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**Datasheet for the decision  
of 4 July 2023**

**Case Number:** T 1484/19 - 3.3.08

**Application Number:** 07761581.3

**Publication Number:** 2013628

**IPC:** G01N33/68

**Language of the proceedings:** EN

**Title of invention:**

METHODS OF EVALUATING PEPTIDE MIXTURES

**Patent Proprietor:**

Momenta Pharmaceuticals, Inc.

**Opponents:**

Generics (U.K.) Limited (trading as Mylan)  
Synthon B.V.

**Headword:**

Request on costs after termination of appeal

**Relevant legal provisions:**

EPC Art. 104, 113(2)  
EPC R. 88, 103(3) (a), 103(4) (c), 103(6)  
RPBA 2020 Art. 16(1)

**Keyword:**

**Decisions cited:**

G 0012/91, J 0012/86, T 0041/82, T 0117/86, T 0323/89,  
T 0614/89, T 0765/89, T 0773/91, T 0490/05, T 1663/13,  
T 1556/14, T 0488/18

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1484/19 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 4 July 2023**

**Appellant:** Generics (U.K.) Limited (trading as Mylan)  
(Opponent 1) Albany Gate  
Darkes Lane  
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Hertfordshire EN6 1AG (GB)

**Representative:** Gill Jennings & Every LLP  
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**Appellant:** Synthon B.V.  
(Opponent 2) Microweg 22  
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**Representative:** van de Kamp, Dominique Anne Marit  
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**Respondent:** Momenta Pharmaceuticals, Inc.  
(Patent Proprietor) 301 Binney Street  
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**Representative:** Potter Clarkson  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 18 March 2019  
rejecting the opposition filed against European  
patent No. 2013628 pursuant to Article 101(2)  
EPC**

**Composition of the Board:**

**Chairwoman**            T. Sommerfeld  
**Members:**            D. Pilat  
                             L. Bühler

## **Summary of Facts and Submissions**

- I. Appeals were filed by opponents 1 and 2 (appellants 1 and 2) against the decision of the opposition division rejecting their oppositions.
- II. The appellants requested that the decision under appeal be set aside and that the patent be revoked in its entirety.
- III. With its letter dated 24 November 2022, the patent proprietor (respondent) stated that it no longer approved the text in which the patent had been granted and would not submit an amended text. It also withdrew all auxiliary requests filed during appeal proceedings.
- IV. In the morning of 29 November 2022, the board issued its decision revoking the patent in the absence of a text agreed by the respondent (Article 113(2) EPC). The decision was authenticated at 09.20 hrs CET by the Chairwoman and at 09.57 hrs by the Registrar and sent to the postal service for dispatch at 10.01 hrs.
- V. By letter dated 29 November 2022, filed electronically and received at the EPO at 14.55 hrs CET, appellant 2 requested a partial reimbursement of the appeal fee under Rule 103(3) (a) EPC and apportionment of costs.
- VI. By communication dated 8 December 2022, the board noted that the request for apportionment of costs had been received on the same day the decision on the case had been sent to the postal services. The board questioned whether it had the power to decide on this request since it was received on the day of completion of the internal decision-making process for the decision to

revoke the patent in the absence of an agreed text by the respondent. The board furthermore opined that no special circumstances existed that would make it equitable to depart from the general principle set out in Article 104(1) EPC that each party to opposition proceedings must bear its own costs. The board invited the parties to comment on the board's preliminary view within a time limit of two months from notification of the board's communication.

VII. By letter dated 19 December 2022, the respondent provided arguments.

VIII. No comments were submitted by the appellants.

IX. No request for oral proceedings was received.

## **Reasons for the Decision**

### *1. Request for apportionment of costs*

1.1 Article 104(1), Rule 88 EPC and, in the current case, Article 16 RPBA, which govern requests for apportionment of costs, imply that such requests be submitted before the final decision is taken. In its communication dated 8 December 2022, the board therefore considered the issue of whether, in light of decision G 12/91 (OJ EPO 1994, 285), appellant 2's request for apportionment of costs, which was filed on the day of completion of the internal decision-making process for the decision of 29 November 2022, was submitted in time for it to be considered by the board. The board concluded that the completion of the decision-making process within the meaning of decision

G 12/91 had to be determined with reference to a date and not an hour or an exact time on a date. Consequently, appellant 2's request was filed after the decision-making process had been completed.

1.2 However, the board also questioned whether decision G 12/91 was concerned with a decision as to substance but not with a situation as in the current case in which appeal proceedings are terminated without a decision. Indeed, under the established case law, a withdrawal of appeal terminates the proceedings on the merits at once (without decision as to substance), but the board still has the power to decide on ancillary questions such as the reimbursement of the appeal fee (J 12/86, T 41/82 and T 773/91) and the apportionment of costs (T 117/86, T 323/89, T 614/89 and T 765/89). By analogy to the withdrawal of an appeal, it could be argued that the decision of 29 November 2022 brought the appeal proceedings to a close for the substantive merits of the appeals (which were no longer open for consideration in view of the respondent's withdrawal of its approval of any text for maintenance of the patent) while leaving ancillary questions like costs open to a decision. Consequently, the board would have the power to decide on the request for reimbursement of the appeal fee and for apportionment of costs filed after the completion of the internal decision-making process.

1.3 A different approach was taken in decision T 1556/14. The board held that a request for apportionment of costs could be admissible despite being filed after termination of the appeal proceedings if, in the case at hand, the request could not be submitted earlier (see T 1556/14 of 15 October 2020, points 3 and 4 of the Reasons).

- 1.4 It can be left open whether and, if so, to what extent legal certainty imposes limitations as to the admissibility of a request for apportionment of costs filed after termination of the appeal proceedings (in line with the approach taken in T 1556/14 of 15 October 2020) as the current request is not allowable for the following reasons.
- 1.5 Article 104(1) EPC requires that, as a rule, each party to the opposition proceedings bear its own costs. Departing from this principle requires special circumstances which make it equitable to award costs against one of the parties. This provision applies equally to opposition appeal proceedings by virtue of Article 111(1) EPC. Article 16(1) RPBA provides that, subject to Article 104(1) EPC, the board may on request order a party to pay some or all of another party's costs which - without limiting the board's discretion - include those incurred by any of the following:
- (a) amendment to a party's appeal case pursuant to Article 13
  - (b) extension of a period
  - (c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings
  - (d) failure to comply with a direction of the board
  - (e) abuse of procedure
- 1.6 The current circumstances do not correspond to any of the above-mentioned situations justifying a different apportionment of costs. The board does not see anything in the timing of the respondent's letter which amounts to improper conduct of the proceedings or even to an abuse of proceedings justifying a different apportionment of costs.



1.7 The communication issued by the board in preparation for the oral proceedings was deemed notified to the parties on 21 November 2022 (Rule 126(2) EPC). The respondent's letter was thus sent three days after the deemed notification. Even if the respondent had received the board's communication posted on 9 November 2022 on the same day, the respondent had only 15 working days before the oral proceedings to consider the preliminary opinion and to decide on its further actions after consultation with its representative. The respondent's letter withdrawing consent to the text of the patent and requesting its revocation was submitted within 11 working days. Therefore, the respondent cannot be reproached for not having acted diligently and in good faith. Even less so can the respondent's conduct be regarded as an abuse of proceedings.

1.8 Under the principle of party disposition expressed in Article 113(2) EPC, it is in the hands of a party to determine the subject-matter on which the EPO should decide. Based on this principle, an appellant is entitled to withdraw its appeal and an applicant or patent proprietor is entitled to withdraw its approval of the text of a patent at any time during pending appeal proceedings. Except for where the exercise of the rights conferred by this principle contravene a party's obligation to act in good faith (as exemplified in Article 16(1) RPBA), this principle may not be restricted by the threat of an apportionment of costs. For the withdrawal of an appeal, this has been confirmed in the case law (see T 490/05, point 3.3 of the Reasons; T 1663/13, point 4.1.1 of the Reasons) and recently acknowledged by the legislators in amended Rule 103(4)(a) EPC. Indeed, reimbursement of 25% of the appeal fee is provided for even for the withdrawal of an appeal during oral proceedings before the decision

is announced. Rule 103(4) (a) EPC would be inoperable in *inter partes* proceedings if a withdrawal of the appeal at the end of oral proceedings gave rise to an apportionment of costs under Article 104 EPC and Article 16 RPBA. Thus, the legislators considered that the benefits the board and respondents to the appeal derive from the withdrawal of an appeal offset the costs that they incur, even if they are avoidable.

1.9 In the board's opinion, the same holds true for a patent proprietor's withdrawal of its approval pursuant to Article 113(2) EPC, even more so if the parties are informed of it before the oral proceedings. Indeed, in view of the respondent's letter of 24 November 2022, it is no longer necessary to consider the appellants' appeals by which they request revocation of the patent. Oral proceedings - which were also requested on an auxiliary basis by the appellants - could therefore be cancelled.

1.10 The board understands that appellant 2 could have avoided costs had it known earlier that the respondent no longer wanted to pursue its requests for the rejection of the oppositions and, in the alternative, for the maintenance of the patent in amended form. However, even in light of the board's preliminary opinion dated 9 November 2022, appellant 2 had no legitimate expectation that the respondent would surrender its patent. Indeed, appellant 2 appears to have still considered its attendance at the oral proceedings to be necessary to defend its case. Otherwise, it could have relied on its written case and announced that it did not intend to attend oral proceedings.

- 1.11 For the above reasons, appellant 2's request for apportionment of costs is refused.
2. *Request for reimbursement of the appeal fee*
- 2.1 As regards the reimbursement of the appeal fee, Rule 103(6), second sentence, EPC implies that the board take a decision even in the absence of a request by the appellant.
- 2.2 Appellant 2 requests partial reimbursement of the appeal fee under Rule 103(3)(a) EPC. In accordance with Rule 103(3)(a) EPC, the appeal fee is to be reimbursed at 50% if the appeal is withdrawn within one month of notification of a communication issued by the board in preparation for the oral proceedings. However, no statement of appellant 2 is on file by which it withdrew its appeal. There is no such statement in appellant 2's letter of 29 November 2022. For this reason alone, the board cannot accede to appellant 2's request for partial reimbursement of the appeal fee.
- 2.3 However, in view of decision T 488/18, points 8 ff of the Reasons and the respondent's letter dated 24 November 2022, the board decided to order on its own motion reimbursement of 25% of the appeal fee under Rule 103(4)(c) EPC (for both appellants).

## Order

### For these reasons it is decided that:

1. Appellant 2's request for apportionment of costs is refused.
2. Appellant 2's request for reimbursement of the appeal fee at 50% is refused.
3. The appeal fees are reimbursed at 25%.

The Registrar:

The Chairwoman:



L. Malécot-Grob

T. Sommerfeld

Decision electronically authenticated