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Datasheet for the decision of 6 April 2023

Case Number: T 0350/19 - 3.3.02

Application Number: 13155770.4

Publication Number: 2767578

IPC: C10M175/00, C10M177/00, F01M1/12, F01M9/02, C10N40/26, F01M11/04

Language of the proceedings: EN

Title of invention:
Process and apparatus for the preparation of a cylinder oil

Patent Proprietor:
LUKOIL Marine Lubricants Germany GmbH

Opponent:
Maersk Oil Trading and Investments A/S

Headword:

Relevant legal provisions:
EPC R. 101(2)
EPC Art. 56
RPBA Art. 12(4)
RPBA 2020 Art. 13(1)

Keyword:
Admissibility of appeal
Inventive step
Late-filed request - request could have been filed in first instance proceedings
Amendment to appeal case - suitability of amendment to resolve issues raised

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0350/19 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 6 April 2023

Appellant: (Patent Proprietor)	LUKOIL Marine Lubricants Germany GmbH Alsterufer 20 20354 Hamburg (DE)
Representative:	RGTH Patentanwälte PartGmbB Neuer Wall 10 20354 Hamburg (DE)
Respondent: (Opponent)	Maersk Oil Trading and Investments A/S Esplanaden 50 1263 Copenhagen K (DK)
Representative:	EIP Fairfax House 15 Fulwood Place London WC1V 6HU (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 4 December 2018 revoking European patent No. 2767578 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	M. O. Müller
Members:	A. Lenzen
	L. Bühler

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the patent proprietor (appellant) against the opposition division's decision (decision under appeal) to revoke European patent No. 2 767 578 (patent).

II. The following documents, cited during the opposition proceedings, are relevant for the present decision:

D1 WO 2007/044909 A1
D2 EP 1 640 442 A1
E1 JP H02-099708 A
E1a English translation of E1
E10 S. Jumaine et al., Wärtsilä Technical Journal, 01, 2012, 47-54

III. With the statement of grounds of appeal, the appellant filed, *inter alia*, the sets of claims of auxiliary requests 1 to 8 and the following documents:

E12 CIMAC Guidelines for diesel engines lubrication - oil degradation, number 22, 2004
E13 LinkedIn profile of Mr Jumaine (1 page)
E14 Comparative examples (1 page)
E15 Marine Propulsion, October/November 2011, 5 pages

IV. With the reply to the statement of grounds of appeal, the opponent (respondent) filed the following documents:

E16 Service Letter SL09-507/HRR from MAN Diesel
E17 Wärtsilä Technical Bulletin RT-113

E18 Press release from Castrol Marine
E18a Website showing publication date of E18a
E19 ASTM D2896-11
E20 Product Information Sheet for NAVIGO 6 SO
E21 Product Information Sheet for NAVIGO 6 CO
E22 Product Data Sheet for Castrol CDX 30
E23 Product Data Sheet for Mobilgard 300
E24 Product Data Sheet for SHELL MELINA S Oil
E25 Product Data Sheet for Veritas 800 Marine
E26 T. Mang and W. Dresel, "Lubricants and Lubrication", Wiley-VCH Weinheim, 2005, 43-5
E27 B. Bhushan, "Modern Tribology Handbook", vol. 1, CRC Press, 1374-7

V. On 27 November 2019, a third-party observation (A18) was filed citing the following documents:

A19 MAN Diesel & Turbo, Recommendation for Cylinder Lubrication Oil in MAN B&W Two Stroke Diesel Engines
A20 CIMAC Guidelines for the lubrication of two-stroke crosshead diesel engines, number 15, 1997
A21 R.M. Mortier and S.T. Orszulik, "Chemistry & Technology of Lubricants", Blackie Academic & Professional, 1992, 238
A22 WO 2006/014866 A1

VI. With the letter dated 2 April 2020, the appellant filed the following documents:

E28 D. Woodyard, "Pounder's Marine Diesel Engines and Gas Turbines", Elsevier Ltd., 8th edn., 2004, 119-21
E29 Product description of Opt-Max BoB300, 320, 340 additives
E30 Extract of the commercial register of the local

court, Hamburg
E31 EC safety data sheet for NAVIGO 6 CO, NAVIGO 6 CO 40, NAVIGO 6 CO 20
E32 Copy of an email from Mr Jumaine
E33 Screenshot of the website of the company Marine Fluid Technology A/S

VII. With the letter dated 29 July 2021, the respondent filed, *inter alia*, the following documents:

E34 Press Release from the appellant regarding, *inter alia*, NAVIGO 6 CO
E35 EC safety data sheet for NAVIGO 6 CO
E36 JP H06-080805 U
E36a English translation of E36

VIII. With the letters dated 7 December 2021 and 27 July 2022, the appellant filed the sets of claims of auxiliary requests 1A and 2A, respectively.

IX. In preparation for the oral proceedings, arranged at the parties' request, the board issued a communication pursuant to Article 15(1) RPBA 2020.

