

**Internal distribution code:**

- (A) [ - ] Publication in OJ  
(B) [ - ] To Chairmen and Members  
(C) [ - ] To Chairmen  
(D) [ X ] No distribution

**Datasheet for the decision  
of 21 July 2015**

**Case Number:** T 0784/14 - 3.3.09  
**Application Number:** 08831921.5  
**Publication Number:** 2190304  
**IPC:** A23L1/29, A23L1/30, A61K38/00  
**Language of the proceedings:** EN

**Title of invention:**

NUTRITIONAL FORMULATION WITH HIGH ENERGY CONTENT

**Patent Proprietor:**

N.V. Nutricia

**Opponents:**

Fresenius Kabi Deutschland GmbH  
ABBOTT LABORATORIES  
Nestec S.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 113(2), 104(1)  
RPBA Art. 12(4), 16(1), 16(1)(e)

**Keyword:**

No text agreed by appellant - appeal dismissed  
Apportionment of costs (no)

**Decisions cited:**

T 0134/11, T 2468/12

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 0784/14 - 3.3.09

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.09**  
**of 21 July 2015**

**Appellant:**  
(Patent Proprietor)

N.V. Nutricia  
Eerste Stationsstraat 186  
2712 HM Zoetermeer (NL)

**Representative:**

Nederlandsch Octrooibureau  
P.O. Box 29720  
2502 LS The Hague (NL)

**Respondent:**  
(Opponent 1)

Fresenius Kabi Deutschland GmbH  
Else-Kröner-Str. 1  
61352 Bad Homburg (DE)

**Representative:**

Heimann, Axel Colin  
Fresenius Kabi Deutschland GmbH  
Patent Department  
Else-Kröner-Strasse 1  
61352 Bad Homburg (DE)

**Respondent:**  
(Opponent 2)

ABBOTT LABORATORIES  
100 Abbott Park Road  
Abbott Park IL 60064 (US)

**Representative:**

Boult Wade Tennant  
Verulam Gardens  
70 Gray's Inn Road  
London WC1X 8BT (GB)

**Respondent:**  
(Opponent 3)

Nestec S.A.  
Avenue Nestlé 55  
1800 Vevey (CH)

**Representative:**

Rupp, Christian  
Mitscherlich PartmbB  
Patent- und Rechtsanwälte  
Sonnenstraße 33  
80331 München (DE)

**Decision under appeal:**      **Decision of the Opposition Division of the  
European Patent Office posted on 13 February  
2014 revoking European patent No. 2190304  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**                    W. Sieber  
**Members:**                  M. O. Müller  
                                  E. Kossonakou

## Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the proprietor of European patent No. 2 190 304 against the decision of the opposition division to revoke it.
- II. Oppositions were filed by Fresenius Kabi Deutschland GmbH (opponent 1), Abbott Laboratories (opponent 2) and Nestec S.A. (opponent 3) requesting revocation of the patent on the grounds of Article 100(a) (lack of novelty and inventive step), (b) and (c) EPC.
- III. During the entire opposition proceedings, the proprietor filed neither a response, nor claim requests, nor a request for oral proceedings.
- IV. By decision issued in writing on 13 February 2014, the opposition division revoked the patent.
- V. This decision was appealed by the proprietor (hereinafter "the appellant"). The statement of grounds of appeal (filed on 23 June 2014) included a main request and an auxiliary request 1.
- VI. In their respective responses to the statement of grounds of appeal, opponents 1 to 3 (hereinafter "respondents 1 to 3") requested that:
  - the appeal be declared inadmissible (respondents 2 and 3);
  - the appellant's claim requests be declared inadmissible (respondents 1 to 3);
  - the appeal be dismissed (respondents 1 to 3);

- a referral be made to the Enlarged Board of Appeal (respondent 2);
- costs be apportioned (respondents 1 to 3); and
- oral proceedings be held.

VII. In a communication issued on 2 February 2015, the board indicated that the appeal appeared to be admissible, that there was no need for a referral to the Enlarged Board of Appeal, that the appellant's claim requests appeared to be inadmissible and that no costs needed to be apportioned.

VIII. In response to the board's communication, respondent 3 *inter alia* commented on the issue of apportionment of costs (letter dated 8 June 2015).

IX. In its letter dated 19 June 2015, the appellant stated as follows:

"Please be informed that the Proprietor no longer approves of the text and that the Proprietor requests revocation of the above referenced patent EP 2190304".

X. In a second communication, dated 26 June 2015, the board observed that the text referred to by the appellant could only be the claims of the main request and auxiliary request 1 as submitted with the statement setting out the grounds of appeal. Consequently, there was no claim request pending in the present appeal proceedings that had been approved by the appellant (Article 113(2) EPC). The board announced that in view of this, the appeal would have to be dismissed.

The board furthermore asked the respondents to clarify whether they maintained their requests for referral to the Enlarged Board of Appeal and for apportionment of costs.

- XI. In response to the board's second communication,
- respondent 1 withdrew its request for apportionment of costs (letter of 29 June 2015);
  - respondent 2 maintained its request for apportionment of costs but withdrew its request for a referral to the Enlarged Board of Appeal (letter of 30 June 2015); and
  - respondent 3 maintained its request for apportionment of costs (letter of 8 July 2015).

Furthermore, all respondents withdrew their requests for oral proceedings.

- XII. The appellant did not file any reply to the board's second communication.
- XIII. On 21 July 2015, oral proceedings were held before the board, with none of the parties present. The issues still outstanding were the admissibility or the dismissal of the appeal and the apportionment of costs (respondents 2 and 3).

### **Reasons for the Decision**

1. Respondents 2 and 3 requested that the appeal be declared inadmissible.

- 1.1 The respondents argued in particular that the appellant was not adversely affected by the opposition division's decision, because it had never filed any request for rejection of the opposition or maintenance of the patent. Thus there was no request from the appellant that was refused by the opposition division.

The board does not find the respondents' argument persuasive. It is inherent to opposition proceedings that the proprietor requests maintenance of the patent as granted (or as amended, if amended claims are filed), unless it withdraws its approval of the text of the patent during the opposition proceedings. Thus, to the extent that the contested patent was revoked, the appellant was adversely affected (see also T 2468/12, point 1.3.2).

- 1.2 The respondents furthermore argued that the appeal was inadmissible since none of the claim requests filed with the statement of grounds of appeal was admissible.

The board does not find this argument persuasive either. Rule 99(1)(c) EPC merely requires the notice of appeal to contain a request defining the subject of the appeal; this request does not however have to be admissible in order for the appeal to be admissible (see T 134/11, point 1.3).

- 1.3 It follows, as already pointed out in the board's communication of 2 February 2015, that the appeal is admissible.

2. Article 113(2) EPC requires that the EPO decide upon the European patent only in the text submitted to it, or agreed by the proprietor of the patent.



- 2.1 The appellant no longer approves the text of the claim requests pending in the present appeal proceedings (points IX and X above).
- 2.2 In such a situation, a substantive requirement for allowing the appeal is lacking and the proceedings are to be terminated by a decision ordering the dismissal of the appeal, without going into the substantive issues.
3. The only remaining issue is thus the request of respondents 2 and 3 for an apportionment of costs.
  - 3.1 The respondents argued that because the appellant had remained completely inactive throughout the opposition proceedings, the appeal or at least the claim requests filed with the appeal were inadmissible. In their view, the appellant's conduct had made it necessary for them to provide arguments on both the admissibility of the appeal and the claim requests and the allowability of these requests (e. g. as regards their novelty). Either the work on the admissibility issues or the work on the allowability issues had been unnecessary and hence there had been unnecessary expenses in preparing one or the other part of these arguments. In fact no work on admissibility issues would have been necessary at all, had the appellant played an active part in the opposition proceedings. The appellant's behaviour had been at odds with "the standard conduct of oppositions". Respondent 2 cited Article 16(1)(e) RPBA in this respect.
  - 3.2 However, the fact that part of the respondents' work might have been unnecessary in retrospect is not a reason for any apportionment of costs. It is common practice for opponents to present alternative attacks

(such as against admissibility and novelty) in appeal proceedings and it is inherent to multiple attacks that, if one of them is found convincing by the board, all the others become unnecessary in retrospect.

3.3 The board however acknowledges that the respondents' discussion of the admissibility of the appeal and claim requests was triggered by the fact that the appellant had remained inactive during the opposition proceedings. It therefore seems to be correct that the work on these admissibility issues became necessary due to the way the appellant conducted the proceedings. The board does not however share the respondents' view that this justifies an apportionment of costs against the appellant.

3.3.1 Firstly, there is no legal obligation under the EPC for a patent proprietor to take an active part in opposition proceedings. The EPC also does not preclude the proprietor from filing in such a case, an appeal against a negative decision of the opposition division. This possibility to file an appeal should not be restricted, even implicitly, by the threat of an apportionment of costs.

3.3.2 Secondly, the board does not share respondent 2's view that remaining inactive during opposition proceedings and filing new claim requests only at the appeal stage constitutes in itself an abuse of procedure which pursuant to Article 16(1)(e) RPBA justifies an apportionment of costs. In fact, another sanction against this way of conducting the proceedings is available, namely non-admission of the new claim requests under Article 12(4) RPBA.

3.3.3 Thirdly, had the appellant participated actively in the opposition proceedings, other issues might have arisen, and although the respondents might then not have had to work on admissibility issues, they might well have incurred work and expenses due to these other issues instead.

3.3.4 Fourthly, the appellant's timely withdrawal of its approval of the text has prevented even more costs for the respondents.

3.3.5 In these circumstances it is not equitable to apportion costs against the appellant (Article 104(1) EPC).

## **Order**

### **For these reasons it is decided that:**

1. The appeal is dismissed.
2. The requests for an apportionment of costs are refused.

The Registrar:

The Chairman:



I. Aperribay

W. Sieber

Decision electronically authenticated