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**Datasheet for the decision  
of 11 January 2017**

**Case Number:** T 0258/13 - 3.2.07

**Application Number:** 08154667.3

**Publication Number:** 2008946

**IPC:** B65D77/00

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**Title of invention:**  
Container for liquids

**Patent Proprietor:**  
Greif International Holding B.V.

**Opponent:**  
PROTECHNA S.A.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 56, 104(1)  
RPBA Art. 16(1)(c)

**Keyword:**  
Inventive step - (yes)  
Apportionment of costs - (yes)

**Decisions cited:**

T 0053/06, T 2179/09, T 0556/96, T 0930/92, T 1704/06

**Catchword:**



**Beschwerdekammern**  
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European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 0258/13 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 11 January 2017**

**Appellant:** PROTECHNA S.A.  
(Opponent) Avenue de la Gare 14  
1701 Fribourg (CH)

**Representative:** advotec.  
Patent- und Rechtsanwälte  
Bahnhofstrasse 4  
57072 Siegen (DE)

**Respondent:** Greif International Holding B.V.  
(Patent Proprietor) Bergseweg 6  
3633 AK Vreeland (NL)

**Representative:** Perani, Aurelio  
Perani & Partners  
Piazza San Babila, 5  
20122 Milano (IT)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 5 December 2012  
rejecting the opposition filed against European  
patent No. 2008946 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** C. Brandt  
**Members:** G. Patton  
V. Bevilacqua

## **Summary of Facts and Submissions**

- I. The appellant (opponent) lodged an appeal against the decision to reject the opposition against the European patent No. 2 008 946, requesting that the decision under appeal be set aside and that the patent be revoked.

Opposition had been filed against the patent as a whole and based on the ground of lack of inventive step pursuant to Article 100(a) EPC.

- II. The patent proprietor (respondent) requested that the appeal be dismissed.

- III. The following documents of the opposition proceedings are relevant for the present decision:

D1: DE 102 16 960 B4;  
D2: EP 1 462 386 A1; and  
D3: WO 2005/082739 A1.

- IV. Both parties requested oral proceedings and the Board provided its preliminary non-binding opinion annexed to the summons for oral proceedings dated 16 November 2016 that the subject-matter of claim 1 could be regarded as involving inventive step so that the appeal would be dismissed.

With letter dated 9 January 2017, the appellant withdrew its request for oral proceedings, which were scheduled for 11 January 2017.

With letters dated 10 January 2017 the respondent requested apportionment of costs pursuant to Article 104(1) EPC.

V. Oral proceedings took place on 11 January 2017 in the absence of both parties pursuant to Article 15(3) RPBA and Rule 115(2) EPC, at the end of which the present decision was announced.

VI. The wording of claim 1 of the patent as granted reads as follows:

"A liquid container (1) comprising:

- a container body (2) of plastic material, with an outlet sleeve (3) having a free end (3a) defining an outlet opening,
- a drainage device (10) of plastic material, having a flange (11),
- electrically conductive means (20) for discharging electrostatic charges from the container (1),

wherein

- said drainage device (10) comprises a tubular member (12) at least partly inserted in said outlet sleeve (3),
- said electrically conductive means (20) comprise a first portion (21) interposed between the tubular member (12) of the drainage device (10) and the outlet sleeve (3) of the container body (2) and a second portion (22), electrically connected to said first portion (21) and positioned between said flange (11) and the free end (3a) of said outlet sleeve (3), said second portion (22) projecting out of said drainage device (10),

characterized in that

said electrically conductive means (20) are made of an electrically conductive plastic material, said first portion (21) comprises a tubular sleeve extending along a lengthwise direction (X-X), and at least partly fitting onto the tubular member (12) of the drainage device (10), said second portion (22) comprises a

flange extending transversely of said lengthwise direction (X-X) and connected to said tubular sleeve (21), said tubular sleeve (21) and said flange (22) connected to said tubular sleeve (21) define an electrically conductive element (20), said electrically conductive element (20) is welded to said tubular member (12) and to said outlet sleeve (3)."

The wording of claim 9 of the patent as granted reads as follows:

"A process for manufacturing a liquid container (1) according to any one of claims 1-8, comprising the steps of:

- a) providing a container body (2) with an outlet sleeve (3) having an end surface (3a) defining an outlet opening, electrically conductive means (20) as defined in claim 1 and a drainage device (10) having a tubular member (12);
  - b) welding the drainage device (10) and the electrically conductive means (20) together;
  - c) welding the electrically conductive means (20) and the outlet sleeve (3) together;
- wherein step c) is carried out after step b) or is carried out prior to step b)."

VII. The appellant argued essentially as follows

*Inventive step*

The subject-matter of claim 1 lacks inventive step starting from D1 in combination with the teaching of D3. The following features of claim 1 are not known from D1:

- the first portion of the electrically conductive means "comprises a tubular sleeve"; and
- the electrically conductive element "is welded" to said tubular member of the drainage device and to said outlet sleeve.

The first distinguishing feature relates to the form of the first portion. Hence, it is not essential to the claimed invention and has no technical effect. Already for this reason it cannot justify inventive step. Should the problem to be solved derived from it be to improve the contact area for discharging electrostatic charges, the claimed solution would be immediately obvious for the skilled person.

The problem associated with the second distinguishing feature could be seen as to provide a reliable and liquid-tight fitting of the draining device onto the container. D3 discloses the claimed solution and its advantages. The skilled person would have no reason not to implement the solution disclosed in D3 to the container of D1, in particular since D3 recommends the implementation to containers being electrically discharging, which is the case of the container of D1.

As a consequence, starting from D1 the skilled person applying the teaching of D3 would arrive at the claimed subject-matter in an obvious manner.

The subject-matter of claim 1 lacks inventive step starting from D2 in combination with the teaching of D3. The following features of claim 1 are not known from D2 (feature V of the impugned decision, point II. 2.1):

said tubular sleeve and said flange define an electrically conductive element (being) welded to said tubular member and to said outlet sleeve.

The problem to be solved derived from the technical effect associated with the distinguishing feature is to increase security against leaks. D3 discloses a welded connection in particular for electrically discharging containers. Since D2 relates to such containers, the skilled person would immediately think of applying the solution of D3 to the container of D2. There is no disclosure in D3 that would dissuade the skilled person from this combination.

As a consequence, starting from D2 the skilled person applying the teaching of D3 would arrive at the claimed subject-matter in an obvious manner.

This objection applies similarly against claim 9.

*Apportionment of costs*

The appellant has not filed any arguments on this issue.

VIII. The respondent argued essentially as follows

*Inventive step*

Claim 1 differs from D1 in that:

- (a) the electrically conductive means are made of electrically conductive plastic material;
- (b) the first portion of the electrically conductive means comprises a tubular sleeve at least partially fitting onto the tubular member of the drainage device;



- (c) the flange (second portion) is connected to the tubular sleeve;
- (d) the tubular sleeve and the flange (second portion) connected to the tubular sleeve define an electrically conductive element; and
- (e) the electrically conductive element is welded to the tubular member of the drainage device and to the outlet sleeve.

The skilled person facing the problem to improve the tightness of the arrangement of D1 while keeping the ability to discharge electrostatic charges, would substitute the drainage device of D1 with that of D3 and weld the latter directly onto the outlet sleeve of the container of D1. Hence, he would remove the conductive element of D1 which has become unnecessary. By doing so, he would not arrive at the claimed subject-matter.

Further, the skilled person would not think of welding the discharge device directly to the outlet opening of the container of D1, i.e. by removing the outlet sleeve, as this would mean going against the teaching of D3. Would he still do it, the resulting container would not comprise the claimed feature of an electrically conductive element welded to the tubular member of the drainage device and to the outlet sleeve.

Hence, the subject-matter of claim 1 involves an inventive step in view of the combination of D1 and D3.

Claim 1 differs from D2 in that:

- iv) the tubular sleeve of the electrically conductive element is at least partly fitting onto the tubular member of the drainage device; and

v) the electrically conductive element is welded to the tubular member and to the outlet sleeve.

The skilled person facing the problem of improving the tightness of the arrangement of D2 while keeping the ability to discharge electrostatic charges would not think of welding as a workable solution. As a matter of fact, by welding he would irreversibly damage the electrically conductive element, i.e. the electrically conductive layer (25), in such a manner that the desired effect of discharging electrostatic charges would no longer be achieved.

Should the skilled person still think of welding, he would not come to the claimed feature of the electrically conductive element being welded to the outlet sleeve.

Hence, the subject-matter of claim 1 involves an inventive step in view of the combination of D2 and D3.

*Apportionment of costs*

The appellant's request for the withdrawal of oral proceedings was filed in short notice. Oral proceedings have been summoned a month before Christmas holidays so that the latter cannot be the reason for the short notice. The appellant even confirmed its attendance at the oral proceedings. This conduct is unfair and has incurred unnecessary costs for the preparation of oral proceedings, including cancellation costs of flights and accommodation for the authorized representative and the accompanying persons.

Costs should then be apportioned pursuant to Article 104(1) EPC.

## **Reasons for the Decision**

### 1. Inventive step

The appellant has contested the inventive step of the subject-matters of claims 1 and 9 starting from D1 and combining with the teaching of D3, or starting from D2 and combining with the teaching of D3.

#### 1.1 Claim 1 - Starting from D1

##### 1.1.1 D1 discloses a liquid container ("Behälteranordnung ... von ... Flüssigkeiten") comprising:

- a container body of plastic material ("Kunststoffbehälter" 1), with an outlet sleeve ("Ablaufstutzen" 15) having a free end defining an outlet opening,
- a drainage device of plastic material ("Kunststoffauslaufventil" 7), having a flange ("Gegenfläche" 18),
- electrically conductive means ("Kontaktfinger" 20; "leitfähige Scheibe" 17; "Spannschelle" 19) for discharging electrostatic charges from the container (1),

wherein

- said drainage device (7) comprises a tubular member at least partly inserted in said outlet sleeve (15),
- said electrically conductive means (17, 19, 20) comprise a first portion ("Kontaktfinger" 20) interposed between the tubular member of the drainage device (7) and the outlet sleeve (15) of the container body (1) and a second portion ("leitfähige Scheibe" 17), electrically connected to said first portion (20) and

positioned between said flange (18) and the free end of said outlet sleeve (15), said second portion (17) projecting out of said drainage device (7) (via its connection with the clamp "Spannschelle" 19, see page 5, left-hand column, first paragraph), said electrically conductive means (17, 19, 20) are made of an electrically conductive material, said first portion (20) being a contact-finger extending along a lengthwise direction (X-X), said second portion (17) comprises a flange extending transversely of a lengthwise direction (X-X) and connected to said contact-finger (20), said contact-finger (20) and said flange (17) connected to said contact-finger (20) define an electrically conductive element, said electrically conductive element is mounted between said tubular member of the drainage device and **to** said outlet sleeve (15) (paragraphs [1], [8]-[9], [25] and [33]; figure 7).

1.1.2 In view of the above, D1 does not disclose the following features of claim 1:

i) the electrically conductive means are made of "electrically conductive plastic material";

ii) the first portion of the electrically conductive means "comprises a tubular sleeve" extending along a lengthwise direction (X-X)", and at least partly fitting onto the tubular member of the drainage device; and

iii) the electrically conductive element "is welded" to said tubular member of the drainage device and to said outlet sleeve.

1.1.3 The following features (c) and (d) mentioned by the respondent (see point VIII above):

(c) the flange (second portion) is connected to the tubular sleeve; and

(d) the tubular sleeve and the flange (second portion) connected to the tubular sleeve define an electrically conductive element

are derivable from the disclosure of D1, paragraph [9] and page 5, left-hand column, lines 3-11. As a matter of fact, the flange (17), the finger-contact (20) as well as the clamp (19) have to be connected together in order to ensure the discharge of the electrostatic charges from the interior to the exterior of the container, by being electrically connected to an earth mass via the cable ("Erdungskabel" 21).

1.1.4 As correctly argued by the respondent, the appellant has only dealt with the last two distinguishing features ii and iii in its statement setting out the grounds of appeal. According to the impugned decision, lines 7-9 of point II.2.2.1, feature i would be obvious in view of the combination of D1 and D3. Hence, there was no absolute requirement for the appellant to further discuss this issue in the statement setting out the grounds.

1.1.5 Technical effects

The technical effect of the electrically conductive plastic material (feature i) used for the electrically conductive means is that the latter is compatible with the elements of the drainage device and outlet sleeve, while obtaining a **tight connection** of the drainage

device onto the outlet sleeve of the container (contested patent, paragraphs [16] and [27]).

The Board shares the respondent's view, taking into consideration the contested patent, paragraphs [2] and [26], that the tubular sleeve (feature ii) has the technical effect of **increasing the contact surface** of the electrically conductive means with the liquid stored in the container. As shown in figure 1 of the contested patent, the space left between the outlet sleeve (3) of the container and the tubular sleeve (21) enables the liquid to come around said tubular sleeve so that more contact surface are created than just with a finger-like part as in D1 (see also appellant's statement of grounds, page 2, last paragraph).

The technical effect of welding (feature iii) is that the mounting of the drainage device onto the container is more reliable and **tighter** (see appellant's grounds of appeal, page 3, second paragraph; respondent's reply, page 3, fifth and seventh paragraphs).

Features i and iii show a synergy in their effects in having a tight fitting of the draining device onto the outer sleeve of the container. There is however no synergy between the technical effects of distinguishing features i and iii (tight connection), on the one hand, and that of distinguishing feature ii (increase of the contact surface), on the other hand.

As a consequence, features i and iii can be dealt with independently from feature ii for the assessment of inventive step of the subject-matter of claim 1.

#### 1.1.6 Problems to be solved

The first partial objective technical problem to be solved by the combination of distinguishing features i and iii can be seen as to modify the liquid container of D1 so as to provide a tighter fitting of the draining device onto the container.

The second partial objective technical problem to be solved by distinguishing feature ii can be seen as to modify the liquid container of D1 so as to increase the discharge of electrostatic charges arising from the friction of the liquid with the container.

#### 1.1.7 Obviousness

##### (a) First partial technical problem

Faced with the above first partial problem, the skilled person will certainly consider D3 which, like D1 and the contested patent, lies in the technical field of liquid container with a drainage device and aims at discharging electrostatic charges (D3, page 1, lines 1-10; page 7, lines 16-21; claims 1 and 10).

D3 teaches for that very purpose the use of an electrically conductive plastic material ("elektrisch leitender Kunststoff") for the whole drainage device ("Entnahmematur" 22) (page 7, lines 16-21). As a result, the skilled person applying this teaching to the liquid container of D1 will also do so for the whole drainage device, i.e. also including the flange (17), the contact-finger (20) and the clamp (19), contrary to the respondent's view.

He will also certainly come up with welding as D3 discloses to weld the drainage device ("Entnahmearmatur" 22) to the outlet sleeve ("rohrförmiger Stutzen" 18) of the container ("Kunststoff-Innenbehälter" 12) (page 6, lines 5-14 in combination with figure 2; claim 1). However the skilled person would not arrive at the claimed solution by applying this teaching to the disclosure of D1 for the following reasons (see respondent's reply, page 4, first three paragraphs).

As pointed out by the respondent, in the liquid container of D1, the flange (17) of the electrically conductive element is interposed between the surface of the flange (18) of the drainage device (7) and the surface of the flange ("Dichtfläche" 16) of the outlet sleeve (15) of the container (1). Therefore, when making the whole drainage device in an electrically conductive plastic material and weld it onto the outlet sleeve, in accordance with the teaching of D3, the skilled person will realise that he no longer needs the electrically conductive element (17, 19, 20) of D1 and remove it. By doing so he will not arrive at the claimed subject-matter.

He will also come up with the removal of the electrically conductive element (17, 19, 20) in order to be able to weld the drainage device (7) to the outlet sleeve (15). In that case, the welding will be performed between the flange (16) of the outlet sleeve (15) and the flange (18) of the drainage device (7), i.e. not to the tubular member of the drainage device as claimed.

Should the skilled person envisage, despite the above, to maintain the electrically conductive element of D1



when welding the drainage device onto the outlet sleeve, as taught in D3, he will come up with welding the clamp (19) of the electrically conductive element exactly as shown in figure 7 of D1: to the outlet sleeve (15) on the one side and to the flange (18) of the drainage device (7) on the other side, i.e. not to the tubular member of the drainage device as claimed.

Even if the skilled person would first think, before applying the teaching of D3, of modifying the teaching of D1 and remove the clamp (19) while maintaining the other parts (17, 20) of the electrically conductive element, the welding will still not be performed onto the tubular member of the drainage device as claimed.

Already for these reasons, inventive step is justified.

(b) Second partial technical problem

The appellant considers that it would be immediately obvious for the skilled person faced with the second partial technical problem to come to the claimed solution of a tubular sleeve, such as by using his common general knowledge. The Board cannot share this view as the skilled person would first think of many other solutions such as to lengthen the contact-finger (20) of D1 or to connect it to another electrically conductive internal part of the container in contact with the liquid stored.

- 1.1.8 As a consequence, the skilled person combining the teachings of D1 and D3 would not arrive at the claimed subject-matter in an obvious manner.

1.2 Claim 1 - Starting from D2

1.2.1 D2 discloses a liquid container ("Transport- und Lagerbehälter für Flüssigkeiten" 1; "Innenbehälter" 2) comprising:

- a container body (2) of plastic material ("Kunststoffbehälter" 2) such as polyethylene ("Polyethylen"), with an outlet sleeve ("Auslaufstutzen" 11) having a free end ("äußeres zylindrisches Ende" 11a; "Stirnfläche" 44) defining an outlet opening,
- a drainage device ("Entnahmemarmatur"; "Klappenhahn" 12) of plastic material, at least for the housing ("Hahngehäuse" 27), having a flange ("Bund" 42),
- electrically conductive means ("Außenschicht" 24; "Innenschicht" 25) for discharging electrostatic charges from the container (2),

wherein

- said drainage device (12) comprises a tubular member ("Einlaufstutzen" 32; with longitudinal grooves "Längsnuten" 48) at least partly inserted in said outlet sleeve (11),
- said electrically conductive means (24, 25) comprises a first portion ("Innenschicht" 25) interposed between the tubular member (32, 48) of the drainage device (12) and the outlet sleeve (11) of the container body (2) and a second portion corresponding to the radial part linking the portions (24) and (25) shown in figure 3, electrically connected to said first portion (25) and positioned between said flange ("Bund" 42) and the free end (11a, 44) of said outlet sleeve (11), said second portion projecting out of said drainage device (12).

In the disclosure of D2, said electrically conductive means (24, 25) forms an homogeneous layer with the outer layer ("Außenschicht" 21) of the container body

("Innenbehälterkörper" 23), said outer layer (21) being made of an electrically conductive plastic material ("elektrisch leitfähigen Außenschicht 21 mit einem Leitrußanteil", column 4, lines 1-2), said first portion (25) comprises a tubular sleeve extending along a lengthwise direction (X-X), said second portion comprises a flange extending transversely of said lengthwise direction (X-X) and connected to said tubular sleeve (25), said tubular sleeve (25) and said flange connected to said tubular sleeve (25) define an electrically conductive element (24, 25), said electrically conductive element (24, 25) is the outer layer of the said outlet sleeve (11) (paragraphs, [1], [10], [12]-[15] and [18]-[21], figures 2-3).

#### 1.2.2 Distinguishing features

Therefore, the Board shares the respondent's view that D2 does not disclose the following features of claim 1:

iv) the tubular sleeve of the electrically conductive element is at least partly fitting onto the tubular member of the drainage device; and

v) the electrically conductive element is welded to the tubular member and to the outlet sleeve.

1.2.3 With respect to feature iv, a contact between the tubular sleeve (25) and the tubular member (32, 48) is not unambiguously disclosed in D2 (paragraph [21]; figure 3). In the schematic figure 3, the layer (25) does not extend till the lowest diameter of the opening of the outlet sleeve (11) of the container. As a consequence, even assuming that said lowest diameter comes in contact with the tubular member, i.e. at least

with the parts free from the longitudinal grooves ("Längsnuten" 48), for the positioning of the drainage device (12) onto the outlet sleeve (11), a contact between the tubular sleeve (25) and the tubular member (32, 48) is not unambiguously and immediately disclosed. Hence, even if the expression "fitting onto" used in claim 1 were to be interpreted as "passend aufgesetzt" (see statement of grounds, paragraph linking pages 3 and 4), this feature is still not derivable from the disclosure of D2. As a result, the tubular sleeve (25) cannot be seen as fitting onto the tubular member (32, 48) in D2.

In fact, what appears to be essential in D2, is that the tubular sleeve (25) comes in contact with the liquid stored, thanks to the longitudinal grooves (48) (see paragraph [21]).

1.2.4 The Board shares the appellant's view that the expression "electrically conductive **element**" does not mandatorily mean that the element is an additional part distinct from the other parts. This, however, does not play a role in view of the following discussion.

1.2.5 Technical effects

The Board considers that there is a synergy between the technical effects of the distinguishing features iv and v in that they provide a **tight** connection between the outlet sleeve of the container and the drainage device, while still keeping the ability to discharge the electrostatic charges (appellant's statement of grounds, paragraph bridging pages 4 and 5; respondent's reply, page 6, lines 1-2).

These effects are also achieved in D2, via the screw connection ("Überwurfmutter" 39) and the sealing ring ("Dichtring" 41) for the tightness of the connection (see paragraph [18]; "...eine flüssigkeits**dichte** Verbindung zwischen dem Klappenhahn 12 und dem Innenbehälter 2...") and via the electrically conductive element (24, 25) for the discharge of electrostatic charges.

#### 1.2.6 Problem to be solved

The problem can hence be seen as to provide the liquid container of D2 with an **alternative** tight connection between the outlet sleeve and the drainage device still enabling to discharge the electrostatic charges.

#### 1.2.7 Obviousness

As already pointed under point 1.1.7 above, the skilled person will certainly consider D3 which, like D2 and the contested patent, lies in the technical field of liquid container with a drainage device and aims at discharging electrostatic charges (D3, page 1, lines 1-10; page 7, lines 16-21; claims 1 and 10).

D3 discloses to weld the drainage device ("Entnahmearmatur" 22) to the outlet sleeve ("Stutzen" 18) of the container (12) (page 2, lines 23-37; page 6, lines 5-20; figure 2).

However, as argued by the respondent, the skilled person would have to completely re-design the liquid container of D2 by, firstly, abandon the screw connection (39) and the sealing ring (41) and, secondly, weld the flange (42) of the drainage device (12) to the outlet sleeve (11) of the container. Should

the skilled person do so, as proposed by the appellant, the electrical contact between the tubular member (25) and the outer layer (24) would no longer hold as a consequence of the damages in the thin layer (24, 25) incurred by welding (see paragraph [13]: 0.1 to 0.5 mm, preferably 0.2 mm). As put forward by the respondent, this would prevent the skilled person from considering welding in D2 as a workable solution.

It is noted that punctual welding would not provide a tight connection so that a complete circumferential welding would be mandatory. This would result in damaging the complete circumference of the electrically conductive element so that its function of discharging the electrostatic charges would no longer be provided.

Further, as also point out in the impugned decision, point II.2.3.4, the skilled person would also possibly consider to remove the layers (24) and (25) of the liquid container of D2 when applying the complete teaching of D3 (the drainage device also conductive). By doing so he would not arrive at the claimed subject-matter.

In any case, as for the combination of D3 with D1 discussed above, by applying the teaching of D3 to the liquid container of D2, with or without the layers (24) and (25), the welding will not be performed to the tubular member (32) of the drainage device (12) as claimed, but rather to the flange (42).

- 1.2.8 As a consequence, the skilled person combining the teachings of D2 and D3 would not arrive at the claimed subject-matter in an obvious manner.

1.3 Claim 9

Since process claim 9 comprises the product of claim 1, the above reasonings and conclusions also apply to claim 9.

1.4 The above reflects the Board's preliminary opinion which was annexed to the summons for oral proceedings and against which none of the parties subsequently filed any additional submissions.

2. Apportionment of costs

2.1 The appellant withdrew its request for oral proceedings per telefax at 17:00 on 9 January 2017, i.e. only two days before the oral proceedings scheduled for 11 January 2017, *de facto* **only one day** in view of the lateness of the filing in the day (17:00).

In reaction, the respondent requested apportionment of costs pursuant to Article 104(1) EPC with two letters dated 10 January 2017, arguing that the appellant's request for the withdrawal of oral proceedings was filed in such a short notice that it resulted in unnecessary costs for the preparation of oral proceedings and for the cancellation of flights and accommodation for the authorized representative and the accompanying persons.

2.2 Article 16 RPBA dealing with costs provides, so far as relevant to the present case:

"(1) Subject to Article 104, paragraph 1, EPC, the Board may on request order a party to pay some or all of another party's costs which shall, without limiting the Board's discretion, include those incurred by any

...

(c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings;...".

2.3 In case T 53/06, not published in OJ EPO, point 4 of the reasons, the deciding Board stated (see also T 2179/09, not published in OJ EPO, point 6 of the reasons):

*"Article 104(1) EPC, referred to in Article 16(1) RPBA, contains the general power of the Opposition division to order, for reasons of equity, a different apportionment of costs from the norm in which each party bears its own costs. It is well-established by case-law that, regardless of which party requested oral proceedings and of whether a communication has been sent or not, every party summoned to oral proceedings has an equitable obligation to inform the board as soon as it knows it will not attend the oral proceedings and that, if a party fails both to respond to a communication and to attend oral proceedings, costs may be awarded against it (see generally "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006, pages 585 to 587)" (now 8th edition 2016, IV.C.6.2.2(a)).*

*"In the present case the appellant requested oral proceedings "in case the board considers not to set the decision aside". As soon as it received the Board's summons to oral proceedings and communication of 26*



*October 2007, the appellant knew not only that oral proceedings would take place but also that the condition it had itself placed on its own request for oral proceedings had been fulfilled, since the communication clearly indicated that the Board's provisional opinion was that the decision under appeal would not be set aside. However, the appellant neither replied to the communication nor indicated at all, let alone as soon as it knew, that it would not attend oral proceedings. Since the respondent had, in the absence of any submissions from the appellant additional to those in the grounds of appeal, nothing to add to its own case in its reply to the grounds of appeal, the oral proceedings proved to be unnecessary."*

*"Accordingly it is clear that, as a result of the appellant's conduct, the oral proceedings were not only unnecessary but also an inefficient use of the time and effort of both the respondent and the Board. In those circumstances, an apportionment of costs in favour of the respondent is appropriate under Article 16(1)(c) RPBA. Since it is also clear that the appellant could have made its position known well in advance of the date appointed for the oral proceedings, and thereby not only spared the respondent and the Board unnecessary work but also allowed the date for the oral proceedings to be used for another pending appeal, such an apportionment of costs is also appropriate under Article 16(1)(e) RPBA."*

- 2.4 The present Board can only fully concur with this reasoning in T 53/06 which is similarly applicable to the present case.

As a matter of fact, in the present case the appellant subsidiarily requested oral proceedings and knew with

the Board's provisional opinion provided in the annex to the summons for oral proceedings of 16 November 2016 that they would take place and that the appeal would be dismissed taking into account the arguments submitted by the parties so far. The appellant has not filed any additional arguments subsequently and even confirmed its attendance to the oral proceedings with letter dated 9 December 2016, requesting simultaneous translation. It was therefore clear that oral proceedings had to be held and that the respondent, the Board and the interpreters needed to invest preparation time.

In this respect, the Board cannot follow the appellant's arguments that in the absence of the deciding persons due to Christmas holidays oral proceedings could not be withdrawn at an earlier point in time. Indeed, the appointed date for the oral proceedings was clearly stated in the summons and the appellant had sufficient time at its disposal before said Christmas holidays to work on the case and anticipate any plausible and foreseeable absence of the deciding persons. The respondent, which invested unnecessary time for the preparation, cannot be penalized for the appellant's conduct.

- 2.5 The Board cannot consider that the appellant's request for withdrawal of oral proceedings two days before the oral proceedings (*de facto* one day, see point 2.1 above) was notified "in good time" in accordance with the following stated in T 556/96, not published in EPO OJ, (see catchword and point 5 of the reasons):

*"1. The equitable obligation of a party summoned to oral proceedings to inform the EPO that it will not attend (T 930/92) implies that the party reaches a*

decision and notifies it **in good time**, i.e. sufficiently in advance of the date of the oral proceedings to allow the Board to reconsider the need for oral proceedings, if necessary after having contacted the other parties summoned, and to give notice to them that the oral proceedings have been cancelled as a consequence.

2. Where a party informs the EPO and/or the other parties of its intention not to attend the oral proceedings **so late** that cancellation of the oral proceedings is no longer a feasible option, then, for the purposes of apportionment of costs, the party responsible is **to be treated as if it had been absent without prior notice.**" (emphasis added by the Board).

The present Board concurs with this reasoning in T 556/96 and, hence, the appellant's request has to be treated as having been received so late that the respondent had already to be fully prepared, taking further into account the necessary travelling time during the day before the oral proceedings.

Accordingly, as a result of the appellant's conduct, the preparation for oral proceedings were not only unnecessary but also an inefficient use of the time and effort of the respondent, the Board and also the interpreters. In those circumstances, an apportionment of costs in favour of the respondent is appropriate under Article 16(1)(c) RPBA.

2.6 The Board points out, however, that for the oral proceedings only the presence of an authorized representative is necessary. The attendance or not of an accompanying person has no bearing on the conduct of the oral proceedings and is a matter of a deliberate

choice from a party for which the other party need not be involved. To charge the appellant also with costs incurred by the accompanying person would contravene the principle of equity (Article 104(1) EPC, Article 16(1) RPBA).

Therefore, the cancellation costs of flights and accommodation for the accompanying person is to be borne by the respondent itself.

- 2.7 The Board notes with respect to the present decision on apportionment of costs that, although the appellant was not present at the oral proceedings, the principle of the right to be heard pursuant to Article 113(1) EPC is observed since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity (see the explanatory note to Article 15(3) RPBA cited in T 1704/06, not published in OJ EPO, see also the Case Law of the Boards of Appeal, 8<sup>th</sup> edition 2016, III.B.2.7.3).

## Order

### For these reasons it is decided that:

1. The appeal is dismissed
2. The appellant shall bear the following costs incurred by the respondent for the preparation of the oral proceedings:
  - cancellation costs of the flights and accommodation for the authorized representative only; and
  - twelve hours preparation time for the authorized representative.

The Registrar:

The Chairman:



G. Nachtigall

C. Brandt

Decision electronically authenticated