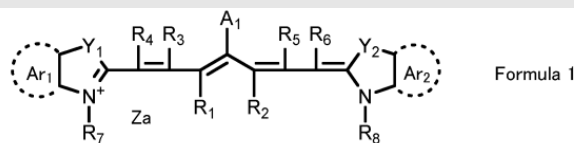


UPC CFI, Local Division Düsseldorf, 2 August 2024, Fujifilm v Kodak



PATENT LAW – PROCEDURAL LAW

An amendment of an application for amendment of a patent

- is not governed by Rule 263 RoP but to be classified as a subsequent request to amend the patent within the meaning of Rule 30(2) RoP, which is admissible only with the permission of the Court

The intended deletion of the limitation to the German designation of the patent in suit is also not subject to [R. 263 RoP](#). If auxiliary requests filed in the context of an application for amendment of the patent are to be amended later, the scope of [R. 263 RoP](#) is not open from the outset. Neither does the Claimant changes its claims nor does it amend its case within the meaning of this provision. Applications to amend the patent are not mentioned in [R. 263 RoP](#).

The conditions under which applications for amendment of the patent are admissible are laid down in [R. 30 RoP](#). According to [R. 30.1 RoP](#), the defence against the counterclaim for revocation may include an application to amend the patent. Any subsequent request for amendment of the patent may only be admitted to the proceedings with the leave of the Court, [R. 30.2 RoP](#), which is a strict preclusion rule ([UPC CFI 210/2023 \(LD Mannheim\), Order of 27 June 2024 – Panasonic Holdings v. Oppo](#)). This would be undermined if it were possible to amend an already filed application to amend a patent on the basis of [R. 263 RoP](#). Such an amendment can only be made by filing a subsequent request to amend the patent, which is only admissible with the permission of the Court.

Territorial limitation of the amendment was inadmissible, in the absence objective reasons for it ([Article 34 UPCA](#)).

- The new applications, without territorial limitations, are ultimately only a clarification of the previous legal situation, is admissible and allowed under Rule 30(2) RoP.

In the light of [Art. 34 UPCA](#) and the requirements of - as a rule - a uniform decision, the territorial limitation of the amendments should only be considered if there are objective reasons for such a limitation. After all, the amendments are the basis for the subsequent decision. If the patentee defends the patent in a limited way in some countries and not in others, this is ultimately the first step towards a later, non-uniform decision. Therefore, a territorial limitation of the amendments should only be possible if there are objective reasons for it.

The Claimant has not provided such reasons, which is why the territorial limitation in the present case was

inadmissible and therefore ineffective in any event. This means that the new applications are ultimately only a clarification of the previous legal situation, but in any case an admissible application under [Rule 30.2 RoP](#).

Source: [Unified Patent Court](#)

UPC Court of First Instance, Local Division Düsseldorf, 2 August 2024

(Thomas)
Düsseldorf Local Division
UPC_CFI_355/2023

Procedural Order

of the Court of First Instance of the Unified Patent Court issued on 2 August 2024

concerning [EP 3 594 009 B1](#)

HEADNOTES:

1. If auxiliary requests filed in the context of an application for amendment of the patent are to be amended later, the scope of [R. 263 RoP](#) is not open from the outset. The conditions under which applications for amendment of the patent are admissible are laid down in [R. 30 RoP](#).

2. If an application for amendment of a patent is to be amended, such a request is to be classified as a further request for amendment within the meaning of [of Rule 30.2 RoP](#). It is admissible only with the permission of the Court.

3. In the light of [Art. 34 UPCA](#) and the requirements of - as a rule - a uniform decision, the territorial limitation of an application to amend the patent should only be considered if there are objective reasons for such a limitation.

KEYWORDS:

Application to amend the patent; amendment of the application; [R. 263 RoP](#); [R. 30.2 RoP](#)

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:

[Rule 263 RoP](#) – Request leave to make a change to the conditional Application to amend the patent

SUMMARY OF THE FACTS AND STATEMENT OF FORMS OF ORDER SOUGHT BY THE PARTIES:

By counterclaim for revocation, the Defendants seek the revocation of the European patent EP 3 594 009 B1 in its entirety **with effect in the territory of all Contracting Member States in which the patent has effect** (emphasis added by the Court).

On 4 June 2024, the Claimant has filed an application to amend the patent. In this context, the Claimant has formulated the following requests:

D. As a further main request,
to dismiss the Counterclaim for Revocation of EP 3 594 009 B1 in its entirety;

E. As a subsidiary request, insofar as the Court considers the claims of EP 3 594 009 B1 to be insufficiently described as contended in the Counterclaim for Revocation,

I. to hold that the Application to Amend **the German designation** of EP 3 594 009 B1 submitted as Auxiliary Request 1 is admissible;
[...]

F. As a further subsidiary request, if the Court considers the claims of EP 3 594 009 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 **the German designation** of EP 3 594 009 B1 submitted as Auxiliary Request 2 is admissible;
[...]

G. As a further subsidiary request, if the Court considers claim 1 of EP 3 594 009 B1 to be both insufficiently described and 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 **the German designation** of European patent No. 3 594 009 B1 submitted as Auxiliary Request 3 is admissible;
[...]
(emphasis added by the Court)

By brief of 10 July 2024, the Claimant filed an “Application to change claim [Rule No. 263 RoP](#)”.

The Claimant puts forward the following arguments in support of its application:

The purpose of the request is to clarify and align the territorial scope of the application to amend the patent. When filing the applications to amend the patent submitted in parallel proceedings between the parties before the Mannheim Local Division, it became apparent to the Claimant that the application to amend the patent in the present proceedings was limited to the “German designation” of the patent in suit. However, as becomes clear from the remaining pleadings of the Claimant, the application to amend the patent shall cover all territories in which the patent in suit has been in force at a certain point of time.

In its original pleading, the Claimant has requested as a compensation that the Defendants be ordered to pay damages for all the territories where the patent in suit has been in force at some point over the non-limited time period. This has always been clear and unequivocal intention of the Claimant since the beginning of the present action. Therefore, even if R. 263.2 (a) RoP were applicable to a request for a mere change of a claim and not limited to an amendment of the case, the present request for leave to change a conditional claim would still comply with the requirements of said Rule. In view of the scope of the Claimant’s original request for damages, covering all designations of the patent in suit which were at some point in force over the non-limited time period, it is, in the Applicants point of view, only logical that the conditional application to amend the patent shall formally extend to those same designations. The present request to leave to change the subsidiary claims submitted through the application to amend the patent in suit therefore aims at clarifying a consistency issue between the Claimant’s current claims. The Claimant shall, thus, be authorized to make the corresponding change to its conditional application to amend the patent. Such an authorisation would not unreasonably hinder the Defendants in the conduct of their action.

In any event, should the Court not grant the requested leave within the meaning of [R. 263 RoP](#), the present application should be admitted into the proceedings, as subsequent requests to amend the patent in accordance with [R. 30.2 RoP](#).

The Defendants objected.

In their view, the requested change is inadmissible. It does not constitute a “clarification” of the previous application of 4 June 2024. Rather, the wording of the previous application clearly indicates that the intention was limited to request amending the German designation of the patent in suit. In consequence, the Claimant’s application of 10 July 2024 constitutes a substantive change to the previous application.

The prerequisites for the admission of such a change in accordance with [R. 263 RoP](#) are not satisfied. In particular, the Claimant could have already made the amendment now requested when filing the reply to the counterclaim for revocation. Therefore, the application is delayed pursuant to [Rule 263.2 RoP](#). Furthermore, the amendment would unduly hinder the Defendants with respect to their defence.

Against this background, the application for leave to change claim would also have to be rejected as inadmissible if it were to be assessed in accordance with [R. 30.2 RoP](#). There are no grounds for admitting the application.

In any event, if the Court grants the Claimant's application, the Defendants should be granted more time to file their rejoinder, reply to the counterclaim for revocation and defence to the application to amend the patent.

INDICATION OF THE PARTIES REQUESTS:

The Claimant asks the Düsseldorf Local Division of the Unified Patent Court, having regard [to Rules 263](#) and [220.2 RoP](#) of the Rules of Procedure,

I. to **grant** the Claimants **request for a leave to change** the application to amend the patent to extend the scope of all designations of the patent in suit (EP 3 594 009);

II. in consequence, to **hold** that the set of requests in the conditional application to amend the patent filed on June 4, 2024 (contained in the consolidated reply to the defence of the statement of claim with reference ACT_578607/2023, in the defence of the counterclaim for revocation with references CC_3088/2024, CC_3090/2024, CC_3093/2024 and in the dedicated workflows App_33385/2024, App_33386/2024, App_33387/2024) shall be replaced by and read as clarified in Annex I attached to the present application and as shown below in an abbreviated form:

“E. As a subsidiary request, insofar as the Court considers the claims of EP 3 594 009 B1 to be insufficiently described as contended in the counterclaim for revocation,

I. to hold that the application to amend EP 3 594 009 B1 submitted as Auxiliary Request 1 is admissible; (...)

F. As a further subsidiary request, if the Court considers the claims of EP 3 594 009 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 3 594 009 B1 submitted as Auxiliary Request 2 is admissible; (...)

G. As a further subsidiary request, if the Court considers claim 1 of EP 3 594 009 B1 to be insufficiently described and 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 European patent No. 3 594 009 B1 submitted as Auxiliary Request 3 as admissible; (...)”

As a subsidiary request, insofar as the Court would not grant the requested leave within the meaning of Rule 263,

III. to admit the present application into the proceedings as a subsequent request to amend the patent in accordance with [Rule 30.2](#). In case of denial of the requested leave to change the application to amend the patent submitted on June 4, 2024 within the meaning of [Rule 263](#) or to file a subsequent request to amend the patent in accordance with [Rule 30.2](#),

IV. to grant the Claimant leave to appeal the order to be handed down.

The Defendants request,

to reject the Claimant's application to leave to change the claim of 10 July 2024.

As a subsidiary request, the Defendants ask for a deadline extension for the Defendants.

GROUND OF THE ORDER:

The Claimant's request to amend its application to amend the patent is to be classified as a subsequent request for amendment under [R. 30.2 RoP](#). This amendment is allowed by the Court in the present case.

1. In view of the wording, the subsidiary requests contained in the application to amend the patent of 4 June 2024 are limited to an amendment of the German designation of the patent in suit. Therefore, the deletion of the addition “the German designation of” in the (subsidiary) requests is not a mere clarification of what was previously intended, even taking into account the applicant's other submissions.

2.

The intended deletion of the limitation to the German designation of the patent in suit is also not subject to [R. 263 RoP](#). If auxiliary requests filed in the context of an application for amendment of the patent are to be amended later, the scope of [R. 263 RoP](#) is not open from the outset. Neither does the Claimant changes its claims nor does it amend its case within the meaning of this provision. Applications to amend the patent are not mentioned in [R. 263 RoP](#).

The conditions under which applications for amendment of the patent are admissible are laid down in [R. 30 RoP](#). According to [R. 30.1 RoP](#), the defence against the counterclaim for revocation may include an application to amend the patent. Any subsequent request for amendment of the patent may only be admitted to the proceedings with the leave of the Court, [R. 30.2 RoP](#), which is a strict preclusion rule ([UPC CFI 210/2023 \(LD Mannheim\), Order of 27 June 2024 – Panasonic Holdings v. Oppo](#)). This would be undermined if it were possible to amend an already filed application to amend a patent on the basis of [R. 263 RoP](#). Such an amendment can only be made by filing a subsequent request to amend the patent, which is only admissible with the permission of the Court.

3.

The Applicant's request is therefore to be classified as an application within the meaning of [R. 30.2 RoP](#). This subsequent request for amendment of the patent is allowed by the Court.

As a general rule, [Art. 34 UPCA](#) provides for a single decision on the revocation action, unless there are objective reasons for limiting it (Tilmann/Plassmann/v. Falck/Dorn, Einheitspatent, Einheitliches Patentgericht, Art. 34 Rz. 93). However, this does not say anything about applications for amendment of the patent, which are only lines of defence for the patent proprietor against a revocation action. Such applications are open to interpretation and cannot be considered in isolation from the counterclaim. [In the light of Art. 34 UPCA and the](#)

requirements of - as a rule - a uniform decision, the territorial limitation of the amendments should only be considered if there are objective reasons for such a limitation. After all, the amendments are the basis for the subsequent decision. If the patentee defends the patent in a limited way in some countries and not in others, this is ultimately the first step towards a later, non-uniform decision. Therefore, a territorial limitation of the amendments should only be possible if there are objective reasons for it.

The Claimant has not provided such reasons, which is why the territorial limitation in the present case was inadmissible and therefore ineffective in any event. This means that the new applications are ultimately only a clarification of the previous legal situation, but in any case an admissible application under [Rule 30.2 RoP](#).

4.

There are no grounds for an extension of the time limits as the Defendants alternatively request.

[R. 9.3 \(a\)](#) of the Rules of Procedure authorises the Court to extend time periods. However, this possibility should only be used with caution and only in justified exceptional cases ([UPC CFI 363/2023 \(LD Düsseldorf\), Order of 20 January 2024, GRUR-RS 2024, 5106](#)).

In the present case, there is no reason to extend the time limits as requested by the Defendants alternatively. The admissibility of the new auxiliary claims is relevant only with regard to the question of the territorial extension of the claims for compensation. The Defendants have already been able to comment on this (and has done so in their statement of defence). The Claimant's most recent submission does not contain any new arguments in this regard.

ORDER:

I. The Application to grant the Claimant's request for leave to change the application to amend the patent to extend the scope of all designations is rejected.

II. The amended set of requests for the application to amend EP 3 594 009 B1, filed on 10 July 2024, is classified as a subsequent request to amend the patent in suit (R. 30.2 RoP). This subsequent request to amend the patent is allowed.

III. The Defendant's request for an extension of the time limit for filing their rejoinder, reply to the counterclaim for revocation and defence to the application to amend the patent is rejected.

DETAILS OF THE ORDER:

ORD_40822/2024 related to App_33385/2024, App_33386/2024 and App_33387/2024 and the main proceeding ACT_578607/2023, CC_3088/2024, CC_3090/2024 and CC_3093/2024

UPC-Number: UPC_CFI_355/2023

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

Issued in Düsseldorf on 2 August 2024

Presiding Judge Thomas