

Claim No. HP-2019-000021

**IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS
OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)
PATENTS COURT**

B E T W E E N:

MEXICHEM UK LIMITED

Claimant

and

HONEYWELL INTERNATIONAL INC

**(a company incorporated under the laws of the State of Delaware,
USA)**

Defendant

STATEMENT OF GROUNDS FOR AMENDMENT

The following are the grounds on which the Defendant seeks conditionally to amend European Patent EP (UK) 3 170 880 ("**EP 880**") pursuant to Section 75(1) of the Patents Act 1977. Forms of the proposed amendments to EP 880 are show in red in underline/strike-through below.

1. Amendment is sought to EP 880 comprising the introduction of two new dependent claims each of which claims a subset of the subject matter claimed in claim 1, as follows:

1. Use as a refrigerant composition, of a composition comprising 1,3,3,3-tetrafluoropropene (HFO-1234ze) or 2,3,3,3-tetrafluoropropene (HFO-1234yf), and a lubricant selected from polyol esters and polyalkylene glycols.

2. The use according to claim 1, wherein the lubricant is selected from polyol esters.

3. The use according to claim 1, wherein the lubricant is selected from polyalkylene glycols.

2. In addition, the existing claims would be re-numbered and new claims 4 and 6 (corresponding to claims 2 and 4 of EP 880 as granted) would have their dependency changed so as to be dependent on claim 1 or the two new dependent claims 2 and 3:

~~24~~. The use according to claim 1, claim 2 or claim 3, wherein the HFO-1234ze or HFO-1234yf is present in an amount of at least 50 wt% of the refrigerant composition.

~~35~~. The use according to claim ~~24~~, wherein the HFO-1234ze or HFO-1234yf is present in an amount of at least 70 wt% of the refrigerant composition.

~~46~~. The use according to claim 1, claim 2 or claim 3, wherein the lubricant is present in an amount of from 30 to 50 wt% of the refrigerant composition.

~~57~~. The use according to any preceding claim, wherein the refrigerant composition has as Global Warming Potential (GWP) of not greater than 150, more preferably not greater than 100 and even more preferably not greater than 75.

~~68~~. The use according to any preceding claim, in a refrigeration, air conditioning, or heat pump system.

~~79~~. Use as a refrigerant composition, of a composition comprising 1,3,3,3-tetrafluoropropene (HFO-1234ze) or 2,3,3,3-tetrafluoropropene (HFO-1234yf) and a lubricant selected from polyol esters and polyalkylene glycols, wherein the HFO-1234ze or HFO-1234yf is present in an amount of at least 50% of the refrigerant composition.

3. These conditional amendments are sought only in the event that the Court should determine that the claims as granted are invalid. The Defendant contends that the claims of EP 880 as granted are valid.

4. The amendments sought are supported by the disclosure of EP 880 and do not result in the specification of EP 880 disclosing additional matter. Further, the amendments sought do not extend the protection conferred by EP 880. Accordingly the amendments sought comply with the provisions of the Patents Act 1977 and in particular Section 76 thereof.

Statement of Truth

The Defendant believes that the facts stated in this Statement of Grounds for Amendment are true. I understand that proceedings for contempt of court may be brought against anyone who makes, or causes to be made, a false statement in a document verified by a statement of truth without an honest belief in its truth.

I am duly authorised by the Defendant to sign this statement.

Signed:

Eleanor Root
Partner, Bird & Bird LLP

Served this 30th day of July 2020 by Bird & Bird LLP, 12 New Fetter Lane, London EC4A 1JP, solicitors for the Defendant