

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 18 September 2007**

Case Number: T 0033/06 - 3.3.06

Application Number: 99924964.2

Publication Number: 1088045

IPC: C10L 1/14

Language of the proceedings: EN

Title of invention:

Oil compositions

Patentees:

Infineum USA L.P., et al

Opponents:

Clariant Verwaltungsgesellschaft mbH
BASF Aktiengesellschaft

Headword:

Fuel oil composition/INFINEUM

Relevant legal provisions:

EPC Art. 54(3)(4), 87(1), 88(1), 91(1), 123(2)
EPC R. 38(1)(3), 41(1)

Keyword:

"Added subject-matter (yes): The disclaimer removed more than
is necessary to restore novelty"

Decisions cited:

J 0002/92, G 0001/03

Catchword:

-



Case Number: T 0033/06 - 3.3.06

DECISION
of the Technical Board of Appeal 3.3.06
of 18 September 2007

Appellant:
(Opponent I)

Clariant Verwaltungsgesellschaft mbH
Brüningstrasse 50
D-65929 Frankfurt am Main (DE)

Representative:

Jönsson, Hans-Peter
Patentanwälte
von Kreisler Selting Werner
Bahnhofsvorplatz 1 (Deichmannhaus am Dom)
D-50667 Köln (DE)

Party as of right:
(Opponent II)

BASF Aktiengesellschaft
D-67056 Ludwigshafen (DE)

Representative:

Schweiger, Georg
Patentanwälte
Reitstötter, Kinzebach & Partner
Sternwartstrasse 4
D-81679 München (DE)

Respondents:
(Patent Proprietors)

Infineum USA L.P.
1900 East Linden Avenue
P.O. Box 710
Linden, NJ 07036 (US)

Infineum UK Ltd.
Milton Hill
P.O. Box 1 Abingdon
Oxfordshire OX13 6BB (GB)

Representative:

UEXKÜLL & STOLBERG
Patentanwälte
Beselerstrasse 4
D-22607 Hamburg (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 November 2005 concerning maintenance of
European patent No. 1088045 in amended form.

Composition of the Board:

Chairman: P.-P. Bracke
Members: G. Raths
A. Pignatelli
L. Li Voti
J. Van Moer

Summary of Facts and Submissions

I. This appeal is from the interlocutory decision of the Opposition Division concerning maintenance in amended form of European patent No. 1 088 045 which was granted in respect of the application 99 924 964.2, based on International patent application PCT/EP99/03306, filed on 13 May 1999, claiming a priority of 22 May 1998 in GB (9810994), published as WO 99/61562, the grant being announced on 16 October 2002 (Bulletin 2002/42).

II. Claims 1 and 2 of the patent as granted, which contained 22 claims, read:

"1. A fuel oil composition comprising fuel oil having a sulphur content of less than 0.05% by weight and an additive composition obtainable by admixture of:

(b) the product obtainable by the condensation reaction between:

(i) at least one aldehyde or ketone or reactive equivalent thereof, and

(ii) at least one compound comprising one or more aromatic moieties bearing at least one substituent of the formula $-XR^1$ and at least one further substituent $-R^2$, wherein:

X represents oxygen or sulphur,

R^1 represents hydrogen or a moiety bearing at least one hydrocarbyl group having hydrocarbon character, and

R^2 represents a hydrocarbyl group and contains less than 18 carbon atoms when linear, and

(c) at least one oil soluble polar nitrogen compound comprising one or more substituents of the formula $>NR^{13}$ when R^{13} represents a hydrocarbyl group containing 8 to 40 carbon atoms, which substituent or one or more of

which substituents may be in the form of a cation derived therefrom."

"2. The fuel composition claimed in claim 1, further comprising
(a) at least one ethylene polymer."

III. Two notices of opposition were filed against the granted patent, wherein both opponents sought revocation of the patent on the grounds of Article 100(a) EPC for lack of novelty and inventive step (Articles 52(1), 54 and 56 EPC), and opponent II on the ground of Article 100(c) EPC that the subject-matter extends beyond the content of the application as filed (Article 123(2) EPC).

In particular, Opponent I objected that the patent in suit could not take advantage of the priority of the document GB 9810994 because only the cover pages and the odd pages of the priority document were initially available to the public via the online inspection system of the EPO and could be considered to have been filed within the limits required by Rule 38(3) EPC.

Therefore, it contested the validity of the priority of the patent in suit.

IV. Inter alia, the following document was cited during the opposition proceedings:

(3) EP-A-0 857 776.

V. At the oral proceedings before the Opposition Division, the proprietor filed three auxiliary requests. Claim 1 of auxiliary request 3 reads:

"1. The use of
(b) the product obtainable by the condensation reaction between:

- (i) at least one aldehyde or ketone or reactive equivalent thereof, and
- (ii) at least one compound comprising one or more aromatic moieties bearing at least one substituent of the formula $-XR^1$ and at least one further substituent $-R^2$, wherein:

X represents oxygen or sulphur,

R^1 represents hydrogen or a moiety bearing at least one hydrocarbyl group having a carbon atom directly attached to the rest of the molecule and having hydrocarbon character, and

R^2 represents a hydrocarbyl group and contains less than 18 carbon atoms when linear,

to reduce CFPP regression in a fuel oil composition comprising fuel oil having a sulphur content of less than 0.05% by weight, and

- (a) at least on ethylene polymer, and
- (c) at least one oil soluble polar nitrogen compound different from (b) and comprising one or more substituents of the formula $>NR^{13}$ when R^{13} represents a hydrocarbyl group containing 8 to 40 carbon atoms, which substituent or one or more of which substituents may be in the form of a cation derived therefrom

excluding the use of a p-nonylphenol formaldehyde resin in a fuel oil composition comprising an ethylene/vinyl acetate/versatic acid vinyl ester terpolymer and the reaction product of a terpolymer of a C_{14/16} α -olefin, maleic anhydride and allyl polyglycol with two equivalents ditallow fatty amine."

VI. In its decision the Opposition Division held that the set of fourteen claims of the third auxiliary request met the requirements of the EPC.

In particular, as regards the claimed priority, the Opposition Division reasoned that the applicant had not been informed by the Receiving Section according to Rule 41(1) EPC in conjunction with Article 91(1) about any formal defects of the priority document.

Only on 12 June 2003 the proprietor was informed that the priority document in the electronic file was not complete. On 4 July 2003 it filed a complete set of pages of the whole priority document.

The Opposition Division was of the opinion that formal defects in the priority document which have not been realized during the grant procedure cannot lead to the consequence that the priority is to be considered not to have been validly claimed.

Since the priority could be considered validly claimed, document (3) was comprised in the state of the art pursuant to Article 54(3) and (4) EPC.

Also, the Opposition Division found that the subject-matter of Claim 1 of auxiliary request 3 was novel

because of the insertion of a disclaimer based on the novelty destroying example of document (3) referring to the use of a p-nonylphenol formaldehyde resin in a low sulfur containing fuel oil composition comprising an ethylene/vinyl acetate/versatic acid vinyl ester terpolymer and the reaction product of a terpolymer of a C_{14/16} α -olefin, maleic anhydride and allyl polyglycol with two equivalents ditallow fatty amine.

Such a disclaimer was allowable under Article 123 EPC.

VII. This decision was appealed by opponent 01 (hereinafter the appellant).

VIII. The appellant raised objections inter alia under Articles 87, 88 and 123(2)(3) EPC. In particular, it insisted on the argument that the priority was not validly claimed and objected that the disclaimer contained in Claim 1 removed more than necessary to restore novelty against a disclosure under Article 54(3) EPC.

IX. Oral proceedings took place on 19 September 2007 in the absence of the respondent and opponent II who both had informed the Board they would not attend, the respondent in its letter dated 6 July 2007, opponent II in its letter dated 24 August 2007.

X. The appellant requested that the decision under appeal be set aside and the European patent be revoked.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. *Priority*

- 1.1 The appellant had objected that the patent in suit could not take advantage of the priority of the document GB 9810994 because only the cover pages and the odd pages of the priority document were initially available to the public via the online inspection system of the EPO and could be considered to have been filed within the limits required by Rule 38(3) EPC.

Therefore, it contested the validity of the priority of the patent in suit.

- 1.2 According to Article 87(1) EPC, the applicant shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing the first application.

To claim a priority of a previous application, an applicant for a European patent must submit the following documents:

- (a) the declaration of priority,
- (b) a copy of the previous application and
- (c) a translation of the previous application into one of the official languages of the EPO if the language is not one of the official languages (Article 88(1) EPC).

The declaration of priority consists of three items of information on the previous application:

- (i) a statement of the date of the previous filing,
- (ii) an indication of the State of filing and

(iii) the file number (Rule 38(1) EPC).

- 1.3 In this case, the respondent - at that date the applicant - had fulfilled all the requirements (i), (ii) and (iii) regarding the information of claiming priority.

The deficiency - objected to by the appellant - was that the electronic file did not contain the complete priority document.

- 1.4 Even if it is admitted that the document was not correctly filed, the possibility of correction of errors under Rule 88 EPC exists.

For a correction of errors no time limits are foreseen. Since, at the date of filing the priority document, the Receiving Section did not inform the respondent that the priority document was not completely filed, the respondent could not know that a filing error occurred. He then promptly corrected the error when he was informed.

The jurisprudence of the Boards of appeal admits corrections in the filing of priority documents even after publication of the application provided that the interests of third parties are not adversely affected by the correction. Third parties are not adversely affected by a correction if the mistake is apparent (see J 2/92 OJ EPO 1994, 375).

In the present case, the interests of third parties were not affected because third parties had all the necessary information (like the number of the priority

document, the state where the priority document was filed and the priority date) to get a copy of the whole priority document and, hence, the public interest was not seriously harmed.

Therefore, the Board concludes that the priority was validly claimed.

- 1.5 The consequence thereof is that document (3) filed on 24 December 1997, claiming the priorities of 7 January 1997 (DE 19700159) and 8 September 1997 (DE 19739272) and published on 12 August 1998 is considered as comprised in the state of the art pursuant to Article 54(3) and (4) EPC since it was published between the priority date [22 May 1998 (GB 9810994)] and the filing date [13 May 1999] of the patent in suit.

2. *Article 123(2) EPC - Disclaimer*

- 2.1 According to G 1/03 (OJ EPO 2004, 413), an amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed.

A disclaimer which is not disclosed in the application as filed may be allowable in order to restore novelty by delimiting a claim against the state of the art under Article 54(3) and (4) EPC (see G 1/03, Order, 1 and 2.1) if the disclaimer does not remove more than is necessary to restore novelty (G 1/03, reasons N° 3, paragraph 2, last sentence and Order, 2.2).

The consequence is in the Board's view that the disclaimer should be drafted as closely as possible on the wording of the anticipation and should not embrace subject-matter not disclosed in such anticipation.

- 2.2 In the present case the disclaimer is not disclosed in the application as originally filed.

It therefore has to be examined whether the disclaimer contained in Claim 1 only excluded the novelty destroying disclosure of document (3) or extended beyond the content of said disclosure.

- 2.2.1 The disclaimer as drafted by the respondent reads as follows:

"excluding the use of a p-nonylphenol formaldehyde resin in a fuel oil composition comprising an ethylene/vinyl acetate/versatic acid vinyl ester terpolymer and the reaction product of a terpolymer of a C_{14/16} α -olefin, maleic anhydride and allyl polyglycol with two equivalents ditallow fatty amine".

- 2.2.2 The novelty destroying disclosure of document (3) is example 3 in table 2 referring to components A1, B1 and C1 described in document (3) (page 7, lines 14 to 15; lines 24 to 31 and lines 47 to 48) and serving as a basis for drafting the disclaimer. The referenced passage in document (3) reads as follows:

" A1) ethylene/vinyl acetate/versatic acid vinylester-terpolymer having about 31% by weight of vinyl acetate and a melt viscosity of 110 mPas (50% in kerosene, 140°C)";

"B1) nonylphenol-formaldehyde resin

For manufacturing this formaldehyde resin, p-nonylphenol was reacted with an equimolar amount of a 35 weight percent formalin solution in the presence of catalytic amounts of alkyl benzene sulfonic acid, and the reaction mixture was freed from water by elimination of water through azeotropic distillation with a mixture of high boiling aromatic hydrocarbons (boiling range 185 to 215°C) and neutralized with potassium hydroxide. The red-brownish resin was diluted in Solvent[®] naphtha to a solid content of 50%. The molecular weight determined by gel chromatography (calibration against polystyrene standards) is 2000 g/mol";

"C1) reaction product of a terpolymer of a C_{14/16}- α -olefin, maleic anhydride and allyl polyglycol with 2 equivalents ditallow fatty amine, 50% in solvent naphtha (according to EP-A-0 606 055)".

2.2.3 The comparison between the disclaimer and the relevant passage in document (3) reveals

- that, in regard of the terpolymer, the wording "31% by weight of vinyl acetate and a melt viscosity of 110 mPas (50% in kerosene, 140°C)" is missing in the disclaimer,

- that the p-nonylphenol formaldehyde resin was defined by the respondent in the disclaimer in more general terms; technical details such as

"reacted with an equimolar amount of a 35 weight percent formalin solution in the presence of catalytic amounts of alkyl benzene sulfonic acid, and the reaction mixture was freed from water by elimination of water through azeotropic distillation with a mixture of high boiling aromatic hydrocarbons (boiling range 185 to 215°C) and neutralized with potassium hydroxide. The red-brownish resin was diluted in Solvent[®] naphtha to a solid content of 50%. The molecular weight determined by gel chromatography (calibration against polystyrene standards) is 2000 g/mol"

are missing;

- that e.g. the wording "50% in solvent naphtha" is missing in the reaction product of the terpolymer with ditallow fatty amine.

- 2.3 The disclaimer, as now drafted, does not only delimit Claim 1 against document (3) (i.e. state of the art under Article 54(3) EPC) but against more subject-matter than defined in document (3) as being novelty destroying. Hence, the subject-matter now excluded from Claim 1 extends beyond the relevant passage serving as a basis in document (3) for the exclusion.

Hence, the amendment has a bearing on the technical information disclosed in the specification, and the patent has been amended in a way that it extends beyond the content of the application as filed.

It follows that the patent in suit contravenes Article 123(2) EPC.

Order:

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke