

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 9 January 2023**

Case Number: T 0040/17 - 3.3.04

Application Number: 10734842.7

Publication Number: 2453902

IPC: A61K31/702, A23L1/29,
A61P37/04, A61P31/00,
A61P37/08, A61P17/00,
A61P11/06, A61K39/39

Language of the proceedings: EN

Title of invention:

Mixture of non-digestible oligosaccharides for stimulating the
immune system

Patent Proprietor:

N.V. Nutricia

Opponents:

Société des Produits Nestlé S.A.
Abbott Laboratories
FrieslandCampina Nederland B.V.

Headword:

Non-digestible oligosaccharides/NUTRICIA

Relevant legal provisions:

EPC Art. 104(1)

RPBA 2020 Art. 16(1)

Keyword:

Apportionment of costs - abuse of procedure

Decisions cited:

T 0490/05, T 1663/13

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0040/17 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 9 January 2023

Appellant: N.V. Nutricia
(Patent Proprietor) Eerste Stationsstraat 186
2712 HM Zoetermeer (NL)

Representative: Nederlandsch Octrooibureau
P.O. Box 29720
2502 LS The Hague (NL)

Respondent I: Société des Produits Nestlé S.A.
(Opponent 1) Avenue Nestlé 55
1800 Vevey (CH)

Representative: Plougmann Vingtoft a/s
Strandvejen 70
2900 Hellerup (DK)

Respondent II: Abbott Laboratories
(Opponent 2) 100 Abbott Park Rd.
Abbott Park, IL 60064-6004 (US)

Representative: Boulton Wade Tennant LLP
Salisbury Square House
8 Salisbury Square
London EC4Y 8AP (GB)

Respondent III: FrieslandCampina Nederland B.V.
(Opponent 3) Stationsplein 4
3818 LE Amersfoort (NL)

Representative: FrieslandCampina IP Department
Bronland 20
6708 WH Wageningen (NL)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 October 2016
revoking European patent No. 2453902 pursuant to
Article 101(3)(b) EPC**

Composition of the Board:

Chairwoman M. Pregetter
Members: S. Albrecht
 P. de Heij

Summary of Facts and Submissions

- I. The patent proprietor (appellant) appealed the decision of the opposition division to revoke European patent No. EP 2 453 902.
- II. All of the opponents (respondents) replied to the statement of grounds of appeal.
- III. The parties were summoned to oral proceedings scheduled to take place on 12 May 2020, which were subsequently rescheduled to 23 February 2021.
- IV. In its communication dated 13 January 2021, the board announced it intended to hold the oral proceedings scheduled for 23 February 2021 by videoconference, and gave the parties the opportunity to object to this intention. The appellant objected. The board then cancelled the oral proceedings and shortly afterwards issued a summons for 15 February 2022.
- V. With a letter dated 14 February 2022, the appellant withdrew its appeal.
- VI. With a letter dated 15 February 2022, respondent III (opponent 3), referred to in the following as "the respondent", requested that the appellant be ordered to pay the respondent's costs of preparation for the oral proceedings pursuant to Article 104 EPC and Article 16(1) (b), 16(1) (c) and 16(1) (e) RPBA 2020, as the appellant's conduct had constituted an abuse of procedure.

VII. With a letter dated 22 April 2022, the appellant requested that an apportionment of costs not be awarded.

Reasons for the Decision

1. Since the appeal was withdrawn by the sole appellant, this decision only concerns the requested apportionment of costs.
2. In response to the respondent's request, the appellant referred to decision T 490/05. This decision held that the appellant always has the right to withdraw its appeal and that this right cannot be restricted by the threat of an apportionment of costs on the grounds that oral proceedings have been scheduled and the opposing party cannot be informed of the withdrawal in time.
3. The board agrees with this decision in as much that the withdrawal of the appeal by the appellant as such cannot constitute a reason for a different apportionment of costs in accordance with Article 104(1) EPC and Article 16(1) RPBA 2020, if only because the withdrawal is not the cause of the costs incurred by the respondent. After all, the respondent would have incurred those costs even if the appeal had not been withdrawn. However, the present request for apportionment of costs concerns, as the board understands, not so much the withdrawal itself, but the timing of the withdrawal and the assumed motives for doing so, which would constitute an abuse of procedure.
4. In this context the respondent advanced the following allegations.

The appellant had deliberately delayed the proceedings with the sole purpose of prolonging the potential lifespan of the patent. This could be inferred from the fact that in 2021 the appellant had objected to oral proceedings in the form of a videoconference, after which the oral proceedings were postponed by a year. The appellant could have been expected at that time to have reviewed the case in depth and to have drawn its conclusions on whether or not to withdraw its appeal. The withdrawal shortly before the oral proceedings confirmed the appellant's true intentions.

The appellant had intentionally withdrawn the appeal at a very late stage to ensure that the respondent would incur the costs of preparation for the oral proceedings.

The appeal was withdrawn to avoid a negative decision by the board that could have affected related patent applications.

5. These allegations are not convincing.

It cannot be inferred simply from the fact that the appellant did not agree to oral proceedings by means of a videoconference that the appellant intended to unnecessarily prolong the appeal proceedings. On the contrary, it must be assumed that the reason for the appellant's preference for in-person oral proceedings was that such oral proceedings would provide a better opportunity to present its arguments and to convince the board of their veracity in what is, in the appellant's point of view, a complicated case (see its letter dated 28 January 2021).

Furthermore, the point in time at which a party should be able to decide conclusively on whether or not to withdraw the appeal depends on many factors. A party can be expected to take reasonable care to avoid unnecessary preparation time and costs for the opposing party as part of its considerations. However, this care is rather limited and need not be the first concern of a party or its representative. Only in marked cases can equity warrant a party being ordered to pay costs on the part of the opposing party. The fact that the appeal was withdrawn shortly before the date of the oral proceedings is an insufficient reason for coming to such decision (in the same vein as T 1663/13, Reasons 4.1.1). In the absence of additional circumstances, it cannot be concluded that a party has neglected the level of care towards the opposing party that can be reasonably expected of it.

The assumed intention of the appellant to cause unnecessary costs is a mere allegation. It cannot justify the requested apportionment of costs.

Finally, the assumed intention of preventing a possible unfavourable decision by the board by withdrawing the appeal by no means constitutes a reason for the requested apportionment of costs either, again if only because this motive is not the cause of the costs incurred by the respondent.

Order

For these reasons it is decided that:

The request for apportionment of costs is refused.

The Registrar:

The Chairwoman:



I. Aperribay

M. Pregetter

Decision electronically authenticated