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**Datasheet for the decision  
of 17 January 2020**

**Case Number:** T 0702/15 - 3.3.10

**Application Number:** 04817445.2

**Publication Number:** 1725628

**IPC:** C09K5/04, C10M171/00

**Language of the proceedings:** EN

**Title of invention:**

FLUORINATED ALKENE REFRIGERANT COMPOSITIONS

**Patent Proprietor:**

Honeywell International Inc.

**Opponents:**

ARKEMA France

Mexichem Amanco Holding S.A. de C.V.

Bayerische Motoren Werke Aktiengesellschaft

Daikin Industries, Ltd.

ASAHI GLASS COMPANY, LTD.

ACEA European Automobile Manufacturers Association

**Headword:**

**Relevant legal provisions:**

EPC Art. 104(1), 112(1), 76, 18(1)

EPC R. 100(1), 36

**Keyword:**

Apportionment of costs - (no)

**Decisions cited:**

T 2165/08, T 0211/15

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 0702/15 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 17 January 2020**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 15 January 2015  
revoking European patent No. 1725628 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** P. Gryczka  
**Members:** R. Pérez Carlón  
F. Blumer

### **Summary of Facts and Submissions**

- I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division to revoke European patent No. 1 725 628.
- II. With a letter dated 21 December 2018, prior to the oral proceedings scheduled for 10 January 2019, the sole appellant withdrew its appeal.
- III. Respondent 1 (opponent 1) requested with a letter dated 3 January 2019 that costs be awarded against the appellant. It argued that its behaviour constituted an abuse of proceedings for two reasons.

Firstly, withdrawing the appeal at such a short notice before the oral proceedings had obliged the respondent to waste considerable time on preparation work which turned out to be unnecessary.

Secondly, the patent in suit had considerable economic value and was the parent application of four divisional applications, directed to similar subject-matter. The appellant withdrew its approval of the text of those already granted; two of them were still in examination proceedings. By withdrawing its appeal, the appellant was preventing any decision on that subject-matter.

The appellant used the same strategy with a second family of 22 patent applications directed to similar subject-matter.

- IV. Respondent 1 did not request oral proceedings on the issue of costs.

## **Reasons for the Decision**

1. The appeal is admissible.
2. As the appellant in the present appeal proceedings has withdrawn its appeal, the sole issue remaining is the request of respondent 1 that all the costs incurred during these appeal proceedings be awarded against the appellant.
3. Costs (Article 104(1) EPC)
  - 3.1 Under Article 104(1) EPC, each party in opposition proceedings bears the costs it has incurred, unless the opposition division, for reasons of equity, orders a different apportionment of costs. This principle applies equally to opposition-appeal proceedings in view of Article 111(1) EPC in conjunction with Rule 100(1) EPC (see T 2165/08 of 6 March 2013, Reasons 45).
  - 3.2 Respondent 1 requested that the board award all of its costs against the appellant for the following reasons.
    - 3.2.1 By withdrawing its appeal at a late stage, the appellant had obliged respondent 1 to perform a considerable amount of unnecessary preparatory work.

However, according to case law (Case Law of the Boards of Appeal of the EPO, 9th edition 2019, III.R.2.4), an appellant is entitled to withdraw its appeal at any time. In view of the principle of free party disposition, this right may not be restricted. As a rule, the benefits that respondents derive from the withdrawal of the appeal offset the costs they have incurred.

3.2.2 Respondent 1 also argued that the patent in suit had considerable economic value and was the parent application of four divisional applications directed to similar subject-matter. The appellant had also withdrawn its approval of the text of those two divisional applications already granted; the remaining two were still in examination proceedings. According to respondent 1, it was clear from the appellant's passivity with regard to these appeal proceedings that it had never intended to defend its case. It had not filed any response to the issues raised in the responses to the statement of grounds of appeal. It did not reply to the communication of the board in preparation for oral proceedings. It had also not requested interpretation. The withdrawal formed part of the patent proprietor's strategy of trying to avoid any substantive decision on the claimed subject-matter. A similar strategy had been used in the family of divisional applications arising from the European patent which resulted in appeal T 211/15. Intentionally prolonging legal uncertainty about the claimed invention should not be allowed.

However, respondent 1 is relying only on assertions about what the strategy of the appellant might have been. The present appeal is based on the decision of the opposition division that the patent in suit contained added subject-matter. The board had informed the parties in a communication annexed to the summons to oral proceedings that it intended to examine the issues of the admissibility of requests, added subject-matter and Rule 80 EPC, and to remit the case to the opposition division if any request before it did not show any of those deficiencies. The withdrawal of the appeal did not prevent the board from taking a decision on the patentability of the claimed subject-matter,

since it was not minded to examine all of the issues raised in the opposition proceedings.

- 3.2.3 Lastly, respondent 1 objects to the fact that the EPO could grant patents based on divisional applications which related to subject-matter granted and then subsequently abandoned.

Article 76(1) and Rule 36 EPC stipulate the conditions under which a divisional application can be filed. The board fails to see any basis in the EPC for a different treatment of a divisional application if a patent arising from an earlier application is no longer defended by its proprietor.

In addition, the powers of a technical board of appeal are limited to examining the case before it. The EPC does not allow a technical board to instruct an examining division dealing with a case which is not the one under appeal. Under Article 18(1) EPC, only the examining division is responsible for the examination of the case before it.

Furthermore, the board fails to see any connection between the examination of divisional applications and the present request regarding a different apportionment of costs.

- 3.3 The board thus sees no reason to order a different apportionment of costs for the present proceedings.



## Order

### For these reasons it is decided that:

The request of respondent 1 for a different apportionment of costs is refused.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated