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**Datasheet for the decision  
of 11 February 2025**

**Case Number:** T 0006/23 - 3.3.02

**Application Number:** 15196223.0

**Publication Number:** 3098281

**IPC:** C09K5/04

**Language of the proceedings:** EN

**Title of invention:**  
COMPOSITION COMPRISING HFC AND HFO

**Patent Proprietor:**  
Daikin Industries, Ltd.

**Opponents:**  
The Chemours Company FC, LLC  
ARKEMA France

**Headword:**  
DAIKIN / REFRIGERANT COMPOSITION / HFC HFO

**Relevant legal provisions:**  
EPC Art. 113(1)  
EPC R. 111(2), 103(1)(a)  
RPBA 2020 Art. 11

**Keyword:**

Right to be heard - substantial procedural violation (yes)  
Appealed decision - sufficiently reasoned (no)  
Remittal - special reasons for remittal (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**

T 0763/04

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0006/23 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 11 February 2025**

**Appellant:**  
(Patent Proprietor)

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**Representative:**

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**Respondent:**

(Opponent 2)

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 18 October 2022  
revoking European patent No. 3098281 pursuant to  
Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman**            M. O. Müller  
**Members:**            M. Maremonti  
                              B. Burm-Herregodts

## Summary of Facts and Submissions

- I. The appeal by the patent proprietor ("appellant") lies from the opposition division's decision to revoke European patent No. 3 098 281 ("the patent").
- II. Two oppositions were filed under Article 100(a) to (c) EPC. With the reply to the notices of opposition dated 7 September 2021, the appellant filed a set of claims according to a main request. Claim 1 of this request reads as follows:
- "1. A composition comprising*
- (1) HFO-1234ze and optionally HFO-1234yf;*
- (2) HFC-134a and HFC-134; and*
- (3) HCFC-1122, HCFC-124, CFC-1113, and*  
*3,3,3-trifluoropropyne;*
- wherein the total amount of (1) and (2) is  $\geq$  95 mass%, based on the total amount of (1)-(3)."*
- III. By letter dated 4 August 2022, opponent 1 filed an experimental report labelled D30.
- IV. By letter dated 3 October 2022, opponent 1 withdrew its opposition.
- V. During oral proceedings on 4 October 2022, the opposition division revoked the patent. In its written reasoned decision, it admitted D30 and concluded on the basis of this document that a technical effect was not achieved over the whole scope of the claims. In view of this, it decided that the subject-matter of claim 1 of the main request did not involve an inventive step.

VI. In the statement of grounds of appeal and in a subsequent letter, the appellant submitted that its right to be heard had been violated during the proceedings before the opposition division and that this violation justified remittal of the case. Moreover, it contested the decision under appeal and argued, *inter alia*, that the subject-matter of claim 1 of the main request involved an inventive step. The appellant corroborated its arguments by filing the following new items of evidence (labelled as D33 to D35 by the appellant; new numbering by the board):

A33: Experimental Report

A34: Experimental Report 2

A35: Wasim Akran *et al.*, "*Lubricity of environmentally friendly HFO-1234yf refrigerant*"; Tribology International, vol. 57, 2013, pages 92 to 100

VII. In its reply to the appeal, opponent 2 ("respondent") rebutted the appellant's arguments and submitted, *inter alia*, that the opposition division had not committed a procedural violation. Moreover, the subject-matter of claim 1 of the main request lacked an inventive step. The respondent also contested the admittance of A33 and A34.

VIII. The parties were summoned to oral proceedings as per their requests. In preparation for the oral proceedings, the board issued a communication under Article 15(1) RPBA. In this communication, the board expressed, *inter alia*, the preliminary opinion that the opposition division had committed a substantial procedural violation.

IX. Oral proceedings before the board were held on 11 February 2025 by videoconference with both parties

present. At the beginning of the oral proceedings, the respondent further requested that A35 not be admitted.

X. Final requests relevant to the decision

The appellant requested that the decision under appeal be set aside, that the case be remitted to the opposition division for further prosecution and that the appeal fee be reimbursed.

The respondent requested that the case not be remitted to the opposition division. The respondent further requested that the appeal be dismissed and that revocation of the patent be confirmed. It further requested that A33 to A35 not be admitted.

XI. The parties' submissions that are relevant to the decision are referred to in the reasons for the decision below.

### **Reasons for the Decision**

Violation of the right to be heard - procedural violation -  
Article 113(1) EPC and Rule 111(2) EPC

1. The appellant argued that opponent 1 had filed the experimental report D30 just two months prior to the oral proceedings before the opposition division. By a subsequent letter, the appellant had requested that D30 not be admitted or, alternatively, that the oral proceedings be postponed to give the appellant sufficient time to respond to D30. Contrary to what was stated under point XIII of the decision under appeal, the appellant had not withdrawn its request for postponement. On the contrary, when discussing the admittance of D30, the appellant had reiterated that it had not been given sufficient time to analyse the data contained in D30 and provide data to refute the

statements made in that document. By admitting D30 and at the same time refusing to postpone the oral proceedings, the opposition division had not given the appellant an opportunity to present its comments on D30, including the submissions based on A33 and A35, or to file experimental counter-evidence, such as A34. This amounted to a violation of its right to be heard. Additionally, the decision under appeal did not contain any reasoning as to why the requested postponement had not been granted. The opposition division had thus committed a substantial procedural violation.

2. The respondent was of the view that the opposition division had correctly exercised its discretion to admit the experimental report D30 while at the same time refusing to postpone the oral proceedings. It submitted that a two-month period was sufficient for the appellant to analyse the content of D30 and respond to it before or at the oral proceedings. The respondent further referred to the minutes of the oral proceedings before the opposition division, especially points 1.4 and 5.4.1, in which no request for postponement was mentioned. This meant that this request had not been maintained.
3. The board notes the following.
  - 3.1 As set out in T 763/04 (point 4.4 of the reasons), the right to be heard under Article 113(1) EPC involves two aspects - the first being that a party must be given the opportunity to present its comments on any ground or evidence, the second being that the decision must be reasoned as required by Rule 111(2) EPC; the opposition division must not merely acknowledge the existence of said comments but also make it clear in its decision that these comments were read and discussed on the merits.



- 3.2 In their notices of opposition, the opponents had alleged, albeit without any experimental evidence, that the claimed subject-matter did not achieve any technical effect over documents which could be regarded as the closest prior art. Opponent 1 further objected (see page 17, first full paragraph of the notice of opposition) to the lack of details in the patent as regards the operating conditions of the abrasion test and the baking test (paragraphs [0027] and [0028] of the patent) which were to be used to demonstrate a technical effect of the claimed composition.
- 3.3 With its reply to the notices of opposition dated 7 September 2021 (see page 14 of the reply), the appellant filed experimental data to demonstrate a technical effect of the claimed subject-matter, specifically of component (3) of the claimed composition (point II above).
- 3.4 On 16 November 2021, the opposition division issued the summons to oral proceedings. In an annex, it expressed the preliminary opinion that on the basis of the experimental data provided by the appellant, an inventive step had to be acknowledged (page 5). At the same time, the final date for making written submissions under Rule 116(1) EPC was set as 4 August 2022.
- 3.5 By letter dated 4 August 2022, i.e. on the final day for making submissions under Rule 116(1) EPC and two months prior to the oral proceedings, opponent 1 filed experimental report D30 to demonstrate that a technical effect of component (3) could not be recognised across the whole claimed scope.
- 3.6 By letter dated 25 August 2022, the appellant requested that D30 not be admitted or, alternatively, that oral

proceedings be postponed so that it could analyse the data contained in D30 and prepare a response.

- 3.7 By communication dated 15 September 2022, the opposition division notified the parties that the date set for oral proceedings would not be changed. No reasons for refusing to postpone the oral proceedings were mentioned.
- 3.8 During the oral proceedings, the opposition division admitted D30. The opposition division concluded on the basis of D30 that a technical effect could not be acknowledged over the whole scope claimed. In view of this conclusion, the opposition division denied inventive step and revoked the patent.
- 3.9 It is acknowledged that, as asserted by the respondent, although the minutes of the oral proceedings before the opposition division (page 1, point 1.4) do refer to the appellant's request not to admit D30, there is no mention of a request for postponement. Nevertheless, there is also no reference to a written statement withdrawing this request, which had been made with the letter dated 25 August 2022. On the contrary, when discussing the admittance of D30, the appellant reiterated that it had not been given sufficient time to analyse the content of D30 and rework the experiments (minutes of the oral proceedings, page 2, point 5.4.1). The assertion that there had not been sufficient time before the date of the oral proceedings can only imply that the appellant still wanted those oral proceedings to be postponed to a later date.
- 3.10 In view of the above, the opposition division's statement under point XIII of the decision under appeal that the appellant had not maintained the request for postponement is inconsistent with the case history summarised above.

- 3.11 In its decision concerning the admittance of D30 (decision under appeal, page 6, point 4), the opposition division did not give any reason why it was not granting the appellant more time by postponing the oral proceedings. The opposition division's decision is thus not reasoned, contrary to Rule 111(2) EPC. For this reason alone, the appellant's right to be heard has been violated (Article 113(1) EPC).
- 3.12 Moreover, the appellant had promptly reacted to the opponents' objection, raised in their notices of opposition, that no technical effect could be attributed to the claimed subject-matter, namely by filing experimental data with the reply to the notices of opposition. By contrast, as noted by the appellant, opponent 1 had waited almost one year from that reply and nine months from the opposition division's preliminary opinion to file experimental report D30, which was not filed until the final date for making written submissions under Rule 116(1) EPC.
- 3.13 The board agrees with the appellant's view that it did not have sufficient time to properly respond to D30 before or at the oral proceedings. Since the opposition division admitted D30, it should have granted a postponement of the oral proceedings to preserve the appellant's right to be heard.
- 3.14 By not postponing the oral proceedings and not considering the appellant's argument that it did not have sufficient time to properly respond to D30, the opposition division violated the appellant's right to be heard (Article 113(1) EPC). Moreover, the opposition division violated the principle of fairness towards the parties by allowing opponent 1 to take almost one year to file its evidence while forcing the appellant - by rejecting its request for postponement of the oral proceedings - to file a response (such as A33 and A35

and related arguments) including experimental counter-evidence (such as A34) within two months.

3.15 The opposition division has thus committed a procedural violation.

3.16 Moreover, this procedural violation is substantial since the lack of inventive step is the sole ground on which the opposition division revoked the patent, basing its finding precisely on the experimental report D30 (decision under appeal, page 7, last two paragraphs).

Remittal to the opposition division - Article 11 RPBA - reimbursement of the appeal fee - Rule 103(1)(a) EPC

4. Under Article 11 RPBA, the board does not remit a case to the opposition division for further prosecution unless special reasons present themselves for doing so. Fundamental deficiencies apparent in the proceedings before the opposition division constitute such special reasons.

4.1 Therefore, in view of these provisions, the board considers that the case has to be remitted since, as set out above, the opposition division committed a substantial procedural violation.

4.2 The respondent objected to the remittal. It argued that the parties had made sufficient submissions on inventive step on appeal to allow a decision to be taken. Even though the admittance of the evidence produced by the appellant on appeal by means of documents A33 to A35 had been contested, this was not a valid reason to remit the case; opponent 1 had already raised an objection to missing details in the patent as regards the operating conditions of the abrasion test and the baking test in its notice of opposition (see above). The appellant could and should have responded

to this objection by filing A33 to A35 before the opposition division and not only on appeal.

4.3 However, the board notes that the appellant filed documents A33 to A35 in response to experimental report D30. A34 constitutes experimental counter-evidence to D30 to disprove the experimental results provided by opponent 1. A33 and A35 concern the discrepancy in operating conditions between D30 and A34. As set out above, the board agrees with the appellant that it had not been given sufficient time to react to the filing of D30 before the opposition division. Even though opponent 1 had indeed raised an objection to missing details in relation to the experimental conditions of the abrasion test and the baking test in its notice of opposition, the appellant had reacted by filing experimental data; the opposition division had issued a preliminary opinion in favour of inventive step on the basis of these data (see above). Therefore, there was no need for the appellant to file additional data and submissions based on A33 to A35 before the opposition division. As argued by the appellant, this need was triggered for the first time by the filing of D30 just two months prior to oral proceedings.

4.4 As pointed out by the appellant, not remitting the case would have implied discussing the contradictory results presented in D30 and A34, especially in consideration of the content of A33 and A35, for the first time on appeal. The board concurs with the appellant that these substantial issues concerning inventive step should first be discussed before the opposition division, also in view of the fact that the respondent had requested that A33 to A35 not be admitted. Not remitting the case would have meant the board ruling on this request on the basis of the provisions set out in the Rules of Procedure of the Boards of Appeal, using much stricter

criteria than those available before the opposition division. This would not have represented fair proceedings towards the appellant, which had already been deprived of its right to be heard before the opposition division for the reasons set out above.

5. Therefore, the board concludes that the case has to be remitted to the opposition division for further prosecution, pursuant to Article 11 RPBA.
6. Since the appeal is allowable, reimbursement of the appeal fee is equitable by reason of the substantial procedural violation mentioned above (Rule 103(1)(a) EPC).

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



U. Bultmann

M. O. Müller

Decision electronically authenticated