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**Datasheet for the decision
of 17 December 2024**

Case Number: T 0285 / 22 - 3.3.10

Application Number: 10011063.4

Publication Number: 2258802

IPC: C09K5/04

Language of the proceedings: EN

Title of invention:

Compositions containing fluorine substituted olefins

Patent Proprietor:

Honeywell International Inc.

Opponent:

Mexichem Fluor S.A. de C.V.

Headword:

Relevant legal provisions:

EPC Art. 100(c)

Keyword:

Grounds for opposition - added subject-matter (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0285/22 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 17 December 2024

Appellant: Mexichem Fluor S.A. de C.V.
(Opponent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 24 November 2021 rejecting the opposition filed against European patent No. 2258802 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chair A. Zellner

Members: R. Pérez Carlón

F. Blumer

Summary of Facts and Submissions

- I. The appellant (opponent) appealed against the decision of the opposition division rejecting its opposition against European patent No. 2 258 802, filed on grounds which included that of added subject-matter (Article 100(c) EPC).
- II. The opposition division concluded that the features of claim 1 of the patent as granted had a basis in the application as originally filed and in the earlier applications in accordance with Article 76 EPC.
- III. Claim 1 of the patent as granted reads as follows:

"Use of a composition consisting essentially of trans-1,1,1,3-tetrafluoropropene (trans-HFO-1234ze) as a replacement refrigerant for HFC-134a, in a chiller."

Claim 1 of auxiliary request 1 requires the chiller to be used in connection with commercial air conditioning systems.

Claim 1 of auxiliary request 2 has the features of claim 1 of the main request and requires the composition to have a Global Warming Potential not greater than a set threshold.

Lastly, claim 1 of auxiliary request 3 has the features of claim 1 of auxiliary requests 1 and 2.

- IV. The appellant argued that the claimed subject-matter resulted from a selection of two independent lists and thus lacked the required basis. In addition, the type of chillers required by claim 1 was not disclosed in

the application as originally filed, and there was no unambiguous link between the compositions for use as replacement of HFC-134a on page 11, lines 23 and 24, and the type of devices on page 12, lines 8 to 12 of the application as originally filed.

V. The respondent saw the passages in the preceding point as a basis for the claimed subject-matter. Only one selection was required, namely that of a chiller among the devices on page 12. Page 11, lines 23 and 24 disclosed the link between the compositions in claim 1 and the refrigerant to be replaced, namely HFC-134a.

VI. Oral proceedings before the board of appeal took place on 17 December 2024.

VII. The parties' final requests were as follows:

The appellant requested that the decision under appeal be set aside and that the European patent No. 2 258 802 be revoked.

The respondent requested that the appeal be dismissed or that the patent be maintained with the claims of one of the first, second and third auxiliary requests, all the requests as filed with the reply to the grounds of appeal.

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

Reasons for the Decision

1. The appeal is admissible.

2. Claim 1 of the main request relates to the use of a composition consisting essentially of trans-1,1,1,3-tetrafluoropropene (trans-HFO-1234ze) as a replacement refrigerant for HFC-134a, in a chiller.
3. As a basis for the features of claim 1, the respondent relied on the passages on page 11, lines 23 and 24 and on page 12, lines 8 to 12, as follows:

Page 11, lines 23 and 24 of the application as originally filed disclosed a composition consisting essentially of trans-HFO-1234ze as a replacement for existing refrigerants such as HFC-134a.

Page 12, lines 8 to 12, disclosed that the compositions in the application were adaptable for use in connection with a number of applications, including chillers (page 12, line 10).

In addition, the first paragraph on page 12 provided a pointer towards the claimed subject-matter.

4. The board concluded that these passages do not provide a basis for the features of claim 1.

Claim 1 does not require chillers in general, but of a special kind, namely chillers suitable to be used with HFC-134a. According to page 11, lines 10 to 13, replacing one refrigerant by another may require system modification. There is thus a link between the refrigeration system and the refrigerant it may use so that not every chiller is necessarily a chiller suitable to be used with HFC-134a.

By disclosing the link between chillers and refrigerant HFC-134a claim 1 contains technical information

(chillers which use HFC-134a) which is not present in the application as originally filed.

The ground for opposition in Article 100(c) EPC thus precludes the maintenance of the patent as granted.

5. The respondent argued that the subject-matter of claim 1 arose from a single selection among the kinds of systems on page 12, lines 8 to 12 of the application as originally filed. The passage at the beginning of page 12 disclosing compositions comprising HFO-1234ze in the context of chillers should in addition provide a pointer towards the claimed subject-matter.

However, such alleged single selection does not disclose the kind of chillers required in claim 1, namely those suitable to be used with HFC-134a. The first paragraph on page 12 discloses a different kind of chillers, namely those suitable to be used with R-12 and R-500 and neither discloses nor points at chillers suitable for use with HFC-134a, as required by claim 1.

6. The parties argued in detail on whether the claimed invention arose from a selection from only one list or else a selection from multiple lists.

Fitting a case into one or more lists can be useful in some cases for showing the presence or absence of a specified combination. The standard is however whether the claimed subject-matter is clearly and unambiguously disclosed, in combination. The board considers it not to be the case for the reasons in the preceding point, regardless of how many assumed lists could be construed in the present case. The missing disclosure is the link between chillers and HFC-134a.

7. The respondent also argued that the systems on page 12, lines 8 to 12, could be combined with every composition of the claimed invention.

However, combining the devices on page 12 with the composition in claim 1 consisting essentially of trans-HFO-1234ze does not require the specific type of chillers which use HFC-134a required by claim 1.

8. As claim 1 contains added subject-matter, the ground for opposition in Article 100(c) EPC precludes the maintenance of the patent as granted.

9. Claim 1 of auxiliary request 1 requires the chiller to be used in connection with commercial air conditioning systems. This kind of chiller is disclosed on page 12 only in the context of chillers to be used with R-12 and R-500. This feature thus does not solve the issue of added subject-matter explained in the preceding points. Auxiliary request 1 is thus not allowable.

10. Auxiliary requests 2 and 3 respectively require the compositions in claim 1 of the patent as granted and of auxiliary request 1 to have a Global Warming Potential below a set threshold. By the respondent's own argument the amendment does not address the issue of added subject-matter. These requests are not allowable for the same reasons as the higher ranked requests.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The patent is revoked.

The Registrar:

The Chair:



C. Rodríguez Rodríguez

A. Zellner

Decision electronically authenticated