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**Datasheet for the ancillary decision
of 30 August 2022**

Case Number: T 0262/17 - 3.3.02

Application Number: 11155906.8

Publication Number: 2371935

IPC: C10M169/04, C10N30/04,
C10N30/06, C10N40/25

Language of the proceedings: EN

Title of invention:

Lubricant compositions for improved engine performance

Patent Proprietor:

Afton Chemical Corporation

Opponent:

Infineum International Limited

Headword:

Relevant legal provisions:

EPC R. 124(1)

Keyword:

Minutes of oral proceedings - request to correct minutes

Decisions cited:

T 0263/05

Catchword:



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Case Number: T 0262/17 - 3.3.02

A N C I L L A R Y D E C I S I O N
of Technical Board of Appeal 3.3.02
of 30 August 2022

Appellant: Afton Chemical Corporation
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Composition of the Board:

Chairman M. O. Müller
Members: M. Maremonti
R. Romandini

Summary of Facts and Submissions

- I. By letter dated 25 April 2022, the patent proprietor requested to amend the minutes of the oral proceedings held before the board on 21 March 2022 and provided by communication dated 28 March 2022, such that "*the course of the proceedings and position of patent proprietor be correctly described*".
- II. In detail, the patent proprietor requested to correct the minutes as follows:
- (a) On page 3, the following passage should be inserted between the first partial paragraph and the first full paragraph:
- "The Patent Proprietor immediately protested against non-admittance of the data contained in Annex II of the minutes of the oral proceedings before the Opposition Division, in particular formulation F (filed 22.08.2016, Tab C) explicitly referred to in item 9.5.4 of the reasons for the decision of the Opposition Division. It was the position of the Patent Proprietor that the appeal proceedings being a judicial review of the decision taken by the Opposition Division could not ignore the facts that the decision of the Opposition Division explicitly relied on."*
- (b) The third full paragraph on page 3 and the following paragraph bridging pages 3 and 4 should be amended as follows (the requested amendments to the minutes issued with communication dated 28 March 2022 have been highlighted by the board):
- "During the discussion of inventive step, the Opponent conceded that it was common general*

knowledge that compositions with Group II base oils performed better in the Sequence IIIG engine test, **including viscosity increase**, than compositions including Group I base oils and that therefore the selection of the claimed Group II base oils was obvious. **The Opponent referred to D4 as a support of the common general knowledge of a person of skill in the art.** The Patent Proprietor objected to the admittance of ~~this submission~~ **the submission that was based on D4 but emphasized the fact conceded by the Opponent that a Group II base oil performed better in viscosity increase within the Sequence IIIG engine test.** The issue of admittance was discussed. The Chair announced at the end of this discussion that the Board would deliberate on admittance and inventive step in substance.

After deliberation, the Board decided not to admit the Opponent's submission that it is common general knowledge that compositions with Group II base oils perform better in the Sequence IIIG engine test than compositions including Group I base oils. **The Chair announced that it did not distinguish between the Opponent's concession as to improved viscosity increase performance of Group II base oils and its reference to D4 as evidence of common general knowledge.** The Chair observed that without this being part of the proceedings, there was no evidence that compositions comprising Group II base oils led to improved performance in the test concerned. As a consequence, the objective technical problem was at most the provision of an alternative lubricant composition passing the Sequence IIIG engine test. In view of this problem, starting from D1, the Board found the solution defined in Claim 1 of the Main Request to be obvious. For this reason, the Board concluded that

*the Main Request was not allowable. **The Patent Proprietor protested against non-consideration of the Opponent's concession**".*

- III. With communication dated 19 May 2022 pursuant to Rule 100(2) EPC, the board issued its provisional opinion that the patent proprietor's request to correct the minutes of the oral proceedings as brought forward by its letter dated 25 April 2022 should be refused. A time limit of 2 months to reply to this provisional opinion was set.
- IV. No reply was received.

Reasons for the Decision

1. Pursuant to Rule 124(1) EPC, the minutes of oral proceedings shall be drawn up containing *inter alia* the essentials of the oral proceedings and the relevant statements made by the parties.
2. In T 0263/05 (OJ 2008, 329, headnote, point IV) the board held that the "*minutes of oral proceedings before the Boards of Appeal should record the requests of the parties on which a decision of the Board is required, such as [...] the form in which the proprietor seeks maintenance of the patent [...]. The minutes should also record specific statements which have an impact on the definition of the subject-matter, such as statements of surrender or abandonment of subject-matter, where these are relevant to the decision to be taken. **The arguments of the parties should not be recorded in the minutes, nor should statements or admissions made in oral proceedings which a party considers will be of use to it in any subsequent proceedings in national courts but which have no bearing on the decision which the Board is required to***

make, such statements or admissions neither constituting "essentials of the proceedings" nor "relevant statements" within the meaning of Rule 76(1) EPC [read: Rule 124(1) EPC] (emphasis and square brackets added by the board) .

3. The board notes that neither of the two requested corrections (points II(a) and II(b) above) concern the submission or the withdrawal of a request, nor a surrender or abandonment of subject-matter. Thus, neither of the two requested corrections fulfil the requirements as set out above by the cited case law of the Boards of Appeal for inclusion in the minutes of oral proceedings. For this reason alone, the requested corrections have to be refused.
4. Moreover, as regards the correction requested under point II(a) above, according to the board's written notes taken during the oral proceedings and the recollection of the members of the board, the patent proprietor did not make any submission after the board had deliberated and announced its conclusion (see the paragraph bridging pages 2 and 3 of the minutes) on the admittance of the patent proprietor's submissions made in its letter dated 15 March 2022 and referring to the experimental data contained in the patent proprietor's letter dated 22 August 2016 and Annex II to the minutes of oral proceedings before the opposition division.
 - 4.1 This board's position is confirmed by the statement reported in the first full paragraph on page 3 of the minutes, which states that after board's deliberation and announcement, *"the Chair asked the patent proprietor whether it had further requests or observations in respect of its submissions contained in the letter dated 15 March 2022. **The patent proprietor stated that there was no other submission in this regard**"* (emphasis added by the board). It is noted that

this statement has not been contested by the patent proprietor. Therefore, no submission, let alone a "protest", was made by the patent proprietor at that point in time of the oral proceedings.

- 4.2 Hence, the passage mentioned under point II(a) above does not correctly reflect the course of the oral proceedings and also on this ground the request to insert this passage into the minutes has to be refused.
5. Furthermore, as regards the correction requested under point II(b) above, according to the board's written notes taken during the oral proceedings and the recollection of the members of the board, the chairman of the board never *"announced that it did not distinguish between the Opponent's concession as to improved viscosity increase performance of Group II base oils and its reference to D4 as evidence of common general knowledge"* as argued by the patent proprietor.
 - 5.1 In fact, the way the chairman of the board works includes taking precise note, at the end of the deliberation, of what will be announced to the parties. By checking these notes, the board has no doubts that the announcement put forward by the patent proprietor was never made by the chairman.
 - 5.2 Additionally, according to the board's written notes taken during the oral proceedings and the recollection of the members of the board, the patent proprietor did not make any submission, let alone a "protest", after the board had concluded (see the last two lines of the paragraph bridging pages 3 and 4 of the minutes) that the main request was not allowable.
 - 5.3 Therefore, the passage mentioned under point II(b) above does not correctly reflect the course of the oral

proceedings and also on this ground the request to insert this passage into the minutes has to be refused.

Order

For these reasons it is decided that:

The patent proprietor's request to correct the minutes of the oral proceedings is refused.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated