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**Datasheet for the decision
of 22 September 2015**

Case Number: T 0860/12 - 3.3.10
Application Number: 05744161.0
Publication Number: 1716216
IPC: C09K5/04, C09K3/30, C08J9/14
Language of the proceedings: EN

Title of invention:

COMPOSITIONS CONTAINING FLUORINE SUBSTITUTED OLEFINS

Patent Proprietor:

Honeywell International Inc.

Opponents:

ARKEMA FRANCE
Daikin Industries, Ltd.
Asahi Glass Company Limited
Daimler AG
ACEA European Automobile Manufacturers Association
Wallinger, Michael
Bayerische Motoren Werke Aktiengesellschaft
Mexichem Amanco Holding S.A. de C.V.
Solvay Fluor GmbH

Headword:

Fluorine substituted olefins / Honeywell International Inc.

Relevant legal provisions:

EPC Art. 100(c)

Keyword:

All requests: grounds for opposition - extension of subject-matter (yes)

Decisions cited:

T 0288/92

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 0860/12 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 22 September 2015

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 13 April 2012
revoking European patent No. 1716216 pursuant to
Article 101(2) and 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: C. Komenda
D. Rogers

Summary of Facts and Submissions

I. The Appellant (Patent Proprietor) lodged an appeal against the Opposition Division's decision which revoked the European patent Nr. 1 716 216.

II. Notice of Opposition had been filed by the Respondents 1 to 9 (Opponents 1 to 9) requesting revocation of the patent in its entirety *inter alia* on the ground that the patent as granted contained amendments extending beyond the content of the original application documents (Article 123(2) EPC) which corresponded to an objection under Article 100 (c) EPC.

III. The decision under appeal was based on the claims according to the main request (claims as granted) and according to the then pending auxiliary requests 1 to 6 and 8 to 12. The late filed auxiliary request 7, which was filed during the oral proceedings before the opposition division was not admitted into the opposition proceedings under Article 114(2) EPC. The wording of independent claim 1 of the main request (claim 1 as granted) read as follows:

"1. Use as a refrigerant of a composition comprising a tetrafluoropropene (HFO-1234) in an automobile air conditioning system."

IV. In its decision the Opposition Division found that the subject-matter of claim 1 as granted claimed the combination of a specific class of fluoroalkenes, namely HFO-1234, in an automobile air conditioning system. Since this specific combination of features could neither be directly and unambiguously derived from the claims as originally filed nor the original description, the combination of the specific class of fluoroalkenes,

HFO-1234, and the automobile air conditioning system was regarded as representing technical information extending beyond the disclosure of the original application (Article 123(2) EPC). Therefore, the objection under Article 100(c) EPC was justified. Since the combination of the class of tetrafluoropropenes, HFO-1234, and its use in an automobile air conditioning system was present in all of the then pending auxiliary requests 1 to 6 and 8 to 12, the same argumentation and conclusion applied also to the subject-matter of these requests.

V. With its letter dated 5 March 2015 the Appellant filed first to ninth auxiliary requests. In its letter dated 15 September 2015 it withdrew the fourth and ninth auxiliary request and declared that the remaining first to third and fifth to eighth auxiliary requests were replacing all other auxiliary requests 1 to 26 that had been filed at earlier stages of the appeal procedure.

a) The wording of independent claim 1 of the first auxiliary request reads as follows:

"1. Use in refrigeration of a heat transfer composition comprising a tetrafluoropropene (HFO-1234), in an automobile air conditioning system."

b) The wording of independent claim 1 of the second auxiliary request reads as follows:

"1. Use as a refrigerant of a composition comprising a tetrafluoropropene (HFO-1234), in an automobile air conditioning system, wherein the composition has a Global Warming Potential (GWP) of not greater than 1000."

- c) The wording of independent claim 1 of the third auxiliary request reads as follows:

"1. Use in refrigeration of a heat transfer composition comprising a tetrafluoropropene (HFO-1234), in an automobile air conditioning system, wherein the composition has a Global Warming Potential (GWP) of not greater than 1000."

- d) The fifth to eighth auxiliary requests consisted each of only one claim. The wording of the single claim of the fifth to eighth auxiliary request was identical to the wording of claim 1 as granted, or of claim 1 of the first to third auxiliary requests, respectively (see Paragraphs III, and V a) to c), *supra*).

VI. The Appellant argued that a skilled person reading the application would have already learned from the abstract that the tetrafluoropropenes referred to as HFO-1234 was the most preferred group of compounds for all the various applications listed in the application. Further, original claims 1 to 24, which related to heat transfer fluids explicitly mentioned tetrafluoropropenes HFO-1234 in claim 3. The description, in particular pages 6 and 7 of the application described all the compounds of formula I as being suitable for all kinds of applications. A preferred subgroup of formula I was defined by the compounds according to formula II and on page 9, lines 8 and 14 the compounds HFO-1234 were highlighted as being even more preferred. All compounds of formula I included all tetrafluoropropenes HFO-1234 and were said to be suitable for various applications, including cooling applications. One of the cooling applications was the use as a refrigerant in automobile air conditioning systems as disclosed on page 12, lines

8 to 12 and in claim 40 of the application as filed. The word "adaptable" on page 12, line 9, only meant that the systems could optionally be adapted for use in automobile air conditioning systems, if they were not already fit for that purpose. The compounds HFO-1234 were already suitable and did not need to be adapted. Therefore, a skilled person would have had no reason to exclude these highly preferred tetrafluoropropenes HFO-1234 from the group of compounds of formula I, which were suitable for application as refrigerant in automobile air conditioning systems, since this information was already present in the application as filed. The combination of tetrafluoropropenes HFO-1234, which was the most preferred class of compounds for all applications, with a particular application, namely the use as heat transfer fluid or refrigerant in automobile air conditioning systems, could not be regarded as being a selection out of two lists.

VII. In their reply the Respondents maintained their objection raised under Article 100 (c) EPC. In particular they stated that the abstract was not part of the disclosure. Any amendment made had to be clearly and unambiguously derivable from the application as originally filed. The passages on pages 6 to 9 did, however, not specify for which particular application the compounds were used. Further, the compounds according to formula II only covered four out of the seven compounds of the tetrafluoropropenes HFO-1234. Thus, the tetrafluoropropenes HFO-1234 did not emerge by simply restricting the compounds of formula I to those also found in formula II. On pages 6 to 9 of the application as filed the tetrafluoropropenes HFO-1234 were mentioned as being preferred, but only in a very specific context, namely in relation to the toxicity level and to the amounts of the compounds used in the

various compositions. Further, the description mentioned four particular areas of application of the compounds of the disputed patent. These applications were described as being completely separate from each other and not all of them identified the tetrafluoropropenes HFO-1234 as being the preferred group of compounds. Particularly with regard to the heat transfer compositions the application as filed disclosed the compounds of Formula I, more preferably the compounds of Formula II and even more preferably the cis and trans forms of one particular compound, namely HFO-1234ze, but did not mention the tetrafluoropropenes HFO-1234. In the same chapter it disclosed that these compounds were adaptable for use in connection with automobile air conditioning systems. Therefore, the compositions were not yet fit for use in this specific application. Original claim 3 disclosed the tetrafluoropropenes HFO-1234, but in referring back to claim 1 it further specified that they had to have a global warming potential (GWP) of not greater than about 1000. Claim 40 related only to a method of transferring heat to or from a fluid or a body, which method comprised circulating the composition in an automobile air conditioning system. However, it only referred to the compositions comprising a compound according to formula I in general, but not to the tetrafluoropropenes HFO-1234. Consequently, the originally filed claims also could not serve as a basis for the amendment.

- VIII. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution upon the basis of the claims as granted, or subsidiarily, upon the basis of the claims according to one of the first to third and fifth to eighth auxiliary

requests, all auxiliary requests filed under cover of a letter dated 5 March 2015.

The Respondents 1 to 3 and 5 to 9 requested that the appeal be dismissed.

Respondent 4 neither filed any requests nor observations.

IX. In the absence of Respondents 4 and 6 oral proceedings were held on 22 September 2015 before the Board. At the end of the oral proceedings the decision was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Amendments (Article 100(c) EPC)*

2.1 The patent in suit has been opposed inter alia on the ground that the subject-matter of the patent extended beyond the content of the application as filed (Article 100(c) EPC). In particular, the combination of the use of a specific group of compounds, the tetrafluoropropenes HFO-1234 and their specific use in automobile air conditioning systems in granted claim 1 was objected to for having no basis in the application as filed.

2.2 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, either explicitly or implicitly (see decision T 288/92, point 3.1 of the reasons).

2.3 Claim 1 of the Main Request, which is claim 1 as granted is directed to the

"use as a refrigerant of a composition comprising a tetrafluoropropene (HFO-1234) in an automobile air conditioning system" (see paragraph III *supra*).

2.4 Neither any of the originally filed claims, nor any passage in the originally filed description explicitly discloses this particular combination of technical features. Therefore, it has to be examined, whether the original application as a whole implicitly discloses the subject-matter as claimed in granted claim 1.

2.5 In this respect the Appellant argued that the originally filed application disclosed the class of tetrafluoropropenes HFO-1234 as the overall most preferred class of compounds for each and every type of application. Therefore, a combination of the most preferred compounds, HFO-1234, with each type of application mentioned in the original application documents did not add any new information, since it only required one selection within the various applications.

2.5.1 Concerning the argument that HFO-1234 was the overall preferred group of compounds it has to be stated that only original claim 3, which was also referred to by the Appellant, relates to the tetrafluoropropenes HFO-1234 as being a preferred embodiment of the compositions claimed in claim 1. However, these compositions are further characterized by having a Global Warming Potential (GWP) of not greater than about 1000 and thus

do not support that HFO-1234 as such was the overall preferred embodiment for all applications mentioned in the application as filed.

2.5.2 Further, the originally filed description identifies separate groups of preferred and highly preferred compounds to be used for each of the four different types of applications. Under the heading "propellant and aerosol compositions" and "blowing agents, foams and foamable compositions", the class of compounds HFO-1234 is mentioned as preferred or highly preferred compounds. Under the heading "flavorants and fragrances" and "heat transfer compositions" only very specific compounds out of the general class of HFO-1234 are mentioned, but not the class of tetrafluoropropenes HFO-1234 as a whole. In particular, for the application of the claimed compositions as heat transfer compositions, described on page 10, line 7 to page 12, line 12, the description only refers to the compound HFO-1234ze (page 10, lines 12 to 13). Therefore, a skilled person reading the application as filed would realize that for each of the various applications very specific groups of preferred compounds are used.

2.5.3 The only passages relating to the use of the compositions in automobile air conditioning systems are located within the chapter under the heading "heat transfer compositions" (page 12, lines 8 to 9) and in original claim 40. Consequently, a skilled person would have only considered the compositions mentioned therein to be suitable for use in automobile air conditioning systems.

The compounds used for the refrigerant compositions listed under the heading "heat transfer compositions" are those in accordance with Formula I, more preferably

in accordance with Formula II, and even more preferably HFO-1234ze (page 10, lines 10 to 13). Since the chapter relating to "heat transfer compositions" does not even mention the group of compounds HFO-1234, the skilled person would not have derived that HFO-1234 was also preferred for use in automobile air conditioning systems.

Original claim 40, which was also referred to by the Appellant, relates to a method for transferring heat, which method comprises the step of circulating a composition according to claim 36 in an automobile air conditioning system. The composition referred to in claim 36 comprises a fluoroalkene of Formula I, but does not refer to the group of tetrafluoropropenes HFO-1234 in general, nor to the heat transfer compositions of claims 1 or 3.

In both cases the selection of HFO-1234 as a further preferred subgroup of all compounds falling within the definition of Formula I constitutes new information that was not present in the application as filed.

- 2.5.4 According to the Appellant a further indication that the class of tetrafluoropropenes HFO-1234 was the overall preferred group of compounds was to be found in the abstract, which also focused on HFO-1234 as being preferred.

However, the abstract does not form part of the original disclosure and cannot form a basis for the amendment made to the claims. Therefore, the Appellant's argument cannot succeed.

- 2.5.5 The Appellant further stated that the suitable compounds could be identified by restricting those of Formula I to

preferably those of Formula II, even more preferably to those of the group HFO-1234 and to highly preferred individual compounds out of the group HFO-1234. The fact that the chapter headed "heat transfer compositions" did not mention HFO-1234 was of no relevance to the skilled person, who learned from the whole application as filed that HFO-1234 was the focus for all applications.

However, it has to be stated that there is no disclosure of hoe to go from the compounds according to formula II to the group of tetrafluoropropenes HFO-1234, since only four out of seven compounds of the group HFO-1234 fall within the definition of Formula II. Therefore, the skilled person would have realized that HFO-1234 represented a group of compounds separate from those of Formula II. Consequently, he would not have automatically included all tetrafluoropropenes HFO-1234, since only the compounds according to Formula II and HFO-1234ze were mentioned as being preferred for the heat transfer compositions. Therefore, this argument is not convincing.

- 2.5.6 As a further argument the Appellant brought forward that the description of the claimed compounds on pages 5 to 9 mentioned that the compounds described therein were suitable for all kinds of applications, including the use as refrigerants. In the same chapter the group of tetrafluoropropenes HFO-1234 was explicitly mentioned as being preferred.

However, the group of HFO-1234 was mentioned only in a specific context that this class of compounds is preferred as low toxicity compounds, but it was not specified as representing a preferred class of compounds for all kinds of applications. Therefore, this argument of the Appellant cannot succeed.

- 2.6 For these reasons, the Board concludes that the original application documents do not disclose that the group of the tetrafluoropropenes HFO-1234 is the overall preferred group of compounds for use in each and every application mentioned in the original application documents. The combination of the features relating to the use of the tetrafluoropropenes HFO-1234 in automobile air conditioning systems thus constitutes new information which a skilled person would not have directly and unambiguously derived from the application as filed, either explicitly, or implicitly.
- 2.7 Claim 1 of the main request therefore extends the subject-matter claimed beyond the content of the application as filed, thus justifying the ground for opposition pursuant to Article 100(c) EPC.
- 2.8 Whether the other technical features in claim 1 of the main request have a basis in the original application documents, or not, needs not to be decided.

First to third and fifth to eighth auxiliary requests

3. The wording of claims 1 of each of the first to third and fifth to eighth auxiliary requests contains the combination of the class of compounds HFO-1234 and their use in automobile air conditioning systems (see paragraph V *supra*). Therefore, the same arguments and conclusions apply as for the main request with the consequence that the subject-matter of these claims extends beyond the content of the application as filed, thus justifying the ground for opposition pursuant to Article 100(c) EPC.

3.1 Any other amendments made to these claims need not to be decided upon.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated