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**Datasheet for the decision
of 15 January 2014**

Case Number: T 2485/11 - 3.3.01

Application Number: 01966106.5

Publication Number: 1313826

IPC: C10M163/00

Language of the proceedings: EN

Title of invention:

EXTENDED DRAIN MANUAL TRANSMISSION LUBRICANTS AND CONCENTRATES

Patent Proprietor:

The Lubrizol Corporation

Opponent:

Afton Chemical Corporation

Headword:

Overbased lubricant composition/LUBRIZOL

Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 12(4)

Keyword:

"Auxiliary requests 1 to 5: Admission (yes)"

"All requests: added subject-matter (yes) - no basis for combination of features"

Decisions cited:

T 1241/03, T 0144/09, T 0936/09, T 0023/10, T 0848/09,

T 1072/98, T 0540/01, T 1206/00, T 0003/06, T 1041/07

Catchword:



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Case Number: T 2485/11 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 15 January 2014

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 14 September
2011 revoking European patent No. 1313826
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: A. Lindner
Members: G. Seufert
M.B Tardo-Dino

Summary of Facts and Submissions

- I. The patent proprietor lodged an appeal against the decision of the opposition division revoking European patent No. 1 313 826.

- II. Notice of opposition was filed by the respondent requesting revocation of the patent in suit in its entirety on the grounds of lack of novelty and inventive step and insufficiency of disclosure (Articles 100(a) and (b) EPC).

- III. The decision of the opposition division was based on a main request filed with letter of 7 May 2009, auxiliary request 1 filed with letter of 22 June 2011 and auxiliary requests 2 and 3 filed on 28 June 2011 at the oral proceedings before the opposition division.

The main request contains a single claim reading as follows:

"A manual transmission lubricant comprising a major amount of an oil of lubricating viscosity, (A) at least one metal thiophosphate, (B) at least one di or trihydrocarbyl phosphite, (C) at least one basic alkali or alkaline earth metal salt of a phosphorous-free acidic organic compound having a total base number of at least 20, (D) at least one neutral or basic alkaline earth metal salt of at least one phenol or an aromatic acid, where component (D) is different from component (C), and wherein the ratio of equivalents of (C) based on the total base number to the equivalents of (B) based on phosphorus atoms is at least one, the manual transmission lubricant being free of barium salts."

In auxiliary requests 1 to 3 various modifications were made in the definition of compound (B) and/or the "ratio of equivalents".

The opposition division held that the amendments made in the main request and auxiliary requests 1 to 3 had no basis in the application as filed and accordingly revoked the patent for contravening Article 123(2) EPC.

IV. With the statement of grounds of appeal, the appellant resubmitted the main request underlying the decision under appeal and filed auxiliary requests 1 to 6.

Auxiliary request 1 differs from the main request in that the term "di or trihydrocarbyl" for component (B) has been deleted and the ratio of equivalents amended as follows: "and wherein the ratio of equivalents (C) based on the total base number to the equivalents of **hydrocarbyl phosphite** based on phosphorus atoms is at least one".

Auxiliary request 2 differs from auxiliary request 1 in that component (B) has been defined as "at least one **hydrocarbyl phosphite**".

Auxiliary request 3 differs from the main request in that the ratio of equivalents has been amended as follows: "and wherein the ratio of equivalents [of] **overbased material** based on the total base number to the equivalents of (B) based on phosphorus atoms is at least one".

Auxiliary request 4 differs from the main request in that the term "di or trihydrocarbyl" for component (B) has been deleted and the ratio of equivalents amended as follows: "and wherein the ratio of equivalents **of**

overbased material based on the total base number to the equivalents of **hydrocarbyl phosphite** based on phosphorus atoms is at least one".

Auxiliary request 5 differs from auxiliary request 4 in that component (B) has been defined as "at least one **hydrocarbyl phosphite**".

Auxiliary request 6 differs from the main request in that component (D) has been defined as "at least one neutral or basic alkaline earth metal salt of at least one **alkyl phenol sulphide**, where component (D) is different from component (C)".

- V. In its reply to the statement of grounds of appeal the respondent raised an objection under Article 123(2) EPC against all requests, *inter alia* because the specific combination of features was not disclosed in the application as filed and required several selections.
- VI. In a communication accompanying the summons to oral proceedings, the board expressed its preliminary opinion. In particular, the board indicated that the appellant had not provided a clear and unambiguous basis for the combination of features in the main and auxiliary requests.
- VII. With letter dated 11 December 2013, the respondent objected to the admissibility of auxiliary requests 1 to 5.
- VIII. Oral proceedings were held on 15 January 2014.
- IX. The arguments of the appellant, with respect to the decisive issues, can be summarised as follows:

- Admission of auxiliary requests 1 to 5

Auxiliary requests 1 to 5 were intermediate requests filed in direct response to the contested decision. Furthermore, auxiliary request 3 has already been considered by the opposition division. The respondent had had sufficient time to consider them and had in fact done so in its reply to the statement of grounds of appeal. The circumstances in decisions R 11/11 (based on T 144/09) and T 936/09 referred to by the respondent were not comparable to those of the present case. These decisions therefore could not support the respondent's argument that auxiliary requests 1 to 5 should not be admitted into the appeal proceedings.

- Amendments (Article 123(2) EPC)

The combination of components (A), (B), (C) and (D) of claim 1 of the main request was clearly supported by the application as originally filed. The addition of preferred features for these components did not add information which extended beyond the application as filed. The claimed subject-matter was not an arbitrary selection of different embodiments but rather reflected combinations which the skilled person would seriously contemplate. The same applied to auxiliary requests 1 to 6. In support, decision T 1241/03 was cited.

X. The arguments of the respondent, with respect to the decisive issues, can be summarised as follows:

- Admissibility of auxiliary requests 1 to 5

Auxiliary requests 1 to 5 should not be admitted into the appeal proceedings. The appellant could have filed them at the oral proceedings before the opposition

division but decided not to do so, despite an invitation by the chairman of the division. Remittal of the case, if the appeal was successful, would result in additional costs for the respondent and an undesirable delay in concluding the proceedings. Furthermore, the appellant should not be able to file new requests at any time it wished during opposition or opposition-appeal proceedings. In support, decisions R 11/11 and T 936/09 were cited.

- Amendments (Article 123(2) EPC)

The claimed subject-matter was an artificial combination of independent embodiments to create a new combination of features. Compared to original claim 2, which was the first claim in the original set of claims, several features had been added, namely component (D), a specific component (B), a specific component (C) being phosphorous-free and having a particular total base number value, the absence of barium salt and the requirement of the ratio of equivalents. None of these features was disclosed as a preferred feature in the application as filed. They were listed as separate embodiments of the invention and their combination with the summary of the invention or the examples, as the appellant had done, was the result of several intermediate generalisations. The same objections applied to auxiliary requests 1 to 6.

- XI. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the main request or one of the auxiliary requests 1 to 6, all filed with the statement of grounds of appeal or, alternatively, that the patent be maintained on the basis of one of the same requests.

- XII. The respondent requested that the appeal be dismissed. It further requested that auxiliary requests 1 to 5 be declared inadmissible.
- XIII. At the end of the oral proceedings the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. Admission of auxiliary requests 1 to 5
 - 2.1 According to Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) the board has the discretionary power to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings. When exercising their discretion the boards of appeal have to consider the specific circumstances of the case bearing in mind that the purpose of an appeal is to offer the losing party the possibility to challenge the decision of the opposition division on its merits, and not to conduct the case anew.

This means that if new submissions are not precluded, their admission is restricted (T 23/10, point 2.2 of the reasons for the decision, T 936/09, point 2 of the reasons for the decision). According to established jurisprudence, submissions which can be considered as a normal reaction of a losing party given the circumstance are usually allowed into the appeal proceedings by the boards (T 848/09, point 1 of the reasons for the decision, T 1072/98, point 2.3 of the

reasons for the decision, T 540/01, point 2 of the reasons for the decision).

2.2 In the present case, the respondent objected to the admission of auxiliary requests 1 to 5 on the grounds that these requests could already have been filed before the opposition division, thereby avoiding remittal of the case if the appeal was successful. It would have saved costs and would have allowed the proceedings to be resolved in due time. In support of its arguments, the respondent cited decisions R 11/11 and T 936/09.

2.3 However, these arguments cannot be accepted for the following reasons:

2.3.1 Decision R 11/11 was based on decision T 144/09, in which the board did not admit sets of claims which could have been filed before the department of first instance pursuant to Article 12(4) RBPA. At oral proceedings before the opposition division the patent proprietor was informed that the introduction of a particular feature contravened Article 123(2) EPC. The patent proprietor did not file any requests in an attempt to overcome this objection despite an invitation to do so by the chairman of the opposition division. With its statement of grounds of appeal, the patent proprietor filed several requests in which the particular feature had been deleted. The board considered that claims with such a straightforward amendment could and should have been filed before the department of first instance, at least in the form of auxiliary requests, and therefore declined to admit them under Article 12(4) RPBA.

2.3.2 In the case underlying decision T 936/09, the patent proprietor did not respond in substance to the opposition, despite having been given several opportunities to do so by the opposition division, but rather presented its case for the first time during the appeal proceedings. The board considered such a circumvention of first-instance proceedings inappropriate conduct on the part of the patent proprietor in view of the judicial nature of the appeal procedure and decided not to admit the patent proprietor's main request, which could easily have been provided during opposition proceedings, since it was a straightforward limitation and all the reasons for revocation were known to the patent proprietor before the opposition division announced its decision.

2.3.3 By contrast, in the present case, the appellant had filed an amended main request and an auxiliary request during first-instance proceedings in an attempt to overcome objections of lack of novelty and inventive step raised in the notice of opposition. In particular, it introduced an additional feature concerning a ratio of equivalents of two components. At the oral proceedings, the opposition division concluded that the amended requests did not comply with Article 123(2) EPC. The appellant, unlike in T 44/09 and T 936/09, took the opportunity offered to it and filed further requests modifying the amendments in the main request, in order to overcome the opposition division's objection under Article 123(2) EPC. The fact that, after these requests had also been considered to contravene Article 123(2) EPC, the appellant did not file a further request, cannot be regarded an abuse simply because, theoretically, it could have filed amendments.

In fact, judging from the circumstances, the board is not convinced that the appellant had a straightforward choice to overcome the opposition division's objection and deliberately withheld these requests, as was the case in the decisions cited by the respondent (see points 2.3.1 and 2.3.2 above). Deleting the amendments was not an option, since the appellant introduced them to overcome objections of lack of novelty and inventive step. Attempts to further amend the claims were made - in contrast to decisions T 144/09 and T 936/09 - but proved to be unsuccessful. Hence, given the circumstance of the case, the appellant's submission of auxiliary requests 1 to 5 is considered to be a normal and legitimate reaction of a losing party.

- 2.3.4 Moreover, auxiliary requests 1 to 5 were filed at the earliest possible stage in the appeal proceedings, namely with the statement of grounds of appeal where the appellant defended its main request. The auxiliary requests are further modifications of the main request. In none of them has the feature referring to the ratio of equivalent been deleted, as was the case in decision T 144/09. Furthermore, these requests are not considered to represent a significant deviation from the line of defence followed during the opposition proceedings, thereby rendering the contested decision pointless or requiring the board to conduct the case anew, as will be apparent from the reasons for rejecting them (see below).

Accordingly, the board decided to admit auxiliary requests 1 to 5 into the proceedings.

- 2.4 No objections were raised against auxiliary request 6 which in fact was identical to auxiliary request 1 underlying the decision under appeal.

Main request

3. Amendments (Article 123(2) EPC)

- 3.1 Amended claim 1 is directed to a manual transmission lubricant comprising a lubricating oil,
- (A) a metal thiophosphate,
 - (B) a di or trihydrocarbyl phosphite
 - (C) a basic alkali or alkaline earth metal salt of a phosphorous-free acidic organic compound with a total base number of at least 20
 - (D) a neutral basic or alkaline earth metal salt of a phenol or an aromatic acid, different from component (C)

wherein the ratio of equivalent (C) based on the total base number to the equivalents of based on phosphorous atoms is at least one
and the manual transmission lubricant is free of barium salts.

Compared to claim 1 as granted, claim 1 of the main request has been amended *inter alia* by introducing the feature concerning the ratio of equivalents, which according to the appellant found its basis on page 16, lines 21 to 24 of the application as originally filed.

- 3.2 However, in the present case, the question is not merely whether this feature *per se* has a basis in the application as originally filed but whether the presently claimed subject-matter with its combination of features finds support therein.

The board notes that page 16, lines 21 to 24 of the application as filed describes the "ratio of equivalents" as **one embodiment**. There is no reference

in this context to feature (D) or to the specific feature (C).

3.3 According to the appellant, the claimed subject-matter with its combination of features had a clear basis in the application as originally filed. The combination of a metal thiophosphate, a hydrocarbyl phosphite, a basic salt of an acidic compound and preferably an additional component (component (D)) found its basis on page 1, lines 2 to 5, page 2, lines 20 to 24 and page 3, lines 26 to 30 and was also reflected in the examples. Preferred embodiments for each of these components were disclosed on

- page 15, line 5 for the phosphite,
- pages 15 to 27 for the basic metal salt, in particular page 15, line 26 to 27, disclosing the absence of phosphor in the basic metal salt, page 16, lines 11 to 24 disclosing the ratio of equivalents of basic salt to hydrocarbyl phosphite
- page 16, line 18 referring to the claimed total base number value and
- page 27, lines 19 to 21 for the further metal salt

The claimed subject-matter was not the result of an arbitrary selection, but reflected preferred features of a combination of components, which clearly formed part of the invention.

3.4 The board is not convinced by the appellant's arguments for the following reasons:

3.4.1 According to established jurisprudence of the boards of appeal, the content of an application cannot be considered to be a reservoir from which features pertaining to separate embodiments of the application can be combined in order to artificially create a

particular embodiment (see T 1206/01, point 3.1.3 of the reasons for the decision; T 3/06, point 4.1.4 of the reasons for the decision, T 1041/07, point 3.5 of the reasons for the decision).

3.4.2 The passages on page 1, 2 and 3 referred to by the appellant disclose a manual transmission fluid comprising three components, namely a metal thiophosphate, a (hydrocarbyl) phosphite and a basic salt of an acid compound. The general presence of a fourth component cannot be found in these passages, although it is to be noted that the passage on page 2, lines 23 to 24 refers to **one embodiment**, where a **particular** compound, namely the metal salt of a phenol (which is not identical to compound (D)), is additionally present. The examples with their specific compositions cannot serve as a basis for a general disclosure of a manual transmission lubricant with four components.

3.4.3 The further passages cited by the appellant disclose separate embodiments of the invention. For example, in one embodiment the phosphite is di- trihydrocarbyl phosphite (page 15, line 5). In another embodiment the basic metal salt is phosphorous-free (page 15, lines 26 to 27). In yet another embodiment the "ratio of equivalents" (see point 3.1. above) must be at least one (page 16, lines 21 to 24) and in one embodiment the transmission lubricant further comprises component (D) (page 27, lines 19- to 21). A list of alternative values including the value "at least 20" for the total base number is provided on page 16, lines 17 to 20. None of these embodiments is characterised as preferred. The application as filed merely lists a number of separate embodiments of the invention in different parts of the description, without providing

any pointer from one embodiment to the other. Hence, the board fails to see any convincing reasons - and the appellant has not provided any - as to why the skilled person, in the absence of such pointers, would seriously contemplate combining them. In particular, the board cannot see a connection between the "ratio of equivalents", the presence of component (D) and the specifically defined component (C). For the sake of completeness, the board also notes that none of the examples discloses a manual transmission lubricant according to the present claim 1. This was not contested by the appellant. In particular, the "ratio of equivalents" falls outside the claimed range.

3.4.4 With respect to decision T 1241/03 referred to by the appellant, it is to be noted that in this decision the board came to the conclusion that there was a general disclosure for the composition and that the addition of preferred concentrations disclosed in different passages did not extend the subject-matter beyond the content as originally filed. In the present case, as set out in detail in points 3.4.1 to 3.4.3 above, there is no general disclosure of a combination of four components and none of the separate embodiments listed in the description as originally filed is characterised as preferred.

3.5 For the aforementioned reasons, the board concludes that the claimed subject-matter is an arbitrary combination of separate embodiments of the invention, which is not directly and unambiguously derivable from the application as filed. Claim 1 therefore extends beyond the content of the application as originally filed, contrary to Article 123(2) EPC.

- 3.6 In view of the above conclusion, there is no need to further examine whether or not the explicit reference to compounds (C) and (B) in the "ratio of equivalents" finds a basis in the passage on page 16, lines 21 to 24 of the application as originally filed.

Auxiliary requests 1 to 6

4. Claim 1 of each of auxiliary requests 1 to 6 is directed to same combination of embodiments as claim 1 of the main request, notwithstanding some minor modifications in the "ratio of equivalents" (auxiliary requests 1 to 5), the definition of component (B) (auxiliary requests 1, 2, 4 and 5) or component (C) (auxiliary request 6). Hence, the same considerations and conclusion as in points 3.4 and 3.5 apply, with the consequence that none of auxiliary requests 1 to 6 complies with Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated