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**Datasheet for the decision
of 21 February 2013**

Case Number: T 1883/11 - 3.3.10

Application Number: 98932436.3

Publication Number: 998539

IPC: C09K 5/04

Language of the proceedings: EN

Title of invention:
Refrigerant compositions

Patent Proprietor:
E.I. DU PONT DE NEMOURS AND COMPANY

Opponent:
Solvay (Société Anonyme)

Headword:
Refrigerant compositions/DU PONT

Relevant legal provisions:
EPC Art. 84

Keyword:
"Adaptation of description to claims (no) - failure to delete
composition not falling under amended claims"

Decisions cited:
T 1808/06

Catchword:

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Case Number: T 1883/11 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 21 February 2013

Appellant: E.I. DU PONT DE NEMOURS AND COMPANY
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Respondent: Solvay (Société Anonyme)
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Representative: Jacques, Philippe
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
17 June 2011 concerning maintenance of European
patent No. 998539 in amended form.

Composition of the Board:

Chairman: P. Gryczka
Members: J. Mercey
F. Blumer

Summary of Facts and Submissions

- I. The Appellant (Patent proprietor) lodged an appeal against the interlocutory decision of the Opposition Division of 17 June 2011 which found that European patent No. 998 539 could be maintained on the basis of the auxiliary request, but that the main request did not satisfy the requirements of the EPC.
- II. This is the second appeal which has been filed in connection with this patent. In the decision on the first, T 894/05 (not published in OJ EPO), the Board of Appeal remitted the case to the first instance with the order to maintain the patent on the basis of auxiliary request 1, submitted during the oral proceedings before the Board on 11 November 2008, and a description yet to be adapted. Said request consisted of two claims, claim 1 of which read as follows:
- "A refrigerant composition which comprises:
- (a) 46% by weight based on the weight of the composition of pentafluoroethane,
 - (b) 50% by weight based on the weight of the composition of 1,1,1,2-tetrafluoroethane and
 - (c) 4% by weight based on the weight of the composition of n-butane."
- Claim 2 related to a refrigerant apparatus containing the composition as claimed in claim 1.
- III. Upon remittal, the Appellant filed two sets of amended pages of the description as a main request and an auxiliary request, respectively. In the decision now under appeal, the Opposition Division found that the

amended description according to the then pending main request, namely pages 2, 2a and 3 to 5 filed with letter dated 9 December 2009, did not comply with Article 84 EPC, since the sentence "It is clear that similar comments apply to the composition R125 - 46.5%, R134A - 50% and R600 - 3.5%" on page 4, lines 6 to 7, had not been deleted. The description was thus not properly adapted to the limitations carried out in the amended claims. The amended description according to auxiliary request 1, which differed from the description according to the main request only by virtue of a new page 4 filed with telefax dated 24 March 2011 in which said sentence was deleted, was in compliance with Article 84 EPC.

- IV. The Appellant argued that retention of said sentence was justified, as the skilled person would understand amended claim 1 as extending to plus or minus 0.5% in relation to each of the three specifically defined amounts of 46, 50 and 4% for R125, R134A and R600, respectively. Deletion in the set of amended claims of granted claim 13, wherein compositions containing 46.5 and 3.5% of R125 and R600, respectively, were defined, did not correspond to abandonment of the subject-matter claimed therein, said subject-matter still being generically encompassed by amended claim 1.
- V. The Respondent (Opponent) submitted that the contested sentence "It is clear that similar comments apply to the composition R125 - 46.5%, R134A - 50% and R600 - 3.5%" should be deleted, since this composition did not fall under the amended claims. In fact, the description of the patent in suit clearly differentiated between the values 3.5 and 4% and between 46 and 46.5%, so that

the amounts defined in amended claim 1 had to be taken as such and not as ranges extending to plus or minus 0.5%.

VI. The Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request on which the contested decision was based, namely claims 1 and 2 filed during the oral proceedings before the Board on 11 November 2008 and pages 2, 2a and 3 to 5 of the description filed with letter dated 9 December 2009.

The Respondent requested that the appeal be dismissed.

VII. At the end of the oral proceedings held on 21 February 2013, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. In order to meet the requirement of Article 84 EPC that the claims have to be supported by the description, the adaptation of the description to amended claims must be performed carefully in order to avoid inconsistencies between the claims and the description which could render the scope of the claims unclear. Any disclosure in the description inconsistent with the amended subject-matter should normally be excised. Reference to embodiments no longer covered by amended claims must be deleted, unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. In such a case,

the fact that an embodiment is not covered by the claims must be prominently stated (see T 1808/06, not published in OJ EPO).

3. In the present case, the dispute between the parties concerns only the question of whether or not the sentence "It is clear that similar comments apply to the composition R125 - 46.5%, R134A - 50% and R600 - 3.5%" on page 4, lines 6 to 7 of the description of the patent in suit may be retained, namely whether or not it is consistent with the amended claims found by the Board to meet the requirements of the EPC.

4. Claim 1 as remitted to the Opposition Division (see point II above) relates to a refrigerant composition comprising by weight (a) 46% pentafluoroethane (R125), (b) 50% 1,1,1,2-tetrafluoroethane (R134A) and (c) 4% n-butane (R600).

5. The Appellant argued that retention of the contested sentence was justified because the composition "R125 - 46.5%, R134A - 50% and R600 - 3.5%" defined in the contested sentence fell under amended claim 1, since the skilled person would not understand amended claim 1 as relating to a single specific composition only, but rather as extending to ranges of plus or minus 0.5% in relation to each of the three specifically defined amounts of 46, 50 and 4%, for R125, R134A and R600, respectively.
 - 5.1 However, the Board, holds that the composition R125 - 46.5%, R134A - 50%, R600 - 3.5% does not fall under the subject-matter of claim 1 of the patent in suit, since claim 1 defines a refrigerant composition defined in

terms of specific percentage weight amounts, namely 46, 50 and 4%, the description of the patent in suit not providing the skilled person with any reason to understand these specific percentage weight amounts as extending to plus or minus 0.5%. On the contrary, the patent in suit, when defining the percentage weight amounts of the components of the refrigerant compositions described therein, quite clearly differentiates between values which differ by 0.5%. The sentence in question is an example therefor, as it compares a composition comprising 46.5% of R125, 50% of R134A and 3.5% of R600 with the composition of Example 1 comprising 46% of R125, 50% of R134A and 4% of R600, these two compositions also being distinguished in the table on page 4, lines 10 to 16 of the application as filed. Comparative Examples 2 and 3 on page 4 of the patent in suit, wherein the amounts of R125 and R600a differ by 0.5%, further illustrate the fact that the patent in suit distinguishes between percentage weight amounts of components of refrigerant compositions differing by 0.5%. Contrary to the argumentation of the Appellant, claim 1 does indeed relate to a specific composition, as supported by the description wherein the amounts of 46% of R125 and 4% of R600 in claim 1 find support in the application as filed as one of the **"specific formulations"** (emphasis added) described on page 4, lines 10 to 16 and in the particular formulation of Example 1, only, there being no suggestion in the patent specification that these amounts are approximate values, let alone that they extend to plus or minus 0.5%.

5.2 The Board is thus not convinced by the Appellant's arguments and as a consequence holds that retention of

the contested sentence on page 4 of the patent in suit leads to unclarity of the subject-matter claimed, as it could suggest to the reader, contrary to the facts of the case, that the claims embrace said composition.

6. By virtue of this sentence on page 4, lines 6 to 7 of the patent specification, the amended version of the specification according to the main request on which the contested decision was based cannot be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

P. Gryczka