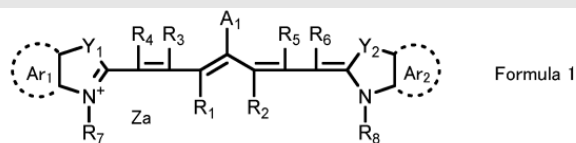


UPC CFI, Local Division Düsseldorf, 30 October 2024, Fujifilm v Kodak



PATENT LAW – PROCEDURAL LAW

Further written pleading with respect to the Defendant's private prior use pleadings on their Rejoinder of 19 August 2024 rejected (R. 36 RoP)

• **Allowing a further written submission would lead to a delay in the proceedings. In view of the oral hearing, which is already scheduled for December, such a delay would be unacceptable to both the Court and the Defendants.**

The Rejoinder was filed on 19 August 2024. The Claimant filed the [R. 36 RoP](#) request on 3 October 2024, only one day before the filing of the Rejoinder in the Counterclaim for revocation. If the Claimant had requested the right to file a further written statement in the infringement action immediately upon receipt of the Rejoinder in order to respond to the Defendants' arguments, the Court could have granted the Claimant the opportunity to file a further written statement in the infringement action within the remaining time limit in the Counterclaim for revocation. However, as the Claimant filed its request shortly before the expiry of the time limit in the Counterclaim for revocation, this possibility no longer existed.

The Claimant's right to be heard is not unduly restricted by the rejection of its request.

• **New factual allegations in the Rejoinder may be rejected (R. 9(2) RoP). If accepted the Claimant will be given the opportunity to respond to the Defendants' new allegations in the Rejoinder during the interim procedure, but at the latest during the oral hearing.**

Even without the submission of further written pleadings in the written procedure, the Claimant will therefore be given sufficient opportunity to respond to the Defendants' new submission in the Rejoinder, if necessary.

Source: [Unified Patent Court](#)

**UPC Court of First Instance,
Local Division Düsseldorf, 30 October 2024
(Thomas)**

Düsseldorf Local Division
UPC_CFI_355/2023

Procedural Order

of the Court of First Instance of the Unified Patent Court issued on 30 October 2024 concerning [EP 3 594 009 B1](#)

HEADNOTES:

1. The fact that the claimant has only one opportunity to submit written observations on the right of prior use is a consequence of the Rules of procedure and the time limits laid down therein. However, in order to give the claimant the opportunity to present further arguments if necessary, [R. 36 RoP](#) provides for the possibility of requesting permission to file additional pleadings.

2. In assessing the prospects of success of such a request, the Court must, on the one hand, have regard to the reasons put forward by the applicant as to why, in its view, further pleadings are necessary. However, the Court must also have regard to the effect of further pleadings on the further course of the proceedings and the risk of delay associated therewith.

KEYWORDS:

[R. 36 RoP](#); further exchanges of written pleadings; prior use right

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: [R. 36 RoP](#) – Further exchange of written pleadings

GROUND FOR THE ORDER:

The fact that the Claimant refers, in support of its request, to the fact that it had only one opportunity to submit written observations on the right of prior use is a consequence of the Rules of Procedure and of the time limits laid down therein. However, in order to give the

Claimant the opportunity to present further arguments if necessary, [R. 36 RoP](#) provides for the possibility of requesting permission to file additional pleadings.

In assessing the prospects of success of such request, the Court must, on the one hand, take into account of the reasons put forward by the Claimant as to why, in its view, further pleadings are necessary. However, the Court must also take into account the impact of further pleadings on the further course of the proceedings and the associated risk of delay.

In the light of those principles, the Claimant's request does not justify allowing it to lodge a further pleading.

The Claimant seeks permission to reply to the arguments put forward by the Defendants in their Rejoinder concerning the private prior use defence. The Rejoinder was filed on 19 August 2024. The Claimant filed the [R. 36 RoP](#) request on 3 October 2024, only one day before the filing of the Rejoinder in the Counterclaim for revocation. If the Claimant had requested the right to file a further written statement in the infringement action immediately upon receipt of the Rejoinder in order to respond to the Defendants' arguments, the Court could have granted the Claimant the opportunity to file a further written statement in the infringement action within the remaining time limit in the Counterclaim for revocation. However, as the Claimant filed its request shortly before the expiry of the time limit in the Counterclaim for revocation, this possibility no longer existed. Allowing a further written submission would lead to a delay in the proceedings. In view of the oral hearing, which is already scheduled for December, such a delay would be unacceptable to both the Court and the Defendants.

The Claimant's right to be heard is not unduly restricted by the rejection of its request.

With respect to the new factual allegations contained in the Rejoinder, the Panel will have to consider whether these new allegations by the Defendants should be rejected under [R. 9.2. RoP](#). If the new allegations are accepted, the Claimant will be given the opportunity to respond to the Defendants' new allegations in the Rejoinder during the interim procedure, but at the latest during the oral hearing. Even without the submission of further written pleadings in the written procedure, the Claimant will therefore be given sufficient opportunity to respond to the Defendants' new submission in the Rejoinder, if necessary.

ORDER:

The request to allow the Claimant the submission of a further written pleading with respect to the Defendant's private prior use pleadings on their Rejoinder of 19 August 2024 is rejected.

DETAILS OF THE ORDER:

App_54506/2024 related to the main proceedings
ACT_578607/2024

UPC-Number: UPC_CFI_355/2023

Subject of the Proceedings: Patent infringement action

Issued in Düsseldorf on 30 October 2024

Presiding Judge Thomas