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D E C I S I O N
of 10 May 2006

Case Number: T 0868/04 - 3.3.10

Application Number: 98958505.4

Publication Number: 1029017

IPC: C09K 5/00

Language of the proceedings: EN

Title of invention:
Silicate free antifreeze composition

Applicant:
Ashland Inc.

Opponent:
-

Headword:
Antifreeze compositions/ASHLAND

Relevant legal provisions:
EPC Art. 54, 111(1), 123(2)

Keyword:
"Main request: Amendments (not allowable) - added subject-matter"
"First auxiliary request: Amendments (not allowable) - added subject-matter - disclaimer based on non-accidental anticipation - disclaimer based on embodiment specifically disclosed as forming part of the invention"
"Second auxiliary request: Amendments (allowable) - no added subject-matter"
"Novelty (yes)"
"Remittal - outstanding issues"

Decisions cited:
G 0010/93, G 0001/03, T 0288/92, T 0680/93

Catchword:

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Case Number: T 0868/04 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 10 May 2006

Appellant: Ashland Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 February 2004
refusing European application No. 98958505.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
D. Rogers

Summary of Facts and Submissions

- I. The appeal lodged on 26 April 2004 lies from the decision of the Examining Division dated 17 February 2004 refusing European application No. 98958505.4 with the European publication No. 1 029 017 and international publication No. WO 99/24524.
- II. The decision of the Examining Division was based on five requests. The Examining Division found that the subject-matter of the then pending main, first, third and fourth auxiliary requests lacked novelty (Article 54 EPC), and that the second auxiliary request contained subject-matter which extended beyond the content of the application as filed, thus contravening the provisions of Article 123(2) EPC.

The Examining Division held in particular that the compositions claimed according to the then pending main, first, third and fourth auxiliary requests were anticipated by two or more of the following documents:

- (2) EP-A-0 564 721;
- (3) US-A-5 366 651;
- (4) US-A-4 561 990 and
- (5) US-A-4 851 145.

- III. In a communication dated 9 February 2006 pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board indicated that the original disclosure for a large number of the amendments made to the claims filed with the Statement of the Grounds of Appeal appeared to be missing (Article 123(2) EPC).

IV. With a letter dated 2 May 2006, the Appellant (Applicant) submitted a main request and a first auxiliary request, and at the oral proceedings before the Board held on 10 May 2006, the Appellant submitted a second auxiliary request, these requests superseding any previous request. The main request comprised a set of ten claims, independent claim 1 reading as follows:

"1. A silicate free antifreeze corrosion inhibited antifreeze composition for use in the cooling system of a water cooled internal combustion engine comprising an inhibitor combination consisting essentially of:

- a. a major amount of a water soluble liquid alcohol freezing point depressant;
- b. from 1.0 to 10.0 weight percent of a linear aliphatic monobasic carboxylic acid compound;
- c. from 0.01 to 5.0 weight percent of an azole compound selected from the group consisting of tolyltriazole, hydrocarbyl triazole, benzotriazole, mercaptobenzothiazole, pyrazoles, isooxazoles, isothiazoles, thiazoles, thiadiazole salts, 1,2,3-tolyltriazole, sodium 2-mercaptobenzothiazole, sodium 2-mercaptobenzimidazole, and combinations thereof; and
- d. from 0.001 to 5.0 weight percent of a molybdate compound."

Claim 1 of the first auxiliary request differed from claim 1 of the main request exclusively in that the expression "consisting essentially of" was replaced with the term "comprising" and by the incorporation of the disclaimer "with the proviso that imidazoles are excluded" at the end of the claim.

The second auxiliary request consisted of a single claim reading as follows:

"1. A silicate free antifreeze corrosion inhibited antifreeze composition for use in the cooling system of a water cooled internal combustion engine consisting of 93.56 weight percent of ethylene glycol, 3.00 weight percent of 2-ethylhexanoic acid, 2.70 weight percent of potassium hydroxide (45%), 0.20 weight percent of sodium molybdate dihydrate, 0.50 weight percent of sodium tolyltriazole (50%), 0.04 weight percent defoamers, whereby the composition has a pH of 8.5."

- V. The Appellant submitted during the oral proceedings before the Board that the amendments found support in the application as filed, and thus complied with the requirements of Article 123(2) EPC. More particularly, although the feature "consisting essentially of" in the main request was not to be found *expressis verbis* in the application as filed, the sentence at page 7, lines 14 to 17 provided a basis therefor. Basis for the disclaimer in claim 1 of the first auxiliary request was to be found at page 8, line 35 of the application as filed which disclosed imidazoles as examples of theazole compound. The specific composition of claim 1 of the second auxiliary request found a basis in Formula "A" in Example 1 on page 12 of the application as filed.
- VI. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request or, subsidiarily, on the basis of the first auxiliary request, both requests submitted on 2 May 2006, or on the basis of the second auxiliary

request submitted at the oral proceedings before the Board.

VII. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Amendments (Article 123(2) EPC)*

2.1 Claim 1 is based on original claims 1 and 10 and on page 8, line 17 of the application as filed. Moreover, the Appellant has introduced into claim 1 the fresh feature "consisting essentially of" in place of the original expression "comprising" at its second occurrence. Such an amendment must be fully examined by the Board as to its compatibility with the provisions of Article 123(2) EPC.

2.2 In order to determine whether or not an amendment offends against Article 123(2) EPC it has to be examined whether technical information has been introduced which a skilled person would not have objectively and unambiguously derived from the application as filed (see decisions T 288/92, point 3.1 of the reasons; T 680/93, point 2 of the reasons; neither published in OJ EPO).

2.3 The Appellant conceded that the feature "consisting essentially of" was not to be found *expressis verbis* in the application as filed, but submitted that the sentence at page 7, lines 14 to 18 which states that the formulation **is** a certain mixture of compounds, provided a basis therefor.

2.4 The Board, however, holds that said sentence cannot provide a basis for the amendment, since it cannot under any circumstances be interpreted to mean that said formulation consists essentially of these components. Thus the compounds disclosed on page 7, lines 14 to 17 represent an exhaustive list of those compounds of which the formulation consists, whereas the expression "consisting essentially of" used in claim 1 as amended allows the formulation to comprise additional non-essential components. Moreover said sentence on page 7 does not specify the presence of the same components as defined in claim 1, *inter alia*, the alcohol component being missing, with the consequence that it cannot support this amendment made to claim 1.

2.5 The Board concludes that claim 1 as amended extends the subject-matter claimed beyond the content of the application as filed, thus contravening the provisions of Article 123(2) EPC. In these circumstances, the Appellant's main request is not allowable and must be rejected.

First auxiliary request

3. *Amendments (Article 123(2) EPC)*

- 3.1 Claim 1 is based on original claims 1 and 10 and on page 8, line 17 of the application as filed. Moreover, the Appellant has introduced into claim 1 the disclaimer "with the proviso that imidazoles are excluded" in order to restore the novelty of the claimed subject-matter over documents (2) and (3), which are pre-published and thus state of the art according to Article 54(2) EPC.
- 3.2 Documents (2) and (3) both relate to an antifreeze concentrate comprising a water soluble liquid alcohol freezing point depressant and a corrosion inhibitor consisting of aliphatic monobasic carboxylic acids or their salts, a hydrocarbyl triazole compound and imidazole.
- 3.3 Therefore, their technical information is not so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken them into consideration when making the invention, such that neither document can be regarded as an accidental anticipation. Consequently, said disclaimer does not fulfil the criteria for the allowability of a disclaimer delimiting a claim from state of the art pursuant to Article 54(2) EPC as set out in the decision G 1/03 of the Enlarged Board of Appeal (OJ EPO 2004, 413).
- 3.4 The Appellant, concurring with the finding of the Examining Division, submitted that basis for the

disclaimer was to be found in the passage on page 8, lines 32 to 36, more particularly line 35, of the application as filed, alleging that said passage provided a basis for both the presence and the absence of imidazoles in the compositions according to the invention.

At page 8, line 32 the azole compounds, i.e. component (c) according to claim 1, are addressed. Starting at line 34, numerous examples of such azole compounds are listed, including imidazoles. Thus, the passage cited by the Appellant addresses the invention and describes particular examples thereof. Hence, this passage directly and unambiguously discloses imidazoles as forming part of the invention, and not as being excluded therefrom. The Board thus holds that the Appellant's allegation that the passage on page 8, lines 32 to 36 of the application as filed is a basis for the exclusion of imidazoles from the invention is in direct contradiction to the fact that said passage discloses imidazoles as being within the scope of the invention. Therefore the disclaimer introduced into claim 1 has no basis in the application as filed.

- 3.5 The Board thus concludes that the disclaimer in claim 1 offends against the requirements of Article 123(2) EPC. The first auxiliary request is therefore not allowable.

Second auxiliary request

4. *Amendments (Article 123(2) EPC)*

- 4.1 The single claim of this request is based on original claim 1, wherein the antifreeze composition is defined

as the specific composition of Formula "A" in Example 1 on page 12 of the application as filed. That this composition is indeed the antifreeze composition is supported by page 18, lines 4 to 5, page 20, lines 2 to 3 and page 23, lines 13 to 14 of the application as filed.

4.2 Therefore, the amendments made to the claim do not generate subject-matter extending beyond the content of the application as filed and the Board concludes that the requirements of Article 123(2) EPC are satisfied.

5. *Novelty*

5.1 Claim 1 is directed to a very specific antifreeze composition. None of the documents (2) to (5) cited in the decision under appeal as anticipating the subject-matter of the then pending requests, disclose a composition having the same components, let alone in the claimed weight percentages. In particular, no specific composition is disclosed in any of these documents which contains sodium molybdate dehydrate.

5.2 Therefore, the Board concludes that the subject-matter of claim 1 is novel within the meaning of Articles 52(1) and 54 EPC.

6. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since substantial amendments have been made to independent claim 1 which amended claim was presented at the oral proceedings before the Board as the second auxiliary request. The

decision under appeal dealt exclusively with amendments which contravened the provisions of Article 123(2) EPC and lack of novelty of claim 1 over the documents cited according to the then pending requests, and did not consider claim 1 in the present form as such a request was never submitted to the first instance. The amendments leading to the fresh claim 1 according to the second auxiliary request, in particular the restriction of the scope of the claim to a single specific composition, have the effect that the reasons given in the contested decision for refusing the present application no longer apply.

Thus, the Board considers that the substantial amendments made by the Appellant remove all the objections on which the decision under appeal was based and that present claim 1 generates a fresh case not yet addressed in examination proceedings and requiring reexamination.

While Article 111(1) EPC gives the Boards of Appeal the power to raise fresh issues in *ex-parte* proceedings where the application has been refused on other issues, proceedings before the Boards of Appeal in *ex-parte* cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), fresh issues normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance.

Under these circumstances, the examination not having been concluded, the Board considers it appropriate to

exercise the power conferred on it by Article 111(1) EPC, to remit the case to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the second auxiliary request submitted at the oral proceedings before the board.

The Registrar:

The Chairman:

C. Moser

R. Freimuth