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**Datasheet for the decision
of 7 May 2019**

Case Number: T 0507/18 - 3.3.03

Application Number: 12150099.5

Publication Number: 2441804

IPC: C08L95/00, C08J3/02, C08J11/04,
E01C5/12, E01C7/18, C04B26/26

Language of the proceedings: EN

Title of invention:

Water-in-oil bitumen dispersions and methods for producing paving compositions from the same

Patent Proprietor:

Ingevity South Carolina, LLC

Opponent:

Akzo Nobel Chemicals International BV

Headword:

Water-in-oil bitumen dispersions/INGEVITY

Relevant legal provisions:

EPC Art. 104(1)
RPBA Art. 16(1)

Keyword:

Apportionment of costs - (no)



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Case Number: T 0507/18 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 7 May 2019

Appellant: Ingevity South Carolina, LLC
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Respondent: Akzo Nobel Chemicals International BV
(Opponent) Velperweg 76
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Representative: Akzo Nobel Chemicals IP Group
Velperweg 76
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 20 December
2017 revoking European patent No. 2441804
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman D. Semino
Members: O. Dury
C. Brandt

Summary of Facts and Submissions

- I. The patent proprietor (appellant) filed an appeal against the decision of the opposition division revoking patent EP 2441804.
- II. In its reply to the statement of grounds of appeal the opponent (respondent) requested i.a. that the appeal be rejected as inadmissible and that the costs made in opposition and appeal proceedings be reimbursed. The opposition division had already rejected the opponent's request for apportionment of costs, since there was no irresponsible or malicious conduct of the patent proprietor. The respondent disagreed with this decision, because in its view the appellant was knowingly trying to have the EPO issue two patents for the same subject-matter and therefore had no legitimate interest in pursuing the patent in suit.
- III. The Board's communication according to Article 15(1) RPBA of 30 November 2018 contained the following passages with regard to the respondent's request for apportionment of costs:

"8.2 The respondent further put forward objections related to double patenting (letter of 14 September 2018: bottom of page 1) regarding the subject-matter claimed in the patent in suit and in the grand-parent case (patent dealt with in T 453/16). Considering that all but claim 19 of the pending claims in T 453/16 are directed to bituminous compositions comprising a "solvent-free water-in-oil dispersion", which is not the case for the claims of the present case, it appears that this issue may only be possibly relevant in view of claim 1 of the main request filed with letter of 7 September 2017 and claim 19 of the patent based on the

grand-parent application (dealt with in T 453/16). However, double patenting is not a ground of opposition (see Case Law of the Boards of Appeal of the EPO, 2016, 8th edition, II.F.5, in particular section 5.2). Besides, since both the patent of the present case and the one dealt with in T 453/16 were revoked, there can be at present no issue of double patenting (even noting that it seems that a further divisional application EP 15 015 474 is still in the examination phase). Therefore, for the moment, the objection does not appear relevant. The issue may, however, have to be discussed at the oral proceedings."

"14. Apportionment of costs

14.1 The respondent requested an apportionment of costs because he considers that the appellant seeks to get two patents for the same subject-matter (middle of page 2 of the rejoinder to the statement of grounds of appeal). The respondent argued that the appellant knowingly misuses EPO procedures by pursuing claims that were already granted in an earlier patent and that the appellant was trying to get two patents for the same subject-matter (rejoinder to the statement of grounds of appeal: page 2, section "Reimbursement of costs").

14.2 However, it appears that the subject-matter defined in the operative claims in each of the cases T 453/16 (grand-parent application), T 89/18 (first divisional or parent application) and T 507/18 (divisional of the first divisional application) is not identical. Therefore, the respondent's does not appear convincing.

14.3 In view of the above, the preliminary non-binding opinion of the Board is that there is no evidence that the appellant deliberately abused the proceedings. Under those circumstances, it appears that there is no

reason to grant a different apportionment of costs than that foreseen in Article 104 EPC and/or Article 16 RPBA."

- IV. The respondent replied to the Board's communication with letter dated 28 February 2019 and maintained its request to reject the appeal as inadmissible, since the appellant had no legitimate interest in the appeal.
- V. With letter of 10 April 2019 the appellant withdrew the appeal.
- VI. With communication of 16 April 2019 the Board informed the respondent of the withdrawal of the appeal and requested the respondent to indicate unambiguously if it maintained its request for apportionment of costs. The Board further pointed out that if said request should not be unequivocally withdrawn, the oral proceedings scheduled on 7 and 8 May 2019 would be maintained. In this respect the Board indicated that in the absence of any further arguments put forward by the parties, there was no reason to deviate from its (negative) provisional opinion in the communication of 30 November 2018.
- VII. With letter dated 2 May 2019 the proprietor submitted arguments against the apportionment of costs requested by the opponent.
- VIII. With letter of 3 May 2019 the opponent maintained its request for apportionment of costs, since the proprietor had forced the opponent to make costs in preparation and handling of the opposition and appeal, even though there was no legitimate interest in filing and pursuing the patent (application).

IX. The respondent requested in writing the reimbursement of costs made in the opposition and appeal proceedings.

The appellant requested in writing that the request for apportionment of costs be rejected.

X. Oral proceedings took place on 7 May 2019. None of the parties attended the oral proceedings, as announced. At the end of the oral proceedings the Chairman announced the decision as indicated below.

Reasons for the Decision

Subject-matter of the appeal proceedings

1. In consequence of the withdrawal of the appeal by the sole appellant the appeal proceedings are, as far as substantive issues are concerned, terminated and the sole remaining issue to be decided upon is the respondent's request for apportionment of costs.

Apportionment of costs

2. Pursuant to Article 104(1) EPC, each party to opposition proceedings must, as a rule, meet the costs it has incurred. However, the opposition division or a board of appeal may, for reasons of equity, order a different apportionment of the costs incurred during opposition or appeal proceedings. At the appeal stage Article 16(1) RPBA also applies, allowing the board, subject to Article 104(1) EPC, to order a different apportionment, e.g. in case of abuse of procedure (Article 16(1)(e) RPBA).

In the present case the requirements for an apportionment of costs to the detriment of the appellant/patent proprietor are not met.

3. In its communication according to Article 15(1) RPBA of 30 November 2018 the Board provided reasons why double patenting cannot be assumed in the present case and indicated that there was no evidence that the appellant deliberately abused the proceedings (point III. above). The respondent did not comment on the Board's opinion, let alone provided any argument suitable to overcome the objections raised against the requested apportionment of costs.
4. In its letter dated 28 February 2019 the respondent argued only with regard to the admissibility of the appeal when asserting that the appellant had no legitimate interest in the appeal, which relates to a separate and different objection of the respondent against the appeal. The respondent's general allegation in its letter dated 3 May 2019 that the proprietor had forced the opponent to make costs in preparation and handling of the opposition and appeal, even though there was no legitimate interest in filing and pursuing the patent (application), can also not be regarded as an appropriate, concrete and substantiated response to the Board's concerns as mentioned in the communication of 30 November 2018.
5. Regarding this legal and factual situation and as indicated in its communication dated 16 April 2019 the Board, having reconsidered the case, had no reason to deviate from its preliminary opinion that no abuse of procedure by the appellant can be established. Therefore, the request of apportionment of costs (Article 16(1)(e) RPBA) had to be rejected.

Order

For these reasons it is decided that:

1. The appeal proceedings are terminated.
2. The request of the respondent for apportionment of costs made in the opposition and appeal proceedings is rejected.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated