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**Datasheet for the decision
of 16 June 2023**

Case Number: T 0635/21 - 3.3.06

Application Number: 15705416.4

Publication Number: 3099644

IPC: B32B7/12, B32B17/06, B32B27/36,
B32B37/16, C03C3/091, H05K1/02,
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C03C17/32, C03C21/00,
B32B37/12, G02F1/1333, H04M1/02

Language of the proceedings: EN

Title of invention:
Bendable glass, articles and methods of making the same

Patent Proprietor:
Corning Incorporated

Opponent:
Schott AG

Headword:
Bendable glass/CORNING

Relevant legal provisions:
EPC Art. 104(1)
RPBA 2020 Art. 16(1)

Keyword:

Apportionment of costs - (no)

Decisions cited:

T 0909/90, T 0952/00, T 0674/03, T 0053/06

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 0635/21 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 16 June 2023

Appellant: Corning Incorporated
(Patent Proprietor) 1 Riverfront Plaza
Corning, New York 14831 (US)

Representative: Sackin, Robert
Reddie & Grose LLP
The White Chapel Building
10 Whitechapel High Street
London E1 8QS (GB)

Respondent: Schott AG
(Opponent) Hattenbergstrasse 10
55122 Mainz (DE)

Representative: Fuchs Patentanwälte Partnerschaft mbB
Tower 185
Friedrich-Ebert-Anlage 35-37
60327 Frankfurt am Main (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 15 March 2021
revoking European patent No. 3099644 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: L. Li Voti
C. Heath

Summary of Facts and Submissions

- I. The patent proprietor filed an appeal against the decision of the opposition division revoking European patent no. 3099644 on the grounds that none of the requests on file was found to overcome the objection raised under Article 123(2) EPC.
- II. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of the claims according to the main request or of one of auxiliary requests 1 to 35, all requests having been filed with the statement of grounds of appeal.
- III. In its reply, the respondent and opponent requested that the appeal be dismissed, that none of the auxiliary requests be admitted into the proceedings and that the case not be remitted to the opposition division.
- IV. Following the board's provisional opinion, both parties presented further arguments as regards in particular the request for remittal, with the respondent referring inter alia to the parallel case T 1521/20 before the same board. The appellant also filed further auxiliary requests (numbered auxiliary requests 36 to 71).
- V. During the oral proceedings before the board the appellant withdrew its appeal and the respondent requested apportionment of costs in its favour.

Reasons for the Decision

1. According to Article 104, paragraph 1, EPC and Article 16(1) RPBA 2020 each party shall in principle bear its own costs in proceedings before the EPO. The board may however order a different apportionment of costs for reasons of equity.
2. The board notes that the above rule differs from a number of national jurisdictions that allow the successful party to recover its expenses from the unsuccessful one. Under the EPC, the only reason for a different apportionment of costs is the inequitable conduct of one of the parties.
3. In the present case, the respondent argued that the appellant, by withdrawing the appeal at a late stage during oral proceedings, prevented the respondent from obtaining a reasoned decision on the issues of patentability as discussed. This was compounded by the fact that such course of action had equally been chosen by the appellant also at least in one parallel case related to the same technology (**T 1521/20**) in order to leave undecided, by avoiding a reasoned decision, the validity of the still ongoing parallel cases wherein similar patentability issues will have to be discussed again. Therefore, the appellant's withdrawal of the appeal amounted to an abuse of procedure that justified the request for apportionment of costs in the respondent's favour.
4. The board observes that case law on inequitable conduct has primarily been developed by the Boards of Appeal for a party that has requested oral proceedings, thereby constraining the other side to appear to the

hearing, and without or very short notice choosing not to attend the same (decisions **T 909/90**, **T 53/06**).

5. Still, inequitable conduct by a party is not necessarily limited to an unexcused non-appearance for an oral hearing that but for the party's conduct would have been unnecessary. Rather, according to decision **T 952/00** (Reasons, point 5), *"the equity requirement is a matter for the body hearing the case to decide at its discretion in the light of the facts. It is to be seen as the compensation one party owes another as a result of his negligence or culpable irresponsibility, or a wrongful act carried out with intent to cause the other party harm and leading to damage requiring that party to request oral proceedings or the taking of evidence which would otherwise have been unnecessary. The wrongful act, whether intentional or simply the result of culpable negligence, must be judged in relation to what the normal behaviour of an ordinarily diligent party would have been. It must also be clearly and obviously the direct cause of the costs which should not have been incurred"*.

6. The Board is mindful of the fact that in certain circumstances, the withdrawal of an appeal can be considered abusive, namely in the context of several (pending) divisional applications where the withdrawal of an application or appeal is meant to avoid legal certainty, see e.g. the decision of the District Court Munich of 24 February 2020 (**7 O 1456/20**), headnote 1: *"A patentee that on the basis of a parent application has branched off several, mostly identical divisional applications, acts contrary to honest practices when by voluntarily dropping the patent right prior to a decision of the opposition division, avoids a decision of the Boards of Appeal for a parallel divisional*

patent that could clarify the legal situation for the whole field of the invention".

Further such practices are highlighted by K. Foss-Solbrekk, "*The Divisional Game: Using Procedural Rights to Impede Generic/Biosimilar Market Entry*", 53 IIC 1007-1037 (2022).

7. However, for the case at issue, the board remarks that it is established case law that an appellant has the right, based on the principle of party's disposition, to withdraw its appeal at any time and that the use of a right does not in principle constitute an abuse (see for example decision **T 0674/03**).

Moreover, there is in the Board's view insufficient evidence that the withdrawal of the appeal was part of a systematic approach by the appellant to avoid clarifying the issues of patentability by way of a written decision on such issues.

8. The board thus concludes for the above reasons that the respondent's request for apportionment of costs is not justified and that any party has to bear the costs it has incurred.

Order

For these reasons it is decided that:

The respondent's request for apportionment of costs is refused.

The Registrar:

The Chairman:



D. Hampe

J.-M. Schwaller

Decision electronically authenticated