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**Datasheet for the decision
of 2 May 2023**

Case Number: T 1045/19 - 3.3.04

Application Number: 11164849.9

Publication Number: 2371382

IPC: A61K39/12

Language of the proceedings: EN

Title of invention:

Use of a PCV2 immunogenic composition for lessening clinical symptoms in pigs

Patent Proprietor:

Boehringer Ingelheim Animal Health USA Inc.

Opponents:

Intervet International BV (opposition withdrawn)
Eli Lilly and Company
Laboratorios Hipra, S.A.

Headword:

Single dose administration/BOEHRINGER INGELHEIM

Relevant legal provisions:

EPC Art. 101, 104(1), 113(2)
RPBA 2020 Art. 16

Keyword:

Basis of decision - text or agreement to text withdrawn by
patent proprietor
Apportionment of costs - (no)

Decisions cited:

T 0073/84, T 1781/13, T 0454/15, T 0467/15, T 0040/17



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1045/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 2 May 2023

Appellant: Boehringer Ingelheim Animal Health USA Inc.
(Patent Proprietor) 3239 Satellite Blvd
Duluth, GA 30096 (US)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Respondent I: Eli Lilly and Company
(Opponent 2) Lilly Corporate Center
Indianapolis, IN 46285 (US)

Representative: Potter Clarkson
Chapel Quarter
Chapel Bar
Nottingham NG1 6HQ (GB)

Respondent II: Laboratorios Hipra, S.A.
(Opponent 3) Avda. La Selva, 135
17170 Amer (ES)

Representative: Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 4 February 2019
revoking European patent No. 2371382 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chair	R. Morawetz
Members:	A. Chakravarty
	F. Bostedt

Summary of Facts and Submissions

- I. The patent proprietor (appellant) filed an appeal against the decision of the opposition division revoking the patent. Opponents 2 and 3 are respondent I and respondent II (or "respondents") to this appeal. Opponent 1 has withdrawn its opposition and has ceased to be a party to the appeal as regards substantive issues.
- II. With its statement of grounds of appeal, the appellant requested, *inter alia*, that the decision under appeal be set aside and that the patent be maintained as granted (main request) or alternatively that the patent be maintained on the basis of the set of claims of auxiliary requests 1 to 18.
- III. The respondents' request was *inter alia* that the appeal be dismissed.
- IV. The board issued a summons to oral proceedings, as requested by all parties, and in a subsequent communication pursuant to Article 15(1) RPBA 2020, provided its preliminary appreciation of the appeal case.
- V. By letter of 18 November 2022, respondent I announced that "*in the event that the appellant does not withdraw its appeal by 20 December 2022, we shall request an award of costs for the time spent preparing for, and attending, the oral proceedings on 10 January 2023.*"
- VI. By letter of 9 December 2022, the appellant made a written submission in the appeal. In this submission it withdrew all previously filed claim requests (the main

request and auxiliary requests 1 to 18) and replaced them with a newly filed main request and auxiliary request 1. The appellant also filed a new document (D170).

- VII. The board issued a further communication, dated 16 December 2022, addressing the admittance of the new claim requests filed by the appellant.
- VIII. By letter of 21 December 2022, the appellant informed the board that it no longer approved the text of the patent as granted, that it would not pursue any of its pending requests on file, including the auxiliary claim requests, and that it would not propose any amended text. It further withdrew its request for oral proceedings.
- IX. The board cancelled the oral proceedings on the same day.
- X. Also by letter dated 21 December 2022, respondent I replied to the appellant's submission of 9 December 2022 and to its filing of new auxiliary requests. In this letter respondent I requested an award of costs according to Article 16(1)(c) and/or Article 16(1)(e) for the reasons set out in their letter of 18 November 2022 and furthermore requested an award of costs under Article 16(1)(a) RPBA for time spent considering the appellant's late filed claim requests, arguments and new document (D170).
- XI. The board issued a communication dated 9 January 2023 concerning respondent I's request for a different apportionment of costs. It gave its preliminary view that no different apportionment of costs would be ordered. Respondent I was furthermore requested to

inform the board if it maintained its request for oral proceedings in order to be heard on this issue alone.

- XII. Respondent I replied to the board's communication with a letter dated 10 January 2023. In this letter the respondent maintained only the request for an award of costs under Article 16(1)(a) RPBA, first made in the letter of 21 December 2022, on the basis of a very late amendment to the appellant's case according to Article 13 RPBA. The request specifically related to costs incurred in the period 12 December to 21 December 2022, amounting to £2,004.20. While some of this was said to be attributable to communications concerning, for example, the change from in-person proceedings to ViCo, it was considered that £1,700 could be attributed to the need to assess the new claim requests and new document (D170) and the board's consequent communication, including the preparation of the letter of 21 December 2022, objecting to the change in the appellant's case. An award of costs of £1,700 (or the equivalent in Euros) was therefore requested. Oral proceedings were not requested to discuss this matter.
- XIII. In response to respondent I's request for a different apportionment of costs the appellant stated by letter dated 16 January 2023 that they were of the view that no such request was justified and that this request should not be granted.
- XIV. The board issued a communication pursuant to Rule 100(2) EPC in which it set out the reasons why it intended to refuse respondent I's request for apportionment of costs. No replies to this communication were received in due time.

Reasons for the Decision

1. The appeal is admissible.
2. Pursuant to the principle of party disposition established by Article 113(2) EPC, the EPO shall examine, and decide upon, the European patent only in the text submitted to it, or agreed, by the proprietor of the patent.
3. Such an agreement cannot be deemed to exist where - as in the present case - the patent proprietor expressly states that it no longer approves the text of the patent as granted and withdraws all pending claim requests.
4. According to the case law of the boards of appeal, in these circumstances the proceedings are to be terminated by a decision ordering revocation of the patent under Article 101 EPC without assessing issues relating to patentability (see decision T 73/84, OJ EPO 1985, 241, and Case Law of the Boards of Appeal of the European Patent Office, 10th edition 2022, III.B.3.3). In the case at hand, where the patent had already been revoked by the opposition division and, as correctly pointed out in decision T 454/15 (see Reasons 6), cannot be revoked again, the effect of the appellant's declaration is that the appeal has to be dismissed.
5. Revocation of the patent is also the main request of respondent I.

Costs (Article 104(1) EPC and Article 16(1), second sentence, (a) RPBA 2020)

6. Respondent I's request for a different apportionment of costs relates to costs arising due to having to respond to the appellant's late change of case, being the withdrawal of the previously pending claim requests and the filing of replacement claim requests shortly before the scheduled oral proceedings.

7. The appellant's submission of 9 December 2022 may indeed be considered an amendment of its appeal case within the meaning of Article 13(1) and (2) RPBA 2020 and would thus also fall under Article 16(1), second sentence, (a) RPBA 2020. However, the wording of Article 16(1) RPBA 2020 does not regulate in which cases a different apportionment of costs is justified; rather, it lists situations for which specific costs may be included in the apportionment. Indeed, the question of whether a different apportionment of costs is warranted is governed by Article 104(1) EPC which requires that, in order to find an exception to the rule that each party bears the costs it has incurred, "reasons of equity" must exist. It follows that the mere fact that an amendment of a party's appeal case is present does not mean that a different apportionment of costs must be ordered. It remains at the discretion of the board (see Article 16(1), second sentence, RPBA 2020) to order a different apportionment of costs taking into account the criterion of equity stipulated in Article 104(1) EPC.

8. The board considers that the late filing of claim requests alone (and the filing of a new document) does not, as such, justify such apportionment for reasons of equity. Instead, additional circumstances are needed

for equity to dictate ordering a party to pay the other's costs because it had amended its case at a late stage (see T 1781/13, Reasons 14.2.1; T 467/15, Reasons 5.3). It is for the party requesting a different apportionment to put forward such additional circumstances and to demonstrate that they warrant an exception to the other above-mentioned rule that each party must bear its own costs. The party must show, for example, that the other party has neglected the level of care towards the requesting party that can be reasonably expected of it (see T 40/17, Reasons 5). The reasons put forward by respondent I are not sufficient in this respect.

9. In the circumstances of the present case, the board does not consider a different apportionment of costs for reasons of equity to be warranted.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for apportionment of costs is refused.

The Registrar:

The Chairwoman:



I. Aperribay

R. Morawetz

Decision electronically authenticated