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**Datasheet for the decision
of 9 March 2017**

Case Number: T 1311/15 - 3.3.10

Application Number: 09773598.9

Publication Number: 2324092

IPC: C09K5/04

Language of the proceedings: EN

Title of invention:

REFRIGERANT COMPOSITION COMPRISING 1,1,1,2-TETRAFLUOROETHANE
(HFC134a) AND 2,3,3,3-TETRAFLUOROPROPENE (HFO1234yf)

Patent Proprietor:

Daikin Industries, Ltd.

Opponents:

Arkema France
Mexichem Amanco Holding S.A. de C.V.
E.I. DUPONT DE NEMOURS AND COMPANY

Headword:

Relevant legal provisions:

EPC Art. 100(b), 111(1)

Keyword:

Grounds for opposition - insufficiency of disclosure (no) -
alleged effect not a feature of the claims
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

T 0197/10, G 0001/03

Catchword:



Beschwerdekammern
Boards of Appeal
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Case Number: T 1311/15 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 9 March 2017

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 April 2015
revoking European patent No. 2324092 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Gryczka
Members: R. Pérez Carlón
 C. Schmidt

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division to revoke European patent No. 2 324 092.
- II. Three notices of opposition had been filed, on the grounds of insufficiency of disclosure (Article 100(b) EPC), and lack of novelty and inventive step (Article 100(a) EPC).
- III. Claim 1 of the main request, which corresponds to the patent as granted, reads as follows:
- "A refrigerant composition comprising 36 to 50 mass% of 1,1,1,2-tetrafluoroethane (HFC134a) and 50 to 64 mass% of 2,3,3,3-tetrafluoropropene (HFO1234yf)."*
- IV. The opposition division concluded *inter alia* that it was an essential feature of the claimed refrigerant composition to be non-flammable. The use of the term "comprising" implied that claim 1 of the patent as granted was not limited to a refrigerant containing only 1,1,1,2-tetrafluoroethane (HFC134a) and 2,3,3,3-tetrafluoropropene (HFO1234yf). As the patent in suit did not teach how to obtain a non-flammable ternary composition, and there was evidence on file that some ternary compositions could be flammable, the division concluded that the invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- V. The arguments of the appellant relevant for the present decision were the following:

Claim 1 did not require the claimed compositions to be

non-flammable and the description provided sufficient examples of compositions within claim 1, so that the invention was sufficiently disclosed for it to be carried out by a person skilled in the art.

Claim 1 of the main request was only directed to binary mixtures, which did not contain any refrigerant in addition to HFC134a and HFO1234yf, and there was sufficient evidence that said binary mixtures were non-flammable. Thus, even if non-flammability were required by the invention, it was sufficiently disclosed for it to be carried out by a person skilled in the art.

VI. The arguments of respondents I to III (opponents 1 to 3) relevant for the present decision were the following:

The ground of opposition under Article 100(b) EPC referred to the "invention" and not to the "claimed invention". The description of the patent in suit made clear that the invention related to providing non-flammable refrigerant compositions.

Claim 1 of the patent as granted was not limited to binary mixtures and, even if it were, document D5 showed that binary compositions according to claim 1 were flammable. For that reason, the invention was not sufficiently disclosed, and the ground under Article 100(b) EPC precluded the maintenance of the patent as granted.

Respondent II argued that claim 1 was too broad and lacked sufficient support in the description, which was also an issue under Article 100(b) EPC.

VII. The board informed the parties with a communication dated 15 November 2016 that it tended to consider that claim 1 of the patent as granted merely required the claimed composition to be suitable as a refrigerant, but not to be non-flammable. For that reason, the sole issue under Article 100(b) EPC was whether the skilled person had sufficient information available to be able to obtain compositions having the specified relative amounts of the required components, which seemed to be the case.

The preliminary opinion of the board was that the decision should be set aside and the case remitted to the opposition division for further prosecution on the basis of the patent as granted.

VIII. Respondent I informed the board that it would not be attending the oral proceedings, which took place on 9 March 2017.

IX. The final requests of the parties were the following:

- The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or, subsidiarily, on the basis of one of auxiliary requests 1 to 17, all auxiliary requests filed with the statement setting out the grounds of appeal.
- Respondent I, in writing, and respondents II and III requested that the appeal be dismissed.

X. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

1. The appeal is admissible.

Sufficiency of disclosure

2. Claim 1 is directed to a refrigerant composition comprising defined relative amounts of two components, namely, 36 to 50 mass% of 1,1,1,2-tetrafluoroethane (HFC134a), and 50 to 64 mass% of 2,3,3,3-tetrafluoropropene (HFO1234yf).
3. The conclusion of the opposition division that the invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art was based on the following reasoning:
 - Due to the use of the wording "comprising", claim 1 of the patent as granted was not limited to a binary refrigerant composition, i.e. a refrigerant containing only 1,1,1,2-tetrafluoroethane (HFC134a) and 2,3,3,3-tetrafluoropropene (HFO1234yf) as the sole refrigerants.
 - According to the description of the patent in suit, it was an essential feature of the invention that the claimed refrigerant composition should be non-flammable.
 - There was evidence on file that at least some ternary compositions could be flammable.
 - The patent in suit did not provide information enabling the skilled person to obtain non-flammable ternary compositions, with the consequence that the

invention was not sufficiently disclosed for it to be carried out by a person skilled in the art.

4. Presence of further components in the compositions according to claim 1
 - 4.1 The appellant argued that claim 1 should be read in the light of the description, which did not make any reference to further refrigerants, and of the examples, which only referred to binary mixtures. Although further compounds could be part of the claimed compositions, such as those defined in claims 3 to 5, refrigerants other than HFC134a and HFO1234yf were excluded from claim 1.
 - 4.2 According to the case law of the Boards of Appeal, if a claim is worded so clearly and unambiguously as to be understood without difficulty by the person skilled in the art, there is no need to use the description to interpret it (T 197/10, not published in OJ EPO, point 2.3 of the Reasons).

No ambiguity is apparent in the wording used in claim 1, and there is therefore no need to use the description to interpret it. A composition "comprising" various components requires the presence of those components explicitly mentioned, and allows the presence of further components. The appellant is attempting to read into the claimed compositions limitations which are not a feature of claim 1.

Thus, the wording of claim 1 does not exclude the presence in the claimed composition of up to 14% of further components in addition to HFC134a and HFO1234yf, irrespective of whether or not said

components are refrigerants.

5. Non-flammability as a feature of the invention

5.1 The parties did not dispute that claim 1 does not include any flammability requirement in its wording. Consequently, "non-flammability" is not a feature of the claims.

It is however also undisputed that the invention underlying the patent aims at providing non-flammable refrigerant compositions, see for example paragraphs [0006], [0008] and [0009] of the patent in suit.

5.2 The question arises whether when examining the ground of opposition under Article 100(b) EPC that "an European patent does not disclose the invention in a manner sufficiently clear for it to be carried out by a person skilled in the art", the intended effect of the claimed subject-matter should be taken into account.

It is however well-established case law of the Boards of Appeal that an objection of insufficient disclosure cannot legitimately be based on an argument that the patent does not enable a skilled person to achieve a technical effect which is not defined in the claim (Case Law of the Boards of Appeal, 8th Edition 2016, II.C.2, last two paragraphs)

Thus, notwithstanding the fact that the present invention aims at obtaining non-flammable compositions, since this effect is not a feature of the claims it cannot be taken into account when examining whether or not the refrigerant composition comprising defined relative amounts of HFC134a and HF01234yf is

sufficiently disclosed.

6. Sufficiency of disclosure

The question whether some compositions according to claim 1 could be flammable does not have any bearing on the sufficiency of the disclosure of the patent in suit (see above).

The respondents have not argued that the claimed compositions could not be obtained and there are sufficient examples of said compositions in the patent in suit.

The respondents have not argued, either, that a composition comprising the relative amounts of HFC134a and HFO1234yf defined in claim 1 would not be a refrigerant, which is a requirement of said claim. As HFC134a and HFO1234yf are known refrigerants and represent at least 86 mass% of the claimed composition, there is no apparent reason why said compositions would not have refrigerant properties.

The skilled person would thus not have any difficulty in obtaining the claimed refrigerant compositions comprising 36-50 mass% of HFC134a and 50-64 mass% of HFO1234yf.

For these reasons, the invention is sufficiently disclosed for it to be carried out by a person skilled in the art, with the consequence that the ground under Article 100(b) EPC does not preclude the maintenance of the patent as granted.

6.1 Respondent II has argued that the claimed refrigerant compositions lacked support insofar as they referred to

flammable refrigerant compositions, and that the scope of claim 1 was too broad with respect to the data provided.

However, none of these arguments is relevant to sufficiency of disclosure. The requirement that the description provides support for the claims is laid down in Article 84 EPC, which is not a ground for opposition.

Remittal

7. Since the decision under appeal has not dealt with all the grounds for opposition, the board considers it appropriate to remit the case to the opposition division for further prosecution on the basis of the claims according to the main request (Article 111(1) EPC). None of the parties objected to such remittal.

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 on the basis of the main request.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated