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**Datasheet for the decision
of 19 March 2014**

Case Number: T 2630/11 - 3.3.01

Application Number: 08252578.3

Publication Number: 2075319

IPC: C10M173/02, C10M173/00,
C10N30/06

Language of the proceedings: EN

Title of invention:
Formulation of a metalworking fluid

Applicant:
Nalco Company

Headword:
Metalworking fluid/NALCO

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Added matter (yes) - unallowable combination of features

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2630/11 - 3.3.01

**D E C I S I O N
of Technical Board of Appeal 3.3.01
of 19 March 2014**

Appellant: Nalco Company
(Applicant) 1601 West Diehl Road
Naperville, IL 60563-1198 (US)

Representative: Chalk, Anthony John
HGF Limited
Saviour House
9 St Saviourgate
York YO1 8NQ (GB)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 26 July 2011 refusing European patent application No. 08252578.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman C. M. Radke
Members: J. Ousset
C. Brandt

Summary of Facts and Submissions

- I. The applicant filed an appeal against the decision of the examining division refusing European patent application No. 08252578.3.
- II. The examining division decided in particular that the subject-matter of the claims of the then pending main request and auxiliary request 1 was not novel and that auxiliary request 2 contravened Articles 123(2), 84 and 56 EPC.
- III. With its statement setting out the grounds of appeal, the appellant submitted a main request.
- IV. In its provisional opinion annexed to the summons to oral proceedings, the board gave reasons for its preliminary opinion that the subject-matter of the claims did not meet the requirements of Article 123(2), 84 and 83 EPC.
- V. With a letter of 17 March 2014, the appellant filed a new main request, and first, second and third auxiliary requests as well as further arguments.

Claim 1 of the new main request reads as follows:

"1. A metalworking fluid composition with a volume average particle size of 125 nm or greater when diluted to 7.5 percent by volume solution, the composition consisting of:

(a) 20 percent of polymeric lubricity agent wherein the polymeric lubricity agent is a Pluronic "R" block copolymer;

(b) 10 percent of partially neutralised carboxylic acid-alkali salts wherein the carboxylic acids are selected from the group consisting of: caproic/hexanoic acid; enanthic/heptanoic acid; caprylic/octanoic acid; pelargonic/nonanoic acid; isononanoic acid; capric/decanoic acid; neodecanoic acid; lauric/dodecanoic acid; stearic/octadecanoic acid; arachidic/eicosanoic acid; palmitic/hexadecanoic acid; erucic acid; oleic acid; arachidonic acid; linoleic acid; linolenic acid; myristic/tetradecanoic acid; behenic/docosanoic acid; alpha-linolenic acid; docosaheptaenoic acid; ricinoleic acid; butyric acid; lard oil; tallow oil; butter; coconut oil; palm oil; cottonseed oil; wheat germ oil; soya oil; olive oil; corn oil; sunflower oil; rapeseed/canola oil; and combinations thereof;

(c) 5 percent of emulsifying agents selected from the group consisting of: alkanolamides; alkylaryl sulfonates; alkylaryl sulfonic acids; amine oxides; amide and amine soaps; block copolymers; carboxylated alcohols; carboxylic acids/fatty acids; ethoxylated alcohols; ethoxylated alkylphenols; ethoxylated amines/amides; ethoxylated fatty acids; ethoxylated fatty esters and oils; ethoxylated phenols; fatty amines and esters; glycerol esters; glycol esters; imidazolines and imidazoline derivatives; lignin and lignin derivatives; maleic or succinic anhydrides; methyl esters; monoglycerides and derivatives; naphthenic acids; olefin sulfonates; phosphate esters; polyethylene glycols; polyols; polymeric (polysaccharides, acrylic acid, acrylamide); propoxylated and ethoxylated fatty acids; alcohols or alkyl phenols; quaternary surfactants; sarcosine derivatives; soaps; sorbitan derivatives; sucrose

and glucose esters and derivatives; sulfates and sulfonates of oils and fatty acids; sulfates and sulfonates ethoxylated alkylphenols; sulfates of alcohols; sulfates of ethoxylated alcohols; sulfates of fatty esters; sulfonates of dodecyl and tridecylbenzenes; sulfonates of naphthalene and alkyl naphthalene; sulfonates of petroleum; sulfosuccinamates; sulfosuccinates and derivatives; tridecyl and dodecyl benzene sulfonic acids; and combinations thereof;

(d) 61 percent water; and

(e) 4 percent corrosion inhibitors selected from the group consisting of: alkali salts of carboxylic acids, undecandioic/dodecandioic acid and its salts, C₄₋₂₂ carboxylic acids and their salts, boric acids, tolytriazole and its salts, benzotriazoles and their salts, imidazolines and their salts, alkanolamides, sulfonates, alkali salts of naphthenic acids, phosphate ester amine salts, alkali nitrites, alkali carbonates, carboxylic acid derivatives, alkylsulfonamide carboxylic acids, arylsulfonamide carboxylic acids, fatty sarkosides, phenoxy derivatives and sodium molybdate.

wherein the composition, when diluted to 7.5 percent by volume, comprises a lubricity, as measured by tapping torque instruments, of less than 8000 Newton-cm⁻¹, and further wherein the composition provides alkanolamine-free chemistry."

Claim 1 of the first auxiliary request differs from claim 1 of the main request only in that the feature "...wherein the pH of the composition is 3 or greater..." has been added.

Claim 1 of the second auxiliary request differs from claim 1 of the main request only in that the features "...wherein the pH of the composition is 3 or greater, and wherein said pH of the composition is provided by an alkalinity agent, which is a metal alkali hydroxide..." have been added.

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request only in that the claimed metalworking fluid composition has been additionally characterised as "...comprising carboxylic acid-alkali salts and polymeric lubricity agent at a ratio 1:2..."

VI. The appellant's arguments, as far as they are relevant for this decision, can be summarised as follows:

The amended claims met the requirements of Article 123(2) EPC as

- the amounts of the components had a proper basis in Material C of example 1; and
- the requirement that the composition "provides ethanolamine-free chemistry" was disclosed on page 3, line 3, of the application as filed.

The fact that the corrosion inhibitors present in said Material C were not specified and might be alkanolamines was not in contradiction with the general option of having a composition free of alkanolamines.

VII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, alternatively, on the basis of any of the sets of claims filed as auxiliary

requests 1, 2 or 3, all requests filed with letter of 17 March 2014.

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

Reasons for the Decision

- 1. The appeal is admissible.
- 2. Added-matter - Main request
 - 2.1 Claim 1 of the main request is based on the table of example 1, Material C on page 7 of the application:

Example 1

Material	A	B	C	D	E
Pluronic "R" block copolymer	0%	10%	20%	20%	20%
Carboxylic acid - alkali salts	10%	10%	10%	5%	0%
Emulsifiers	5%	5%	5%	5%	5%
Corrosion inhibitors	4%	4%	4%	4%	4%
RO water	Remainder	Remainder	Remainder	Remainder	Remainder

In example 1, and more particularly in Material C, corrosion inhibitors are used to make the metalworking fluid. However, in the said example, the corrosion inhibitors used are not specified (see page 7, line 10 to page 8, line 19). Examples of specific corrosion inhibitors are mentioned in original claim 2 and on page 5, lines 20 to 32. Among these, alkanolamine salts of carboxylic acids (see page 5, line 25), alkanolamines and alkanolamine salts of naphthenic acids (see page 5, lines 28 to 29) are cited. It is indisputable that, in the application as filed, both

options are envisaged, namely the presence or the absence of alkanolamines in the claimed compositions (see page 3, line 3), including Material C of example 1. However, there is no hint, either in example 1 or in the rest of the application as filed, which could lead the skilled person to conclude clearly and unambiguously that Material C of example 1 was indeed made without alkanolamines as presently claimed. Therefore, this Material C cannot be used as a basis for an amendment in a claim requiring "alkanolamine-free chemistry". Whereas the appellant is right that "alkanolamine-free chemistry" and the amounts of the components of Material C are disclosed in the application as filed, there is no clear and unambiguous disclosure of the combination of these two features.

3. Added-matter - Auxiliary requests 1 to 3

3.1 Since this combination of features is also present in the auxiliary requests, the board arrives at the same conclusion, namely, that these requests likewise contravene Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

C. M. Radke

Decision electronically authenticated