T-17 ("the mid-year review [...]") as well as an internal test report, analysing the results of the test carried out at [...] (exhibit T-16). Further, internal email correspondence has been submitted as exhibit T-18.

71. The witness declaration T-09 submits that an employee of Defendants group was present only during the first day of the testing in order to assist [...] in adjusting the machines and to collect data for internal analysis. During this time, 70 of the 300 [...] printing plate precursors were consumed. Thereafter, the remaining 230 printing plate precursors remained in the possession of [...], which could allegedly "freely dispose of them and planned to use them for a job at the end of June". There allegedly were "no instructions as to how [...] should proceed with the test plates or dispose of them after use or how to discuss the results with other partners within the trade".

72. These facts are not sufficiently substantiated to show that there were no confidentiality agreements in place. Rather the fact that the tests carried out at [...] and its results were dealt with in a report (exhibit T-16) marked as "confidential/for internal use only" is counter to the absence of any confidentiality obligations. In that report is being stated that the remaining plates will be used for printing jobs of [...] with a certain run length and that the remaining 230 out of 300 plates – 70 of which had been used in the tests – will be consumed in print job for [...] in [...]. This indicates that the plates were not intended for any external use or distribution. The documents affirm that the test plates remained at [...]. There is no indication

whatsoever that an interested member of the public would have been granted access to the test plates, which had been sent to [...] in the course of the cooperation which aimed at carrying out test runs and test prints so as to assess the quality of the plates. Under these circumstances it would have been decisive in the eyes of the panel to submit facts and present evidence that the partner involved in these test runs, [...], understood the delivery not to be subject to any confidentiality restrictions but that the test plates could be shared with anyone, even Claimant, in case there were an interest. Defendants especially did not offer any evidence in the form of witnesses from [...] so as to affirm their allegations. However, it would have been critical to see, how the circumstances of the test job had been understood at their end. Confronted with this point in the oral hearing, representatives of Defendants only put forward that such witnesses were not available as [...] had fallen into insolvency and therefore no witnesses could be reached. Furthermore, Exhibit T-17, which is in part redacted for the court as well as for the Claimant, does not establish any facts which lead into another direction as it only deals with the future business plans and apparently aims at swearing in sales people of Defendants' group to support the future commercialization of the new product line and highlight the business potential of the project [...]. Still, as the burden of proof to establish that the plates were publicly available rests on Defendants' side, that is insufficient.

73. Thus, it can be left open, if the plates that had been delivered to [...] and/or [...] had the same properties as foreseen by claim 1 and found in the attacked embodiment, which had been heavily contested by Claimant. In that context it is sufficient to remark that alleging that the production conditions had been identical without describing them in detail, could not be considered to be sufficient to believe that the products are available since it is apparent from the whole technical discussion in these proceedings that the properties of the product depend largely on the exact process conditions. Also the witness declaration according to exhibit T-10 does not add any details which go beyond what had been presented in the Statement of Defence.

#### Novelty over WO 2018-160379 A1 (WO'379; T12)

74. The subject-matter of claim 1 is new with respect to WO'379, which is only relevant

with respect to novelty as it has a priority date before the earliest priority date of the patent-in-suit but was published after that date.

75. WO'379 relates to lithographic printing plate precursors comprising an aluminium-containing substrate that has been prepared using two separate anodizing processes to provide different aluminium oxide layers with different structural properties (p. 1, l. 5-11). According to the description, for simplification of the lithographic printing plate making process, omission of the pre-development heating step (preheat) and carrying out development on-press (DOP) using a lithographic printing ink or fountain solution to remove unwanted (non-exposed) imageable layer materials on the lithographic printing plate precursors, are used. Such negative-working lithographic printing plate precursors should be designed by balancing many features within the element structure in order to achieve optimal press life, on-press developability, and scratch resistance (p. 2, l. 17-25). Metal-containing substrate comprising aluminium or an aluminium-alloy are commonly anodized one or more times to provide an outermost hydrophilic aluminium oxide coating for abrasion resistance and other properties of the resulting lithographic printing plate precursor once one or more imageable layers have been formed thereon (p. 3, l. 10-14). However, lithographic printing plate precursors prepared according to known methods are still unsatisfactory in one or more precursor properties (p. 3, l. 21-28). Based on this, the technical problem of WO'379 is to balance the manufacturing conditions, especially during anodization, for negative-working lithographic printing plate precursors so that improved scratch resistance is achieved without sacrificing press life and on-press developability (p. 3, l. 29-32). As a solution, WO'379 proposes a lithographic printing plate precursor comprising a substrate having a planar surface, and a radiation-sensitive imageable layer disposed over the planar surface of the substrate. The substrate comprises an aluminium-containing plate having a grained and etched planar surface. On the grained and etched planar surface an inner aluminium oxide layer is disposed. The inner aluminium oxide layer has an average dry thickness of at least 650 nm and up to 3000 nm. It comprises a multiplicity of inner micropores having an average inner micropore diameter of less than or equal to 15 nm. Furthermore, an outer aluminum oxide layer is disposed on the inner aluminum oxide layer. This layer comprises a multiplicity of outer

micropores having an average outer micropore diameter of at least 15 nm and up to 30 nm. The layer has an average dry thickness of at least 130 nm and up to 650 nm. A combination of two anodizing processes is carried out in such a manner as to achieve the recited features of both the inner and outer aluminium oxide layers (p. 8, l. 4-8).

76. WO'379 describes a precursor with features **1**, **1.1**, **1.2**, **1.3**, **1.4**, **1.6**, **1.8** and **1.9**, which is not disputed by the Claimant and also not the result of an erroneous legal assessment.

77. WO'379, however, does not disclose feature **1.5** or feature **1.7'**.

78. In principle, when assessing novelty, the disclosure of a prior-art document also extends to a result which is automatically achieved as a result by reworking a procedure which is being described in a manner, which allows reworking by the person skilled in the art, or where the procedure for reworking is obvious to a person skilled in the art which aims at arriving at a specific technical result. In that way the result itself, at which the skilled person arrives by reworking according to the disclosed procedure, is also directly and unambiguously disclosed. However, this requirement is not met, if the desired result may only be achieved by accident as the procedure for reworking is neither sufficiently disclosed nor suggested by the prior art (cf. in that sense also BGH, 30.1.2024 – X ZR 15/22, GRUR 2024, 749 – Organogelmaterial at para 75 et seq.).

79. When applying this standard, features **1.5** and **1.7'** are not directly and unambiguously disclosed by WO'379. Defendants claim that reworking example 7 of WO '379 inevitably leads to a product which also possess the properties described in feature **1.7'**. However, they exclusively rely on the reworking of that example by Dr Merka, one of the inventors of the technical teaching of WO '379, who states that he carried out the reworking by applying "the same procedure" he used "at that time" (Exhibit T 30, p. 2). Hence, the reworking is not based on process conditions which the average person skilled in the art in the art would be able to extract from the disclosure of the document but on specialist knowledge of one of its inventors. Therefore, even if it were accepted that the person skilled in the art would have

sufficient reason to rework example 7 in order to study the properties of the result achieved thereby, it has not been submitted that the document itself discloses in sufficient details the conditions for reworking example 7.

80. WO'379 discloses outer micropores having an average diameter of at least 15 nm and up to and including 30 nm. Because the outer micropore diameter can be determined from a top view SEM image (p. 9, l. 25-28), this is the diameter of the outer micropores in the surface of the anodized film. However, the relation between maximum diameter according to feature **1.5** and the pore diameter in the surface according to feature **1.7'** is not disclosed. Therefore, the reworking argument employed by Defendants has to be revisited. However, these features are not disclosed intrinsically by reworking the teaching of WO'379, either. The first and second anodizing treatments are carried out by modifying electrolyte concentration, temperature, current density, dwell-time and charge density (p. 44-45, table I). Thus, a micropore having a large and a small diameter portion is formed. However, the said features do not inevitably result from the process described in WO'379 for manufacturing the lithographic printing precursor, because the description discloses various treatment steps for preparing the aluminium substrate of the invention examples on page 43 and the following pages. Which treatment steps are crucial for the reworking in order to determine the claimed characteristics subsequently, is not part of the disclosure nor are the claimed characteristics inevitably obtained (c.f. p. 14, l. 15 to p. 15, l. 24, particularly p. 15, l. 21-23). This view is also supported by the fact that the patent-in-suit itself is silent on the circumstances necessary to obtain the required property.

81. Furthermore, even the reworking of example 7 only leads to a ratio of 56 %, i.e., outside the range of feature **1.7'**. If Defendants argue that 56 % for sample A were well within the standard deviation of 50 % this cannot serve as an argument since even if that were to be accepted, a direct and unambiguous disclosure cannot be found on the basis of such standard deviation.

#### Novelty over EP 2 878 452 A1 (EP'379; T41)

82. The subject-matter of claim 1 is also new with respect to EP'452, which is an

application filed by Claimant and which had not been considered in prosecution.

83. EP'452 relates to a lithographic printing plate support and a method of manufacturing a lithographic printing plate support, as well as a lithographic printing plate precursor. State of the art lithographic printing plate supports exhibiting good properties in respect to long press life and excellent on-press developability have been prepared by anodizing a roughened aluminium plate surface in a first step, followed by pore-widening treatment, and a subsequent step for reanodizing under such conditions that the diameter of micropores may be smaller than that in the anodized film formed in the first step [0004]. Generally, the press life has a trade-off relation with the on-press developability and it has been difficult to simultaneously achieve these properties [0006]. Based on this, the object of EP'452 is to provide a lithographic printing plate support that has excellent scratch resistance, enables a lithographic printing plate formed therefrom to have a long press life, and is capable of obtaining a lithographic printing plate precursor exhibiting excellent on-press developability [0008]. Still, the avoidance of appearance failure is not specifically being addressed in the document but only the aspect of dotted scumming, which in the eyes of Claimant cannot be equated with appearance failure (see *infra*).

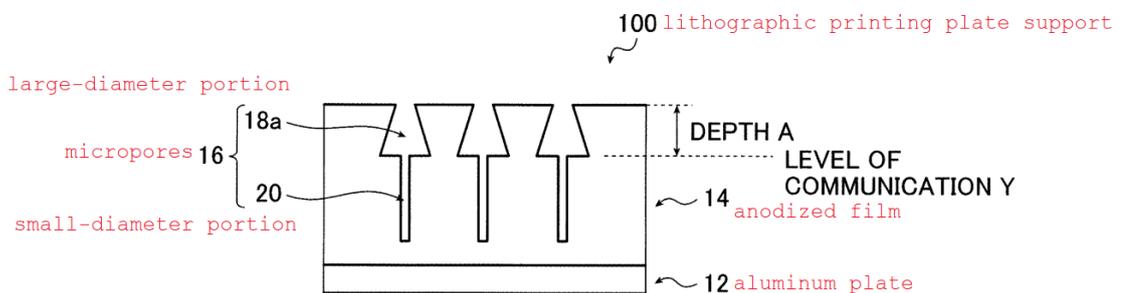
84. As a solution, EP'452 suggests to control the micropore shape, particularly, shape of a large-diameter portion thereof, in the anodized film [0009]. Therefore, EP'452 provides a lithographic printing plate support, comprising an aluminium plate and an anodized film of aluminium which is formed on the aluminium plate and has micropores extending therein from a surface of the anodized film opposite from the aluminium plate in a depth direction of the anodized film. Each of the micropores has a large-diameter portion which extends from the surface of the anodized film to an average depth (depth A) of 75 nm to 120 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to an average depth of 900 nm to 2,000 nm from a level of communication with the large-diameter portion. An average diameter of the large-diameter portion at the surface of the anodized film is at least 10 nm but less than 30 nm and a ratio of the depth A to the average diameter (depth A/average diameter) of the large-diameter portion is more than 4.0 but up to 12.0. In particular, in terms of longer press life, the average

diameter is preferably from 10 nm to 25 nm, more preferably from 11 nm to 15 nm and even more preferably from 11 nm to 13 nm [0026].

85. Figure 2 below shows an alternative schematic embodiment of the large diameter portion within the anodized film according to EP'452. This embodiment differs in the values of average diameter and ratio of the depth given above.

86.

FIG. 2



87. EP'452 describes a precursor with features **1**, **1.1**, **1.2**, **1.3**, **1.4** and **1.8**, which is not disputed by Claimant and also not the result of an erroneous legal assessment.

88. However, EP'452 does not directly and unambiguously disclose the ratio addressed in feature **1.7'** between the average pore diameter of the micropores in the surface of the anodized film in relation to the maximum diameter of the micropores inside the anodized film. Rather, Defendants argument is based on an arbitrary selection, which is based on hindsight and not inherently disclosed as put forward by Defendants (rejoinder para 269).

89. As Defendants refer to Table 2 of EP'452 only Examples 3, 11 and 12 show surface layer average diameters in nm and bottom average diameters in nm of 12/25 (example 3), 12/25 (example 11) and 13/26 (example 12). However, the skilled person looking at table 2 realizes those values only as being values which are included in fourteen different column of table 2 without there being any indication to read the entries in the table in a certain relation to each other. Such reason to read the entries in table 2 in a specific context can also not be derived from Table 3

which sets out quality levels of the example plates with regard to certain properties. Neither of example 3, 11 or 12 stands out when compared with the other examples. Therefore, the skilled person does not have reason to focus on these examples, nor do they give him a reason to put both values of the diameters in context with regard to avoiding appearance failure.

90. Furthermore, as far as feature **1.9** is concerned, none of the examples 3, 11 and 12 include an acid color former. The image recording layer-forming coating liquid was obtained by mixing a photosensitive solution and a microgel solution [0286], the photosensitive solution not including an acid color former (see ingredients in [0287]).

#### INVENTIVE STEP OVER EP'452

91. The technical teaching of claim 1 also is inventive in the light of EP'452.

92. With regard to inventiveness, there is no motivation for the skilled person to recombine the micropore properties of the thirty examples disclosed in table 2 so as to arrive at a technical solution which is encompassed by the patent-in-suit.

93. In general, a claimed solution is obvious if, starting from the prior art, the skilled person would be motivated (i.e. have an incentive or in German: "Veranlassung", see the CoA in NanoString/10x Genomics, p. 34) to consider the claimed solution and to implement it as a next step ("nächster Schritt", CoA in NanoString/10x Genomics, p. 35, second par.) in developing the prior art (UPC, Central Division Munich, Decision of 16 July 2024, UPC\_CFI\_14/2023, point 8.6).

94. As laid out before there is no indication to focus on Examples 3, 11 and 12 as the disclosure of EP'452 does not teach the person skilled in the art that a certain combination of properties is advantageous when trying to solve the technical problem which is addressed by the patent-in-suit, i.e., the avoidance of appearance failure occurring on the print-out images (see patent-in-suit [0007 et seq.]). The patent-in-suit explicitly presents as solution to that technical problem that the specific micropore structure taught and claimed by the patent-in-suit helps to suppress the occurrence of appearance failure, even if conceding that an

explanation why exactly this desired effect is achieved remains unclear (patent-in-suit at [0030]). Still, it lays out in [0031] that dissolution of the anodized film is unlikely to be promoted even in a case where the component in the image recording layer infiltrates into the micropores. Hence it elaborates explicitly on the connection of the micropore structure and here on the ratio between the diameter of the large-diameter pores inside the anodized film in relation to the diameter of the pores in the surface of the film. No such correlation is addressed in EP'452. Therefore, the skilled person, when studying the technical teaching of EP'452 is not motivated to specifically narrow its focus on just these three examples, on which Defendants rely in their line of arguments. Even if the argument were followed that "appearance failure" as being addressed by the patent-in-suit and the avoidance of "dotted scumming" in EP'452 are to be equated, for which there is little reason to agree as the first relates to the problem of errors in the print-out image (i.e., an image used for checks before the final image is printed) whereas the latter relates to defects in the printed image as the final product of the printing job, picking out examples 3, 11 and 12 and analysing further the properties of the micropores in these examples and in a next step musing on whether or not the ratio of micropore parameters contributes to advantageous results, nothing would motivate the skilled person to focus on examples 3, 11 and 12. All the examples had only a performance of "B" in respect to microdots whereas other examples performed "A" or even "AA".

95. Therefore, it can be left open, if – as a next step – the skilled person is sufficiently motivated to combine such structure as shown in examples 3, 11 and 12 with an image recording layer containing an acid color former according to feature **1.9**. Defendants advanced that the skilled person had motivation and reason to combine examples 3, 11 and 12 – none of which has an acid color former as is undisputed amongst the parties and follows from the ingredients of the photosensitive solution used in the examples and described in para. [0287] – with an acid color former as EP'452 in the so called "first configuration" (described in paras. [0189] et seqq.) made clear reference to JP'434 for "colorants and printing-out agents" thereunder listing up acid color formers next to radical color formers as well as the so called "second configuration" (paras. [0219] et seq.) referred to further ingredients such as crystal violet, victoria pure blue and malachite green as known acid color formers. In

Defendants' view EP'452 also referred in general to on-press developability, e.g., in [0008], so that a skilled person would have reason enough to combine examples 3, 11, 12 with such acid color former in the image recording layer. Still, Claimant rebutted this argument by advancing that the prior art EP'452 focussed on increasing press life and did not deal with the problem of appearance failure in the context of on-press development. Insofar as the prior art EP'452 dealt with a phenomenon called "dotted scumming" (see paras. [0305] et seqq.) this – according to Claimant – must not be equated with appearance failure as dotted scumming concerned defects on the final print, whereas appearance failure relates to defects of the print-out image, which is used for checking quality before mounting the plate on the press, i.e., does not relate to the final product of the printing process. Also the reference in EP'452's [0215] to JP'434 were to no avail as the optional compounds disclosed as colorants may perhaps be used as acid color formers, but had not been disclosed in that specific context or functionality so that the skilled person were not motivated to use those substances in that function, i.e., as color switching agents triggered by acid. Rather the disclosure of radical color formers in that list would render such choice arbitrary. The same were true for the colorants mentioned in the context of the "second configuration" in [0224].

96. In this context, when discussing at length in the briefs whether EP'452 or EP'968 serves as the more adequate starting point according to a closest prior art approach, Defendants themselves express that in their opinion EP'968 is remote from the patent-in-suit. This view is to be shared as EP'968 neither tackles the problem of avoiding the occurrence of unwanted dots or other defects nor does it focus on scratch resistance but on a substrate having a certain reflection density.
97. The same considerations are valid, if – as being discussed by Claimant in the alternative but not accepted by Defendants as a starting point – examples 13 to 15 or 26 to 30 of EP'452 are considered or if a combination of EP'968 and EP'452 is assessed. Even if a skilled person started from EP'968 and now seeks for solutions which provide a printing plate precursor which avoids appearance failure and has a high scratch resistance would not arrive at the claimed invention of the patent-in-suit as EP'452 does neither disclose nor motivate to arrive at the ratio of diameters

addressed by feature **1.7'**. Also US 2009/00047599 A1 (US'599, T40) does not add any further aspects, it has been relied upon only so as to argue on inventive step in regard to feature **1.9** (acid color former).

NO ADDED MATTER

98. Finally, the subject-matter of feature **1.6** of claim 1 of the patent-in-suit does not extend beyond the disclosure of the European patent application in the version originally filed WO 2019/064696 A1, published by the European Patent Office as EP 3 511 174 A1 (EP'174, T2).

99. According to the opinion of Defendants the depth of the large-diameter pores within the range of 100 nm to 1500 nm is only disclosed in combination with micropores containing both large-diameter pores (D) and small-diameter pores (E) as well as the other features of Figure 3. This does not withstand revision.

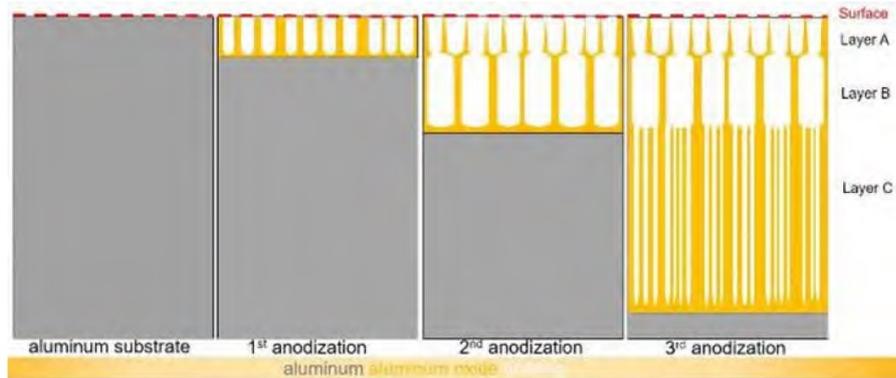
100. Any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims, and drawings) can irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application(s) as filed, (cf. UPC, The Hague Local Division, order of 19 June 2014, UPC\_CFI\_131/2024, ACT\_14945/2024, points 3.4 to 4).

101. Taking these principles into account, it follows in the case in dispute that feature **1.6** is directly and unambiguously disclosed to a skilled person. As shown above with respect to the claim construction of feature **1.8** the application EP'174 was originally directed to a first aspect A and a second aspect B. Contrary to the opinion of Defendants, the second aspect B is related to figure 3. This relation is found both in the description of the original application EP'174 (e.g., par. 102 et seqq., par. 122 et seqq.) and of the patent-in-suit (e.g., par. 55 et seqq., par. 75 et seqq.). Accordingly, the thickness (D) is the depth of the large-diameter pores (130) from the surface of the anodized film to the bottom, which is originally disclosed in application EP' 174 in paragraph 123, being identically worded as the respective paragraph 76 of the patent-in-suit. In addition, according to the

description of both, the application [0014] and the patent-in-suit [0014], the description of constituent elements is made based on representative embodiments of the present disclosure in some cases, but the present disclosure is not limited to such embodiments. Correspondingly, the small diameter pores with respect to figure 3 are optional (application EP'174 [0109]; patent-in-suit [0062]). Therefore, the depth of the large diameter pores within the range given in feature **1.6** is originally disclosed, even without the other features mentioned with respect to the second aspect of figure 3, respectively.

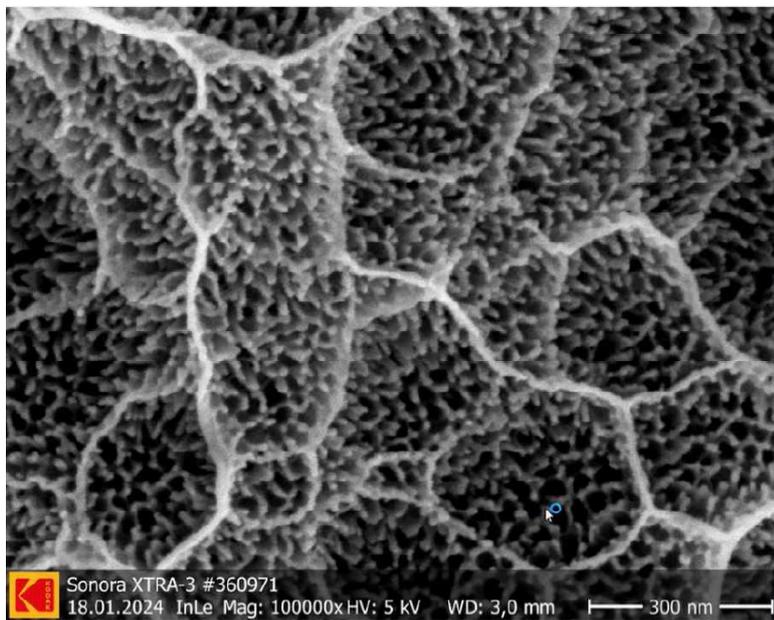
#### INFRINGEMENT BY SONORA-XTRA 3 PLATES

102. The Defendants directly infringe upon claim 1 of the patent-in-suit through the commercialization of Sonora-XTRA 3 plates. The acts of making, offering, placing on the market, using or storing it for those purposes had not been contested by Defendants.
103. Also Defendants cannot be heard with their argument that the attacked embodiment would not infringe upon feature **1.7'** as no pore diameter in the surface could be measured due to the spike-like structure of the surface of the attacked embodiment. In consequence, no measurable continuous boundaries were existent which allowed the determination of a certain diameter. As argument it has in essence been presented that the attacked embodiment is prepared in three anodization steps. In a first step a layer A with pores is formed through a first anodization step. Thereafter, in a second anodization step, a layer B is formed. In the course of this second step the pore walls in layer A are – at least partially – dissolved. In a third anodization step then small-diameter pores are formed as a third layer C, this formation not leading to any dissolution of walls in the structures of the pores in layer A and B. Defendants explained this by referring to the following schematic drawing (Rejoinder para. 14):



104.

105. and produced a picture of the surface of the attacked embodiment as follows:



106.

107. As explained above when interpreting feature **1.7'** (see para. 59) the skilled person also addresses a part of an anodized film as its surface, if there are protrusions or spikes as he understands the figures in the patent-in-suit, which have flat surface as a schematic drawing. He knows that in reality the surface of the anodized film will not be an ideal plane but will have recesses and protrusions which depend on the anodization process applied as well as on the surface structure of the aluminium substrate. Still, the skilled person is able to measure a diameter in said surface, what is being schematically illustrated by Claimant in its crown-like figure, which it copied from a patent application of Defendants highlighting as argument that in this context Defendants do not encounter any difficulty in measuring outer pore diameters ([0160] of WO 2021/067054 A1, T70, and its claim 1):

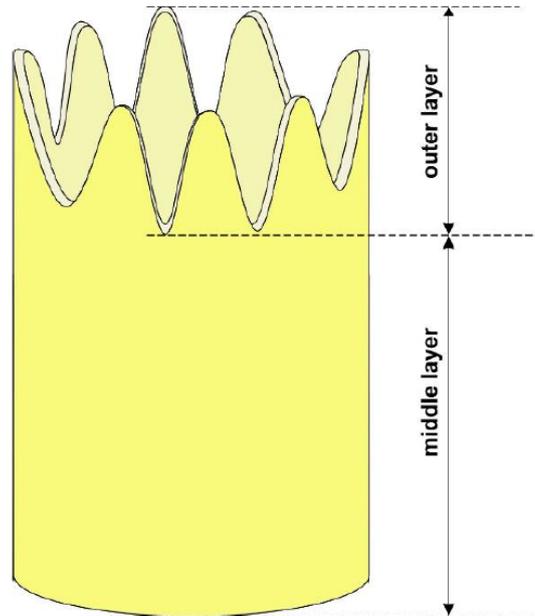


Figure 8 : schematic 3D view of (parts of) Fig. 1 of WO '054

108.

109. and which can also be seen in the enlarged pictures of the attacked embodiment:

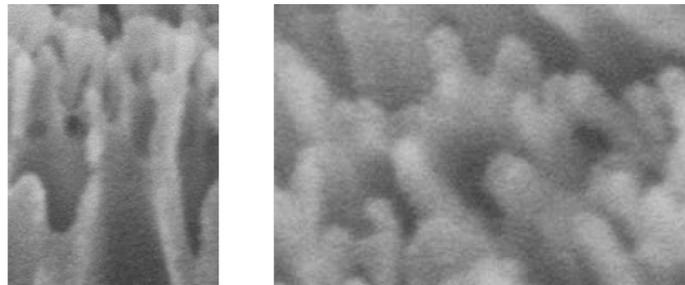


Figure 9 : excerpts from analysis report, Exhibit K15 Annex 1c (diameter small-diameter pore, FE SEM image #348754 n3)

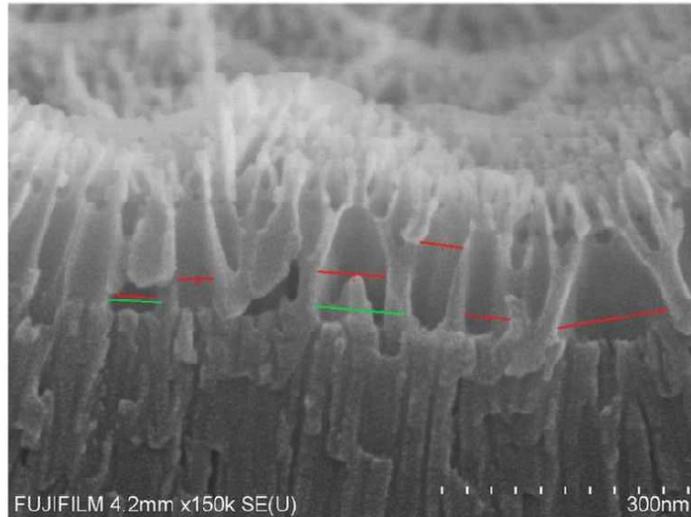
110.

111. Moreover, it is not decisive whether the attacked embodiment had been formed through two or three anodization steps. Even if formed through three steps, there is no reason which mandates to address layers A and B as separate layers as suggested by Defendants.

112. Also the submissions of Claimant are not inconclusive with regard to the measurements as brought forward by Defendants. In the first place, it is insufficient to rely on single measurements only as the patent-in-suit does not demand that all pores have the dimensions as defined in claim 1. Therefore, referring to some measurements allegedly falling outside the range is not a sufficiently substantiated contestation of a substantiated fact. Moreover, with

regard to some contested measurements Defendants define the distance to be measured between side walls of the pore in an inconclusive manner by measuring distances where there is a structure in between two walls (green line: correct measurement in the eyes of Defendants; red line: measurement of Claimant):

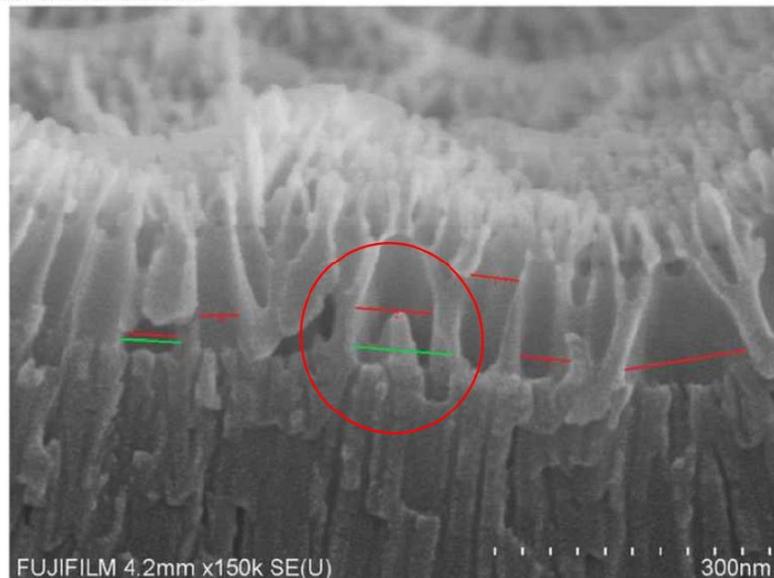
SONORA XTRA-3 #348754 n1



113. (Exhibit K 15 Annex 1c, p. 25, green and red lines added)

114. As criticized by Claimant with highlighting in the following picture and putting forward that the measuring took place across and through solid structures:

SONORA XTRA-3 #348754 n1



115. (Exhibit K 15 Annex 1c, p. 25, green and red lines added)

116. Furthermore, Defendants do not contest the measured average pore diameter of

the pores of the attacked embodiment of 23 nm (Exhibit 15).

NO PRIVATE PRIOR USE RIGHT IN GERMANY

117. Defendants can also not rely on a private prior use right under Art. 28 UPCA, § 12 German Patent Act. At least Defendants did not submit sufficient facts so as to establish that they had also made the final business decision within the Kodak Group to commercialize printing plates with the features of the claimed invention before the relevant priority date.
118. Under established German caselaw it is necessary that a firm and final decision to use the form of alleged prior use took place before the priority date. For this the burden of presentation and proof regarding the underlying facts of a private prior use right lies on the defendant (HRC Düsseldorf, judgement of March 14th, 2018 – I-15 U 49/16 – Schutzverkleidung für funktechnische Anlagen). It is therefore up to the defendant, to prove by submitting relevant documents and/or witnesses that by the date of the priority, he had possession of the invention and exercised the possession of the invention (*Kühnen*, Handbuch der Patentverletzung, 16th Ed. 2024, E. ciph. 662). The Claimant may simply dispute the allegations by the defendant as the Claimant has no insights in the relevant processes at the defendant which constitute the private prior use right (FCJ, judgement of September 20th, 2006 – VIII ZR 127/04, BeckRS 2006, 12687; *Kühnen*, loc. cit. E. ciph. 663). The case law is rigorous regarding the assumption of a private prior use right (FCJ, judgement of November 17th, 1970 – X ZR 13/69, BeckRS 1970, 220; HRC Düsseldorf, judgement of January 11th, 2007 – 2 U 65/05, BeckRS 2008, 5814; RC Düsseldorf, judgement of March 29th, 2013 – 4a O 113/10, BeckRS 2013, 15860; *Kühnen*, loc. cit. E. ciph. 666). This applies not only to the taking of evidence itself, where no reasonable doubt may remain and any uncertainty tends to be to the detriment of the infringing defendant, but also applies equally to the preliminary factual submissions to be made by the defendant in order to arrange for evidence to be taken of the facts of prior use (*Kühnen*, loc. cit. E. ciph. 666). The defendant must make a clear statement as to who exactly, on which specific occasion, made which technical considerations that supposedly resulted in the possession of the invention (*Kühnen*, loc. cit. E. ciph. 666). The same applies to any

accompanying or subsequent acts of use or preparatory acts for immediate use (Kühnen, loc. cit. E. ciph. 666). Substantive submissions are particularly necessary if the documents presented by the defendant do not show the inventive concept (Kühnen, loc. cit. E. ciph. 666).

119. Before the background of these standards Defendants' allegations fall through. Up and foremost Defendants failed to submit detailed facts so as to establish that a final management decision had been made to commercialize plates with properties of the patent-in-suit. Defendants did not elaborate on such explicit business decision nor did they submit any evidence. They only arrive at their conclusion on the basis of incidental circumstances instead of submitting meaningful documents from the top management level in charge of taking such decision which show that such a far reaching decision has been made. This is even more unconvincing since Exhibit T18 shows that there is – as to be expected in a professionally organized company – explicit communication upon central business decisions and respective documentation. In T18 an exchange of [...] – i.e. after the priority date – becomes visible where consent is sought to start merchandising plates under the new official product name SONORA X. Hence, it is not understandable that no documentation at all exists of that, when a new product line which had been tested over a considerable time and with significant effort in a specific composition is being put on the market after various different compositions of the plates had been tested throughout the development phase of the project [...].
120. In that light the incidental facts submitted are insufficient. It had only been submitted that a research project [...] had been launched in [...] and that in the first half of [...] Kodak had the intention to commercialize the [...] plates as the next generation of plates (see submissions of Defendants and identical witness declaration T09). Defendants further submit that plates had been manufactured in [...] and sent to [...] on [...] (see supra). Still, this is to be regarded as a production of plates for test runs in real-life environment of a customer (see supra). No elements point into the direction of a final and firm business decision being present to commercialize at that point of time already. Such business decision is

also not reaffirmed by T17, the already addressed mid-year review of Kodak of [...], which swears in staff members to the new generation of plates and sets out that the new [...] plates are considered to be a game changer for the group of companies. Still, no sufficient facts are presented in that document that a final decision on the properties of such a plate had already been present as it states that [...] has to be “accelerated” (p. 8) which can only be understood to underline that the development had not yet been finalized.

121. Furthermore, no persuasive facts have been presented that in fact the plates which had been produced on [...] had actually been produced for sale in the sense that at that point of time a firm and final business decision was present. Also the witness (T10) only states – as identically submitted as facts in the briefs – that on that date printing plate precursors had been manufactured on the production line in Osterrode. That alone is insufficient, since such production on the production line might also have taken place at a late stage of the ongoing development project [...] in order to check, if the envisaged plates can be produced with satisfaction on the existing production line. So that is no fact which in itself is sufficient to show that a business decision to produce those plates in order to carry out an already taken business decision. The witness does not state that the production had been for sale. Therefore, also the later delivery of 360 plates of that batch to [...] in [...] (i.e. after the priority date) does not offer any incidental facts to conclude that such a business decision to commercialize the plates, if any, had already been taken before 29 September 2017. That is even more unlikely since the IR absorber of the image recording layer in the plates having been produced on [...] was different from the plates, which had been produced in [...] (see T10 points (1) vs (2)). Also the further documentation of the sale of [...] plates to [...] even if taken into consideration would not lead to different conclusions as they may still have been produced in [...] without a firm and final business decision having been taken before the priority date. In the documentation dated [...] the plates are still referred to as [...] plates, not as SONORA X plates. This is justified by Defendants with the remark that the name had only been agreed in [...]. That again rather points into the direction of there being no final business decision instead of supporting Defendants allegations. Finally, also the customer information bulletin

of Kodak dated [...], i.e., long after the priority date, (Exhibit T20) reads as an announcement that the old generation of SONORA UV plates will be upgraded only in 2018 and that the plate at that time is only known under its project name [...]. It continues by setting that the official product name will also only be announced “during the marketing launch in early 2018” and that “extensive field trials with customers in all regions of the world have had impressive results”. This reaffirms the panel in believing that there is a high probability that any deliveries to customers like [...] and [...] in [...] are still part of the extensive field trials. Even in the customer bulletin the attached technical specifications as of [...], i.e., well after the priority date, are referred to as “Draft technical specification”, which again points into the direction that the final settings had not yet been fixed by a prior firm and final business decision. As the project and development proceeds and the plates are deemed to work for printing jobs already with sufficient reliability it is also not surprising that customers, even if plates are received in the course of such trials pay a certain price for consideration as they actually can do their print jobs with the test plates. Therefore, the fact that invoices have been sent and paid alone also is no sufficient point to be relied on that the firm and final business decision had already been taken before the relevant priority date.

#### APPLICABLE SUBSTANTIVE LAW

122. The determination of the substantive law applicable to an alleged infringement is to be strictly distinguished from the jurisdiction to hear the case (cf. Kalden, GRUR Patent 2023, 178 mn. 52; McGuire, GRUR Patent 2024, 466 mn. 5).
123. As developed in detail in the decisions LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 and ORD\_11863/2025, UPC\_CFI\_162/2024 of 11 March 2025, the UPCA is the substantive law applicable to infringing acts after 1 June 2023 since Art. 25 to 28 UPCA refer to a “patent” (cf. Art. 2 (g) UPCA) without distinguishing between European (bundle) patents within the meaning of Art. 2 (e) UPCA and European patents with unitary effect within the meaning of Art. 2 (f) UPCA. Thus, the provisions (at least) apply to infringing acts committed after the entry into force of the UPCA with respect to both types of patents (see LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 of 11 March 2025 at paras. 91-94).

124. Due to the fundamental principles governing retroactivity being enshrined and recognised in European Law and international law, the law applicable to infringing acts before 1 June 2023, i.e., to legal situations that have arisen and become definitive and concluded under the old legal regime, solely is the relevant substantive national law (see LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 of 11 March 2025 at paras. 95-100).
125. As far as infringing acts continued after 1 June 2023, it is again justified to apply the UPCA as a new rule of law also to future effects of facts that have arisen, but have not become definite before 1 June 2023 since such application is not of retroactive effect at least in a strict meaning as referred to in the ECJ case law cited in the decisions referred to supra and therefore not counter to principles of European law. Accordingly, the substantive law of the UPCA also applies to ongoing infringing acts that started before the entry into force of the UPCA and continued after the entry into force on 1 June 2023. When assessing whether infringing acts are in that sense “ongoing” and justify the application of the UPCA, as a general rule, an overly formalistic approach which runs counter to the aims of the Agreement must not be applied. What is decisive is to categorize such acts not in a formalistic manner which only takes into account, if, when viewed from a purely natural perspective, such acts can be referred to as separable acts, but which looks at the scenario from a normative and therefore evaluative perspective. Before this backdrop it is justified to apply the UPCA as a harmonized set of substantive national law of the contracting member states of the UPCA to ongoing acts, if the infringer continues its infringing behaviour although he could have stopped the infringement in the light of the entry into force of the new regime on 1 June 2023. Therefore, it is not decisive that the alleged infringer manually started its production line every day anew so that one could regard all infringing acts of manufacture separately on a daily basis as individual acts of past use before or after the entry into force of the UPCA. What is decisive is that from an evaluative perspective the alleged infringer could have stopped its ongoing production in the light of the entry into force of the UPCA but still made the decision to continue. However, in order to avoid potential hardship, the party concerned may rely on the provisions of the respective substantive national law in

force prior to the entry into force of the UPCA with regard to acts of past use which lie before 1 June 2023 (see LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 of 11 March 2025 at paras. 100 et seq.).

126. Thus, the substantive law to be applied to on the instant facts of the case is the UPCA as the attacked embodiments (SONORA XTRA-3 plates) had been marketed at least also after 1 June 2023.

#### INFRINGING ACTS AND REMEDIES SOUGHT

127. The infringing acts in Germany, which are reserved to the Claimant pursuant to Art. 25 (a), 26 (1) UPCA, remain undisputed by Defendants. The established infringement predominantly justifies Claimant's requests.

#### REQUEST FOR DECLARATION OF INFRINGEMENT

128. The request to hold that the Defendants infringe the patent-in-suit has its basis in Art. 64 (2) (a) UPCA. Since the Claimant did not further elaborate on the request and did not set out that such declaration serves a legitimate interest, the request had to be denied (compare facts in LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 of 11 March 2025 at para. 111), especially since the latest version of the requests explicitly refer to the product name of the attacked embodiment which therefore is displayed in the operative part of the judgement which may be communicated in case of need.

#### REQUEST FOR PERMANENT INJUNCTION

129. The requested injunctive relief has its basis in Art. 25 (a), Art. 63 (1) UPCA. The request is to be granted with regard to the acts of making, offering, placing on the market and using and the acts of storing and importing for those purposes, within Germany, because the infringement in the past constitutes a risk of repetition. There is no need for explicitly deciding upon Claimant's "in particular"-requests relating to the subclaims, because they are merely exemplary specifications of acts already covered by the decision relating to the new Main request's claim 1.

130. Since the court has discretion to grant the permanent injunction (Art. 63 (1) UPCA “may”) the circumstances of the individual case can be taken into account, in particular whether an injunction would be disproportionate (Art. 42 UPCA, Art. 3 (2) Enforcement-Directive). However, since any restriction affects the patent owner’s exclusive right pursuant to Art. 25 UPC which, moreover, is granted for a limited time period only, such a restriction on the grounds of disproportionality has to be limited to exceptional cases where the interest of the infringer clearly outweighs the interest of the patent owner. In accordance with general rules, the burden of demonstration and proof lies on the infringer relying on disproportionality. Defendants’ submissions lack relevant facts which could support that a permanent injunction was disproportionate on the instant facts. The mere reference to the general public interest and defendant’s interest in a functioning market with competing offerors and reliable supply chains does not trump Claimant’s IP rights, which by way of decision of the legislator reserve the infringing acts exclusively to him. The same is true for the reference to Defendants’ general R&D efforts and alleged pioneer position in the field and to their legitimate reason to believe that the patent-in-suit is invalid. Insofar as the Defendants put forward that switching the production facility to the manufacture of different printing plate precursors would only be feasible under significant costs and time that submission lacks substantiation which is even more true since the parties were involved with high motivation to set up a confidentiality regime allowing for such submissions which was acceptable to both sides only after multiple exchanges.
131. The requested threat of a penalty payment in general terms (“to be determined by the court for each case of infringement”) is a sufficient basis to determine such request as Claimant has elaborated on estimated sales price of Defendants’ printing plates per square meter at which it arrives by referring to Defendants’ annual reports and invoices (Exhibit K12) of roughly 10 € per square meter (SoC para 246), which remained undisputed and rather is in line with Defendants’ submissions on security, so that in accordance with previous decisions of the Local Division Mannheim (see LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 of 11 March 2025 at para. 114 (factor 3) and Local division Mannheim

ORD\_598506/2023 UPC\_CFI\_210/2023 of 22 November 2024, para. 175: 1.000 € per mobile) to be dissuasive, the amount is set to 50 € per square meter.

#### REQUEST FOR DECLARATION OF DAMAGES

132. The declaration of entitlement to damages on the merits is based on Art. 68 (1) UPCA and justified by the established infringement. The Defendants, with reasonable grounds, at least should have known that they engage in a patent infringing activity as they are obliged to monitor the IP rights of its competitors so as not to infringe upon them. Accordingly, it is not a prerequisite that the Defendants had been alerted of a possible infringing behaviour. Such doctrine would support careless behaviour and protect patent infringers without sufficient justification. Even more than with regard to material property, intellectual property rights are to be protected due to their ubiquity and the resulting danger of unjustified use (cf. recital 3 enforcement directive pointing as well to the obligations arising from the TRIPS agreement and recital 25 which foresees monetary compensation even where an infringement is committed unintentionally and without negligence as well as Art. 13).
133. The determination of the amount of damages and time periods to be taken into account is reserved for subsequent proceedings under R. 125 et seqq. RoP (see LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 of 11 March 2025 at para. 103 et seqq., 116 and infra at “ordering information”).
134. As far as the requests extends back to 17 July 2019 with regard to Germany, in the light of the reasoning given in the statement of claim, the request has to be interpreted to relate to compensation pursuant to Art. 67 EPC the amount of which is to be determined in subsequent proceedings under R. 125 et seqq. RoP as well. Therefore, at this stage, the panel does not have to adjudicate on potential time periods to be left out in this regard either.

#### REQUEST TO PAY DAMAGES IN COMPENSATION FOR MORAL PREJUDICE

135. The request for damages in compensation for moral prejudice finds its basis in Art. 68 (3) (a) UPCA specifying some appropriate aspects which the Court has to take

into account when setting the damages. However, pursuant to Art. 68 (3) (a) UPCA, moral prejudice is only one among other aspects which have to be taken into account. Thus, it could already be questionable whether Art. 68 (3) (a) UPCA allows an award of damages in compensation for moral prejudices up-front and separately from the setting of the overall damages. In any case, the award of compensation for moral prejudice requires special circumstances which go beyond the usual consequences of an infringement suffered by the patent holder and which are not fully compensated by the other remedies. The Claimant did not bring forward any specific fact which would justify such compensation but just rely on general aspects as trivializing the patent and negative effects on general research efforts which come with every patent infringement. Also the reference to Kodak's annual report (Exhibit K24) which names Claimant and Agfa as main competitors and in the next paragraph highlight the SONORA process free plates does not suffice to justify the request as it does not specifically deny the innovative capacity of the competitors, let alone the innovative capacity as incorporated in the patent-in-suit, in a way to justify a request for moral damages. Thus, the request had to be denied.

#### REQUEST FOR INTERIM AWARD OF DAMAGES

136. Claimant seeks an interim award of damages according to R. 119 RoP, estimating the minimum amount of damages by focusing on publicly available sales numbers as well as information from invoices in possession of Claimant (Exhibit K 12). R. 119 RoP gives the court discretion ("may"). When exercising its discretion the court has to take all relevant circumstances into account including the interest of the parties to obtain or avoid, respectively, an interim award of damages. The granting of such interim award does not follow the establishment of an infringement automatically but calls for justification. The Claimant did not demonstrate any facts justifying the requested interim award. In particular, the Claimant did not elaborate on why obtaining the requested amount of EUR 10 Million up-front would be an essential element of compensation in the light of the infringement found on the instant facts. This is all the more true considering the fact that Claimant bases its estimation on a weak reasoning by merely stating that the entire production of SONORA XTRA plates in 2021 probably accounts for infringing plates without taking into account that finally Claimant restricted its requests to SONORA XTRA-3 only.

## REQUEST FOR INFORMATION

137. The request for information finds its basis in Art. 67 (1) UPCA and Art. 68 (3) (a) (b) UPCA in conjunction with R. 191 sentence 1 alternative 2 RoP, respectively. The right to information is comprehensive even if the infringer committed a single act out of the several acts of use under Art. 25 (a) UPCA only. Thus, the infringer owes information in particular about all aspects listed in Art. 67 (1) UPCA regardless of which infringing act was established. Information may have to be rendered in consequence of the infringement found which after evaluation by the Claimant and/or the court do not relate to such infringing acts and may not be used to calculate damages. E.g., it may not be for the infringer to finally assess, if certain items offered or delivered, which qualify as means relating to an essential element of the invention, were used for a subsequent direct infringement by arguing they were not and therefore not to render the respective information. The same holds true for the information to be rendered according to Art. 67 UPCA which may be used in subsequent proceedings in which damages are being determined (R. 125 et seqq. RoP). Furthermore, the Claimant will in many instances not know in which temporal scenario his case resides. It may be uncertain, if infringement only occurred prior to the entry into force of the UPCA, or if the case concerns a scenario extending beyond 1 June 2023 or if Claimant is faced with a scenario where all relevant facts only lie after 1 June 2023 so that solely the UPCA and RoP apply. Hence, it is only after the information under Art. 67 UPCA had been rendered that Claimant will know if and to what extent rules of national law play a role and may limit or extend Claimant's claims compared to the rules enshrined in the UPCA and the RoP and are worth being litigated upon. In consequence, it is not for the operative part of the decision on the merits according to R. 118 RoP to limit the extent of information time-wise up-front based on arguments of national law applicable to acts lying before 1 June 2023. Rather information is to be rendered in accordance with the requests of the Claimant and is limited by the date of the grant of the patent or the publication date of the patent application respectively on the one hand and, as applicable, by Art. 72 UPCA on the other hand (see also LD Mannheim ORD\_11865/2025, UPC\_CFI\_159/2024 of 11 March 2025 at para. 103).
138. Since and to the extent the patent holder – as regularly – needs the information to

identify third infringers, to determine and calculate damages and to verify information obtained from the infringer, such right regularly is not disproportional. In particular, the infringer's commercial interests are sufficiently protected, because the information obtained must not be used for any other purpose than the purposes mentioned above. In case of an indication of a specific risk of misuse, the information can be further protected by protective orders pursuant to R. 262A RoP.

139. In order to protect Defendants' relationship to their non-commercial costumers, if any, it suffices that the Defendants reserve the right to disclose the names of their non-commercial customers to an impartial auditor only, chosen by Claimant and paid by Defendants, who, upon Claimant's request, confirms or denies whether a specific non-commercial customer is contained in the disclosure and who, in all other cases, is subject to confidentiality towards the Claimant. Art. 67 (c) UPCA does not apply to non-commercial costumers who, according to Art. 27 (a) UPCA, are not capable of committing and taking part in infringing acts. However, the patent holder is entitled to information which allows him to verify whether the information obtained from the infringer is true. Therefore, he must have the right to check whether non-commercial customers he knows of are included in the sales and offers reported by the infringer. The defendant's right to disclose non-commercial customers to an auditor according to the procedure takes due account of the interests of both parties. The auditor's costs if the infringer makes use of this option are part of the costs of providing information, which must be borne by the infringer.
140. The panel exercises its discretion not to determine a fixed time period for the provision of the information and not to set an amount of penalty in case of non-compliance up-front, thereby retaining the flexibility to take into account the circumstances of the failure if the Defendants should fail to provide proper information in due time. As regularly, the infringer has to provide the information as soon as possible without undue delay. Also the request to provide information supported by evidence verified by an independent accountant had to be rejected as the comprehensiveness of the information rendered is sufficiently ensured by the possibility of severe penalties to be imposed on Defendants, if falsified and/or insufficient information is rendered.

141. The request to destroy the infringing embodiments in possession and/or ownership in Germany is based on Art. 64 (1), (4), (2) (e), (b) and (d) UPCA, respectively. In exercising its discretion (cf. Art. 64 (1) UPCA “may”) the court has to take into account the circumstances of the single case and to balance the interests of the parties considering the principle of proportionality (Art. 64 (4) UPCA). In order to effectively avoid further acts of infringement, the requests shall be granted on a regular basis. The burden of demonstration and proof of any circumstance justifying to refrain from such grant is for the infringer objecting to the grant of corrective measures, e.g., on grounds of disproportionality. The Defendants did not state such circumstances in the proceedings at hand. However, no legal basis to order the production of evidence certified by an independent bailiff as to how and when destruction was carried out can be found in the UPCA nor the RoP. Again, the threat of penalties serve as a sufficient remedy to ensure compliance with the decision.
142. The recall is to be restricted to commercial recipients only, because private end users are not part of the channels of commerce (cf. Local Division Düsseldorf, decision of 3 July 2024, UPC\_CFI\_7/2023, GRUR-RS 2024, 17732 mn. 143). However, Claimant’s request takes this into account by restricting the requested recall to the channels of commerce. Again, the Defendants did not state any specific fact which calls for the assumption of disproportionality. It is for the infringer to take the appropriate measures to be taken to make an appropriate recall. Similarly as for the destruction, it lies in the infringer’s own vital interest to indicate the fulfilment of its recall obligation beyond any reasonable doubts towards the Claimant in order to avoid an enforcement proceedings. However, contrary to Claimant’s request at hand, there is no need to order the infringer to provide a list of the recipients of the recall letter.
143. In accordance with the wording of Art. 64 (2) UPCA, the definite removal of infringing products from the channel of commerce is a separate corrective measure additional to the recall (cf. Local Division Mannheim, decision of 22 November 2024, UPC\_CFI\_210/2024 mn. 177). The Defendants did not state any specific fact which would turn the removal disproportionate. In the opinion of the panel, it suffices to request and order the definite removal without specifying the modalities thereof (different opinion Local Division Düsseldorf, decision of 3 July 2024, UPC\_CFI\_7/2023, GRUR-RS 2024, 17732 mn. 147). The reason is that Art. 64 (d) UPCA calls for the

success of the definite removal. It is the infringer's responsibility how he guarantees such success.

#### REQUEST FOR PUBLICATION

144. The requested publication of an own declaration by the Defendants on their webpage may find its basis in Art. 64 (1), Art. 80 UPCA 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 (cf. Local Division Düsseldorf, decision of 31 October 2024, UPC\_CFI\_373/2023, p. 25). Such special and specific circumstances are not shown by the Claimant on the instant facts. The same applies to the rectification letters understood as a separate remedy. As far as the rectification letters form part of the recall, it is for the Defendants how to phrase the recall letter in order to fulfil the obligation (cf. supra).

#### REQUEST FOR AN INTERIM AWARD ON COSTS

145. The request finds its basis in Art. 69 UPCA, R. R. 118(5), 119, R. 150(2) RoP. The panel exercises its discretion to grant the interim award on costs as requested. The amount is well below the sum of the recoverable court fees and the maximal costs recoverable for the value in dispute of 15 Million € which the Claimant according to its brief of 4 February 2025 already exceeded. The panel has not doubt that Claimant incurred costs at least in the amount requested as interim award on cost.

146. Since the statement of claim was successful, in its essence and the panel considers the economical focus of the case to be on the product Sonora XTRA-3, Defendants had not been granted an interim award on parts of their costs despite the partial withdrawal of the infringement action regarding Sonora X and Sonora XTRA-2.

#### INDIRECT INFRINGEMENT

147. With regard to the indirect infringement of claims 15 and 16 by the attacked embodiment as means relating to an essential element of the invention within the territory of Germany as Contracting Member State, the requests are justified according to Art. 26 (1) UPCA, 65 (1) UPCA (permanent injunction barring supply and offering to supply); Art. 26 (1) UPCA, Art. 67 UPCA, Art. 68 (3) (a), (b) UPCA, R. 191 S. 1 RoP (information), Art 26 (1) UPCA, Art 68 (1) UPCA, R. 119 RoP (damages) and Art

63(2), 82 (1) and (4) UPCA, R. 354.3 RoP (penalty). Reference is made to the considerations supra. As far as requests B.V. also refers to A.III.2 this is considered to be a mere oversight by Claimant. It is furthermore not apparent that the attacked embodiment can be used without making use of the invention so that an unrestricted permanent injunction appears justified.

#### ENFORCEMENT SECURITY

148. Art. 82 (2) UPCA, R. 118.8 RoP give the court the discretion to make any order subject to the provision of a security for its enforceability. When exercising its discretion the court has to take into account the circumstances of the single case at hand and has to balance the interest of the parties involved including the Claimant's interest to enforce its property rights effectively and the defendant's to enforce possible claims for damages effectively as well in the event the enforced decision is reverted later on. The enforcement of possible claims for damages against a Claimant could be put in jeopardy by the financial situation of Claimant, his unwillingness to compensate defendant and by any circumstances at the places where potential claims for damages may have to be enforced that render the enforcement impossible or unreasonably burdensome. Whether and to what extent such factors are present is to be determined on the basis of the facts and arguments put forward by the parties, in the same way as in the case of an application for security under Rule 158 RoP. Since the ordering of a security for the enforceability serve the purpose to protect defendant, it is, first, for defendant to demonstrate and justify (and, if necessary, prove) as to why it appears appropriate in the specific case at hand to make the order or measure subject to a security in accordance with R. 118.8 RoP. Afterwards, it is for Claimant to dispute these facts in a substantiated manner, especially because Claimant generally has knowledge and evidence regarding his financial situation. In addition, it is for the Claimant, if necessary, to demonstrate and justify (and, if necessary, prove) why, despite the reasons put forward by defendant, his interest in the enforceability of the order or measure without a security takes precedence over defendant's interest (cf. Local Division Düsseldorf, decision of 31.10.2024, UPC\_CFI\_373/2023, p. 26).
149. Applying these principles, the panel exercises its discretion not to make the enforceability subject to the provision of a security by Claimant. The Defendants did not put forward sufficient facts justifying such order, in particular constituting a risk

that potential damage and costs are not recoverable in the event the decision at hand is reverted. They only advance in general terms that the attacked embodiment makes up for a large part of Defendants' manufactured products and that enforcement would lead to massive losses in sales revenues and in profits whereas providing security would not be difficult for Claimant. Defendants did not address specifically why an injunction would inevitably result in the losses claimed as, e.g., easy work-around solutions might be available. The same holds true for the damage resulting from an allegedly forced market exit as just referring to the high competitiveness of the business sector alone is not sufficient. As far as the defendants put forward that the customers had to adjust their printing presses to the use of certain printing plates so that it was not possible to switch at short notice is also too vague as is the reference to a new certification process being necessary. This holds true especially before the background that defendants were able to have customers use multiple versions of the printing plates during the field trials and alleged commercial transactions which had been advanced so as to establish a prior use right. Finally, Defendants did not argue that Claimant's group were not sufficiently solvent to compensate damages incurred with an enforced decision being reverted. In contrast Claimant pointed to it having also considerable assets within the EU, which could be subject to any enforcement measure of Defendants.

150. The same holds true for Defendants' request to permit the Defendants to avert enforcement of the decision by providing security.

#### COSTS

151. The decision on costs is based on Art. 69 (1) UPCA, R. 118.5 RoP. Since the statement of claim was unsuccessful to a minor part only and the panel considers the economical focus of the case to be on the product Sonora XTRA-3, the panel exercises its discretion that the Defendants have to bear the recoverable costs in full despite the partial withdrawal of the infringement action regarding Sonora X and Sonora XTRA-2.
152. Claimant clarified in the oral hearing that it did not intend to apply to increase the ceilings set forth in the Administrative Committee's decision on scale of ceilings under para 3. of its brief of 4 February 2025. Defendants did not apply for an increase of the ceilings either.

#### VALUE IN DISPUTE

153. The value of the dispute is set to 15.000.000 € after having heard the parties in the oral hearing.

#### NO PROVISIONAL INJUNCTION FOR UK

154. As far as Claimant requests that the Court grant a provisional injunction for the UK in the event the Court should find any reason to stay the proceedings as they relate to infringing acts carried out in the UK, or not to grant a permanent injunction for the United Kingdom (UK) until further conditions are fulfilled, the proceedings have been separated and will be dealt with in subsequent proceedings after having discussed the consequences of the ECJ's decision without there being a basis for granting such interim relief in the meantime.

#### DECISION:

A.I. The Defendants are ordered 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. A lithographic printing plate precursor comprising:
    - an aluminum support; and
    - an image recording layer on the aluminum support,
    - wherein the aluminum support includes an anodized film on a surface of the image recording layer side,
    - the anodized film has micropores extending in a depth direction from the surface of the anodized film on the image recording layer side,
    - the micropores include at least large-diameter pores whose maximum diameter inside the anodized film is in a range of 0.01  $\mu\text{m}$  to 0.30  $\mu\text{m}$ , and wherein an average value of depths of the large-diameter pores to the bottom from the surface of the anodized film is in a range of 100 nm to 1500 nm,
    - an average pore diameter of the micropores in the surface of the anodized film is in a range of 10% to 50% of the maximum diameter of the micropores inside the anodized film,
    - a thickness of the anodized film is in a range of 550 nm to 2850 nm, and

the image recording layer contains an acid color former,

- direct infringement of claim 1 EP 3 511 174 B1 -

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 preparing a lithographic printing plate, comprising

a step of imagewise-exposing the lithographic printing plate precursor of any of claims 1-14; and

a step of supplying at least any of printing ink or dampening water and removing an image recording layer in a non-image area on a printing press.

- indirect infringement of claim 15 EP 3 511 174 B1 -

- b. a printing method, comprising:

a step of imagewise-exposing the lithographic printing plate precursor according to any one of claims 1 to 4;

a step of supplying at least any of printing ink or dampening water and removing a non-image area of an image recording layer on a printing press to prepare a lithographic printing plate; and

a step of performing printing using the obtained lithographic printing plate.

- indirect infringement of claim 16 EP 3 511 174 B1 -

A.II. It is ordered, that in the event of any violation of the injunction under A.I. above, the respective Defendants shall pay severally to the Court a penalty payment of EUR 50 per square meter of the contested printing plate precursor.

B.I. It is held that the Defendants shall pay damages to the Claimant compensating all losses caused by infringing acts referred to in A.I. above in Germany since 17 July 2019.

- II. The Defendants are ordered to inform the Claimant to the extent of which the Defendants have committed the infringing acts of EP 3 511 174 referred to in A.I – stating

1. the origin and distribution channels;

2. the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained;

in particular

- manufacturing quantities and times;
- 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;
- the turnover, the gross margin and the contribution margin generated by the Defendants with the sale of these products;
- 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;
- 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;
- 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;

whereby the Defendants each reserve the right to disclose the names of their non-commercial customers to an impartial auditor only, chosen by Claimant and paid by the respective Defendant, who, upon Claimant's request, confirms or denies whether a specific non-commercial customer is contained in the disclosure and who, in all other cases, is subject to confidentiality towards the Claimant.

- III. The Defendants are ordered to destroy at their own expense the products, material and/or implements referred to under A.I.1. which are in their possession and/or ownership within Germany.
- IV. The Defendants are ordered to recall the products referred to under A.I. which have been placed on the market from the channels of commerce, with reference to the infringement determined by a court of law (Unified Patent Court, Local Division Mannheim, decision of 2 April 2025);
- V. The Defendants are ordered to definitively remove the products referred to under A. I. from the channels of commerce at their own expense;
- VI. The Defendants are ordered to pay the Claimant the sum of EUR 300.000 as an interim award on the legal costs and other expenses.

C. All further requests of Claimant are dismissed.

- D. The counterclaim for revocation is dismissed.
- E. The Defendants have to bear the costs of the litigation.
- F. The value of the dispute is set at EUR 15.000.000.
- G. The Orders A.I., B.II. to B.VI. shall be enforceable only after the Claimant has notified the Court which part of the orders it intends to enforce, this notification has been served on the Defendant concerned and a certified translation of the orders in the official language of a Contracting Member State in which the enforcement shall take place has been provided by the Claimant and served on the Defendant concerned.

Delivered in Mannheim on 2 April 2025

**NAMES AND SIGNATURES**

Presiding judge Tochtermann	
Legally qualified judge Agergaard	
Legally qualified judge Böttcher	
Technically qualified judge Wismeth	
For the Sub-Registrar: Kranz, Clerk LD Mannheim	

**Information about appeal**

An appeal against the present Decision may be lodged at the Court of Appeal, by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of its notification (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RoP).

**Information about enforcement** (Art. 82 UPCA, Art. Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP)

An authentic copy of the enforceable decision or order will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.