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**Datasheet for the decision
of 25.01.2022**

Case Number: T 1955/18 - 3.3.10

Application Number: 10718018.4

Publication Number: 2427527

IPC: C09K5/04

Language of the proceedings: EN

Title of invention:

HEAT TRANSFER COMPOSITIONS AND METHODS

Patent Proprietor:

Honeywell International Inc.

Opponents:

ARKEMA FRANCE
Daikin Industries, Ltd.

Headword:

HEAT TRANSFER COMPOSITIONS AND METHODS/Honeywell

Relevant legal provisions:

EPC Art. 123(2)
EPC R. 139

Keyword:

Amendments - correction of errors (no) - allowable (no)

Decisions cited:

G 0011/91

Catchword:



Beschwerdekammern
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Chambres de recours

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Case Number: T 1955/18 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 25.01.2022

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
29 May 2018 concerning maintenance of the
European Patent No. 2427527 in amended form.

Composition of the Board:

Chairman P. Gryczka
Members: J.-C. Schmid
E. Mille

Summary of Facts and Submissions

I. The appellant (opponent 1) lodged an appeal against the interlocutory decision of the Opposition Division which found that the European patent No. 2 427 527 amended according to the second auxiliary request filed during oral proceedings on 12 April 2018 met the requirements of the EPC. Claim 1 of that request read as follows:

"1. A heat transfer composition comprising: (a) from about 10 to about 35% by weight of HFC-32; (b) from about 10% to about 35% by weight of HFC-125; (c) from about 20% to about 50% by weight of a combination of HFO-1234ze and HFO-1234yf; and (d) from about 15% to about 35% by weight of HFC-134a, with the weight percent being based on the total of the components (a)-(d) in the composition."

II. Notice of opposition had been filed by the appellant and the party as of right (opponent 3) requesting revocation of the patent-in-suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), insufficiency disclosure of the invention (Article 100(b) EPC) and extension of the subject-matter of the patent-in-suit beyond the content of the application as filed (Article 100(c) EPC).

III. The Opposition Division held that the amendments made to the then pending second auxiliary request fulfilled the requirements of Articles 123(2) EPC. It also held that the invention was sufficiently disclosed, that the subject-matter of the claims was novel and involved an inventive step.

- IV. *Inter alia*, the appellant objected again in appeal that claim 1 of the request maintained by the opposition division did not meet the requirement of Article 123(2) EPC. According to the appellant there was no support in the application as filed for defining the percentage by weight of components (a) to (d) present in the claimed composition on the basis of the total of components (a)-(d) in the composition.
- V. The respondent argued that the contested amendment was the result of the correction of an obvious error and that, in any event, the subject matter of claim 1 of the main request, which corresponds to the request maintained by the opposition division, was based on the penultimate paragraph of page 3 of the application as filed.
- VI. The party as of right (opponent 3) made no submission in these appeal proceedings.
- VII. During the oral proceedings before the Board on 25 January 2022, the respondent defended the maintenance of the patent in suit on the basis of the main request and the first to twelfth auxiliary requests, all requests filed with the letter of 12 February 2019
- Claims 1 of the first to eighth and eleventh auxiliary requests are identical to claim 1 of the main request.
- Claims 1 of the ninth, tenth and twelfth auxiliary requests differ from claim 1 of the main request in that the weight ratio of HFC-32:HFC-125 is from about 0.9:1.2 to about 1.2:0.9.
- VIII. The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be dismissed, that is, the patent be maintained on the basis of claims 1 to 7 filed with the letter of 12 February 2019, or, subsidiarily, that the patent be maintained on the basis of one of the first to twelfth auxiliary requests filed with the letter dated 12 February 2019.

- IX. The appellant (opponent) requested that the appeal be dismissed.
- X. At the end of the oral proceedings, the Board announced its decision

Reasons for the Decision

Main request

Amendments (Rule 139 EPC and Article 123(2) EPC)

- 1. Claim 1 of the main request differs from the claim 1 of the application as filed *inter alia* in that the basis for defining the percentage by weight of components (a) to (d) present in the claimed composition has been modified from "based on the total of components (a)-(c) in the composition" to "based on the total of components (a)-(d) in the composition."
- 2. The respondent submitted that said amendment was merely a correction of an obvious error allowable under Rule 139 EPC.
 - 2.1 In order for a correction under Rule 139 EPC, second sentence, to be allowable it must be established

(a) that an error is in fact present in the document filed with the EPO, and

(b) that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

With respect to the above requirement (a), the patent application must contain such an obvious error that a skilled person is in no doubt that this information is not correct and - considered objectively - cannot be meant to read as such. If, on the other hand, it is doubtful whether any information at all is incorrect, then a correction is ruled out. The same applies if incorrect information only becomes apparent in the light of the proposed correction (see G 11/91, OJ EPO 1993, 125, point 5 of the reasons).

2.2 Claim 1 of the application as filed is directed to a composition comprising components (a), (b), (c) and (d). The weight ratios of the compounds (a) to (d) of the composition are defined relative the total amounts of the components (a) to (c) present in the claimed composition. The compositions referred to in originally filed claims 7 and 9 are defined in the same way.

Taking the total amount of the compounds (a) to (c) as the basis for defining the weight ratios of compounds (a) to (d) in the claimed composition makes technical sense. It gives instructions on how the claimed composition may be prepared, for example by first preparing or taking a tertiary composition having the required ratio and then diluting the tertiary composition with 15-35% by weight of component (d) to obtain a composition conforming to the invention.

Therefore, no obvious error can be detected from the reading of the original claims.

- 2.3 According to the respondent, there is a discrepancy between the claims and the description as filed, since examples 2 to 6 do not fall within the scope of the claims as drafted. It is therefore clear to the skilled person that the wording of the claims contains an error.

The claims shall define the matter for which protection is sought and be supported by the description (Article 84 EPC). However, it is not a requirement that the scope of the claims encompass all embodiments described in the description. Therefore, the fact that most of the compositions exemplified in the application as filed are not covered by the claims does not necessarily imply an error in the drafting of the claims. Moreover, the wording of the claims is clear, so that it is not even necessary to look to the description to interpret the claims.

- 2.4 It follows that claim 1 of the application as filed cannot be corrected under Rule 139 EPC, since the skilled reader would not detect an obvious error in the claim.

Article 123(2) EPC

3. Since the amendment to claim 1 cannot be considered as the correction of an obvious error it must be examined whether the amendment fulfills the requirements of Article 123 (2) EPC. In order to determine whether or not an amendment adds subject-matter extending beyond the content of the application as filed it has to be examined whether technical information has been

introduced which a skilled person would not have directly and unambiguously derived from the application as filed.

- 3.1 According to the respondent, claim 1 of the main request is based on the penultimate paragraph of page 3 of the application as filed, which discloses compositions comprising: (a) from about 10% to about 35% by weight of HFC-32; (b) from about 10% to about 35% by weight of HFC-125; (c) from about 20% to about 50% by weight of HFO-1234ze, HFO-1234yf and combinations of these; (d) from about 15% to about 35% by weight of HFC-134a; and optionally (e) up to about 10% by weight of CF₃I and up to about 5% by weight of HFCO-1233ze, with the weight percent being based on the total of the components (a)-(e) in the composition.

The respondent argues that component (e) is optional. When component (e) is absent, the compositions comprise components (a) to (d), with the weight percent being based on the total of the components (a) to (d). Therefore, when the optional compound (e) is absent the penultimate paragraph on page 3 of the application as filed provides a direct and unambiguous disclosure of the subject matter of claim 1 of the main request.

- 3.2 The compositions of claim 1 of the main request are defined as comprising component (a), (b) (c) and (d) and, due to this open definition, may comprise further components, including component (e) defined in the penultimate paragraph on page 3 of the application as filed in any amount. Therefore, by not taking in claim 1 the optional feature that the composition comprises (e) up to about 10% by weight of CF₃I and up to about 5% by weight of HFCO-1233ze, the requirement for an upper limit for components (e) when present in the

composition has been removed, with the consequence that the compositions of claim 1 of the main request may comprise more than 10% by weight of CF₃I and/or more than 5% by weight of HFCO-1233ze. This contradicts the teaching of the application as filed on page 3.

Consequently, the penultimate paragraph on page 3 of the application as filed does not provide an adequate support for the subject-matter of claim 1 of the main request.

3.3 According to the respondent, the penultimate paragraph on page 3 of the application as filed defines two distinct alternatives, the first alternative being that where the optional component (e) is absent. Since the composition is also defined by the term "comprising" in this first alternative, it can comprise component (e), also in higher proportions than in the second alternative where (e) is limited up to about 10% by weight of CF₃I and up to about 5% by weight of HFCO-1233ze. The first alternative therefore clearly supports claim 1 of the main request.

3.4 However, the skilled person reading the penultimate paragraph on page 3 of the application as filed would immediately and unambiguously recognize that when CF₃I and/or HFCO-1233ze (component (e)) are present in the composition, their amount is limited up to about 10% by weight for CF₃I and up to about 5% by weight for HFCO-1233ze, with the weight percent being based on the total of the components (a)-(e) in the composition. The removal of these limitations in claim 1 of the main request provides the skilled person with technical information that is not disclosed in the application as filed.

- 3.5 Furthermore, the proportions of components (a) to (d) present in the composition are different depending on whether the basis is to be taken from the total contents of components (a) to (d) or components (a) to (e).

The penultimate paragraph on page 3 of the application as filed requires that the weight ratio of components (a) to (d) in the composition be based on the total amount of components (a)-(e), and thus does not provide support for the basis to be based on the total amount of components (a)-(d), as required by claim 1 of the main request.

4. In view of the above, the Board therefore arrives at the conclusion that claim 1 of the main request contains subject-matter extending beyond the content of the application as filed, with the consequence that the requirement of Article 123(2) EPC are not fulfilled.

First to twelfth auxiliary requests

5. Claim 1 of each of these requests contains the modification of the basis for defining the percentage by weight of components (a) to (d) present in the claimed composition from "based on the total of components (a)-(c) in the composition" or "based on the total of components (a)-(e) in the composition" to "based on the total of components (a)-(d) in the composition". It was not contested that if the amendment of claim 1 of the main request is not allowable, the same applies to claim 1 of the auxiliary requests.

Accordingly, these auxiliary requests should be rejected for the same reason as for the main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated