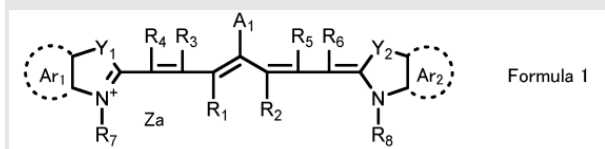


UPC CFI, Local Division Düsseldorf, 21 February 2024, Fujifilm v Kodak



PATENT LAW – PROCEDURAL LAW

Time limits for filing the Statement of defence and the Counterclaim for revocation extended to 7 February 2024, as it was not possible to upload the Counterclaim for revocation on 6 February 2024 for internal technical reasons ([Rule 9\(3\) RoP](#), [Rule 25\(1\) RoP](#))

• **[Claimants' requests for a decision by default against the defendants in the main proceedings pursuant to Rule 355 \(1\)\(a\), 277 RoP and for a rejection of the Counterclaims for revocation is rejected.](#)**

1. Although the Statement of defence shall include a Counterclaim for revocation, the parties shall make use of the official forms available online ([Rule 4\(1\) RoP](#)). In practice, this means that the Counterclaim for revocation must also be filed in the workflow provided for this purpose by the CMS. Only when this requirement has been met is the Counterclaim for revocation properly filed.

2. Where the defendant has filed a Statement of defence in due time in accordance with the requirements of [Rule 25.1 RoP](#), the time limit for filing the Counterclaim for revocation in the dedicated workflow of the CMS may be extended retrospectively upon request ([Rule 9.3 \(a\) RoP](#)) and subject to the following conditions:

Firstly, the defendant must have already made a first attempt to file the Counterclaim for revocation in due time in the workflow provided for this purpose before the expiry of the time limit.

Secondly, the defendant must have uploaded the Counterclaim for revocation to the correct workflow without culpable delay after the expiry of the deadline

Source: [Unified Patent Court](#)

**UPC Court of First Instance,
Local Division Düsseldorf, 21 February 2024**
(Thomas)

Düsseldorf Local Division
UPC_CFI_355/2023

Procedural Order

of the Court of First Instance of the Unified Patent Court issued on 21 February 2024 concerning [EP 3 594 009 B1](#)

HEADNOTES:

1. *Although the Statement of defence shall include a Counterclaim for revocation, the parties shall make use of the official forms available online. In practice, this means that the Counterclaim for revocation must also be filed in the workflow provided for this purpose by the*

CMS. Only when this requirement has been met is the Counterclaim for revocation properly filed.

2. *Where the defendant has filed a Statement of defence in due time in accordance with the requirements of [Rule 25.1 RoP](#), the time limit for filing the Counterclaim for revocation in the dedicated workflow of the CMS may be extended retrospectively upon request ([Rule 9.3 \(a\) RoP](#)) and subject to the following conditions:*

Firstly, the defendant must have already made a first attempt to file the Counterclaim for revocation in due time in the workflow provided for this purpose before the expiry of the time limit.

Secondly, the defendant must have uploaded the Counterclaim for revocation to the correct workflow without culpable delay after the expiry of the deadline.

KEYWORDS:

Statement of defence; Counterclaim for revocation; time period; deadline; extension of a time limit; retrospectively; CMS; workflow

CLAIMANT:

FUJIFILM Corporation, 26-30, Nishiazabu 2-chome, Minato-ku, Tokyo 106-8620, Japan,
represented by: Lars Baum, HOYNG ROKH MONEGIER, Steinstraße 20, 40212 Düsseldorf, Germany

electronic address for service: ...

DEFENDANT:

1. **Kodak GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs ... and ..., at the same place, represented by: Eva Acker, Freshfields Bruckhaus Deringer Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz 1, 40545 Düsseldorf, Germany
electronic address for service: ...

2. **Kodak Graphic Communications GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs ... and ..., at the same place, represented by: Eva Acker, Freshfields Bruckhaus Deringer Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz 1, 40545 Düsseldorf, Germany
electronic address for service: ...

3. **Kodak Holding GmbH**, Kesselstraße 19, 70327 Stuttgart, represented by its CEOs ... and ..., at the same place, represented by: Eva Acker, Freshfields Bruckhaus Deringer Rechtsanwälte Steuerberater PartG mbB, Feldmühleplatz 1, 40545 Düsseldorf, Germany
electronic address for service: ...

PATENT AT ISSUE:

European patent n° [EP 3 594 009 B1](#)

PANEL/DIVISION:

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This order was issued by Presiding Judge Thomas acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS:

Patent infringement action – [Rule 9.3 \(a\) RoP](#) Extension of a deadline

SUMMARY OF THE FACTS:

The defendants request that the time limits for filing the Statement of defence and the Counterclaim for

revocation be extended to 7 February 2024, as it was not possible to upload the Counterclaim for revocation on 6 February 2024 for internal technical reasons. The unredacted version of the Statement of Defence, which already included the Counterclaim for revocation, was filed on time. Only placeholders were uploaded instead of the redacted versions of the documents referring to the Statement of defence and the Counterclaim for revocation.

The claimant opposes this request for an extension of the time limits and asks the Court to

- Issue a decision by default against the defendants in the main proceedings UPC_CFI_355/2023 according to [Rule 355\(1\) \(a\), 277 RoP](#);

- Reject the Counterclaims for revocation CC_3088/2024, CC_3090/2024 and CC_3093/2024.

Alternatively, the claimant requests to extend the deadlines of the claimant for the Rejoinder in the main proceedings CFI_355/2023 and the Defence to the Counterclaim in the proceedings CC_3088/2024, CC_3090/2024 and CC_3093/2024 by one week.

The defendants have agreed to this extension.

GROUND FOR THE ORDER:

The time limit for filing the Counterclaim for revocation was not observed in the present case. Although the Statement of defence shall include a Counterclaim for revocation, the parties shall make use of the official forms available online ([R. 25.1, R. 4.1 S. 2 RoP](#); UPC_CFI_8414/2024 (LD Düsseldorf), Order of 15 February 2024; [UPC CFI 9/2023 \(LD Munich\), Order of 3 Oktober 2023](#)). In practice, this means that the Counterclaim for revocation must also be filed in the workflow provided for this purpose by the CMS. Only when this requirement has been met is the Counterclaim for revocation properly filed.

Whether an exception should be made in cases where the relevant workflow is not available for technical reasons within the CMS (see UPC_CFI_365/2023 (LD Mannheim), Order of 19 February 2024) does not need to be decided in the present case. The reasons why the Counterclaim for revocation was not uploaded to the CMS in the workflow provided for that purpose within the time limit were entirely within the sphere of responsibility of the defendant and not the CMS.

Where – as in the present case – the defendant has filed a Statement of defence in due time in accordance with the requirements of [Rule 25.1 RoP](#), the time limit for filing the Counterclaim for revocation in the dedicated workflow of the CMS may be extended retrospectively upon request ([Rule 9.3 \(a\) RoP](#)) and subject to the following conditions:

Firstly, the defendant must have already made a first attempt to file the Counterclaim for revocation in due time in the workflow provided for this purpose before the expiry of the time limit.

Secondly, the defendant must have uploaded the Counterclaim for revocation to the correct workflow without culpable delay after the expiry of the deadline.

The defendants have complied with these requirements in this case. The Statement of defence, including the Counterclaim for revocation and its annexes, was

uploaded in due time. The uploading of a redacted version is not a prerequisite for the filing of a complete Statement of defence including the Counterclaim for revocation, even if a [Rule 262A RoP](#) application is filed at the same time. In addition, the defendants attempted to upload the Counterclaim for revocation to the CMS before the deadline. Due to an internal technical error within the sphere of the defendants, the Counterclaim was uploaded immediately after the deadline.

Therefore, a retrospective extension of the time limit for filing the Counterclaim for revocation by one day is exceptionally justified here.

As the Counterclaim was filed in time due to the extension of the time limit, no decision by default can be issued and the Counterclaim for revocation cannot be rejected.

The claimant's request for an extension of the time limits was granted as the defendants agreed to the extension and the claimant only received the unredacted versions of all submissions and exhibits one week after the defendants' deadlines.

ORDER:

I. At the request of the defendants, the time limits for filing the Counterclaims for Revocation are retrospectively extended to 7 February 2024. There is no need to extend the time limits for lodging the Statement of defence.

II. The Claimants' requests for a decision by default against the defendants in the main proceedings UPC_CFI_355/2023 pursuant to [Rule 355 \(1\)\(a\), 277 RoP](#) and for a rejection of the Counterclaims for revocation CC_3088/2024, CC_3090/2024 and CC_3093/2024 is rejected.

III. At the request of the claimant and with the agreement of the defendant, the time limits for the Claimant to file its Rejoinder in the main proceedings (ACT_578607/2023; UPC_CFI_355/2023) and its Defence to the Counterclaim for revocation (CC_3088/2024, CC_3090/2024 and CC_3093/2024) are extended to 15 April 2024.

DETAILS OF THE ORDER:

App_6926/2024 related to the main proceeding ACT_578607/2023

UPC-Number: UPC_CFI_355/2023

Subject of the Proceedings: Patent infringement action

Issued in Düsseldorf on 21 February 2024

Presiding Judge Thomas