X. With the letter dated 3 March 2023, the appellant filed the sets of claims of auxiliary requests 3A to 8A.

XI. The oral proceedings before the board took place as a videoconference on 6 April 2023 in the presence of both parties. The board decided:

- that the appeal was admissible
- not to admit auxiliary requests 2 to 8 and 1A to 8A
- that E32 remain excluded from the public file
- to admit E12 and E15

At the end of the oral proceedings, the chair announced the order of the present decision.

XII. Summaries of the appellant's arguments on the allowability of the main request and auxiliary request 1 and the admittance of auxiliary requests 2 to 8 and 1A to 8A are contained in the reasons for the decision.

XIII. The respondent's arguments on the admissibility of the appeal are contained in the reasons for the decision. Its arguments on the allowability of the main request and auxiliary request 1 and the admittance of auxiliary requests 2 to 8 and 1A to 8A can be summarised as follows.

- *Main request*

  The subject-matter of claim 1 of the main request lacked novelty over E1. Furthermore, even if the appellant's argument were accepted that the feature "*wherein the used oil has a lower TBN value than the fresh cylinder oil*" was not disclosed in E1, the objective technical problem would merely be to provide an alternative process to that of E1. The board was right to say that the wording of claim 1 still allowed the "*used oil*" to be a used cylinder oil and that, consequently, the objective technical problem formulated by the appellant was not solved over the entire breadth of the claim. It was evident to the skilled person that changes in the TBN (total base number) value of the used cylinder oil could easily be compensated for by changes in the new cylinder oil and *vice versa*. Hence, the subject-matter of claim 1 of the main request did not involve an inventive step.

- *Auxiliary request 1*

  The additional feature in claim 1 of auxiliary request 1 compared to claim 1 of the main request was not an additional distinguishing feature over E1. This was because the used cylinder oil of E1 could, by analogy with the blending-on-board concept, also be understood as a mixture of used system oil and additives. The appellant's argument that used system oils contained different by-products than used cylinder oils had not been substantiated. Nor was it credible in view of the fact that cylinder oils were subjected to harsher operating conditions than system oils.

- *Auxiliary request 1A*

  The reasons given by the appellant for submitting auxiliary request 1A were a misrepresentation of an argument set out in the decision under appeal and repeated by the respondent. Such a misunderstanding could not justify the admittance of auxiliary request 1A under Article 13(1) RPBA 2020.

- *Auxiliary requests 2 to 8*

  The course of the proceedings before the opposition division could not justify the filing of auxiliary requests 2 to 8 only on appeal. Claim 1 of auxiliary requests 2 to 8 contained the feature of claim 4 as filed/granted. This feature had never been included in claim 1 in any of the requests filed before the opposition division. Requests containing this feature could and should have been filed before the opposition division. Hence,

auxiliary requests 2 to 8 should not be admitted (Article 12(4) RPBA 2007).

- *Auxiliary requests 2A to 8A*

  Auxiliary requests 2A to 8A should not be admitted essentially for the same reasons as auxiliary requests 2 to 8.

XIV. The parties' final requests at the end of the oral proceedings were as follows.

The appellant requested that:

- the decision under appeal be set aside and the patent be maintained as granted, implying that the opposition be rejected (main request)
- alternatively, the patent be maintained in amended form based on one of the sets of claims of auxiliary request 1 or 1A, with auxiliary request 1 having been filed with the statement of grounds of appeal and auxiliary request 1A having been filed with the letter dated 7 December 2021
- further alternatively, the case be remitted to the opposition division for further prosecution based on one of the following sets of claims in the indicated order: auxiliary request 2, 2A, 3, 3A, 4, 4A, 5, 5A, 6, 6A, 7, 7A, 8 and 8A, with auxiliary requests 2 to 8 having been filed with the statement of grounds of appeal, auxiliary request 2A having been filed with the letter dated 27 July 2022, and auxiliary requests 3A to 8A having been filed with the letter dated 3 March 2023
- further alternatively, the patent be maintained in amended form based on one of the above sets of

claims of auxiliary requests 2, 2A, 3, 3A, 4, 4A, 5, 5A, 6, 6A, 7, 7A, 8 and 8A
- auxiliary requests 2 to 8 and 1A to 8A be admitted
- E12 to E15 and E28 to E33 be admitted
- E16 to E18, E18a, E22 to E27, E34 to E36 and E36a not be admitted
- a first third-party observation filed before the opposition division and the enclosed documents as well as the second third-party observation filed on appeal (A018) and the enclosed documents A019 to A022 not be admitted
- the inventive-step objection starting from E10 as the closest prior art not be admitted
- the novelty objection based on D2 and the inventive-step objection starting from D2 as the closest prior art not be admitted
- the case be remitted to the opposition division if E36/E36a was admitted
- Article 100(b) EPC not be admitted as a fresh ground for opposition

Lastly, the appellant formulated the following request (letter dated 3 March 2023, page 3, paragraph 2):

"*(1) to find that the Opposition Division has not exercised its discretion correctly, when it did not admit auxiliary requests 4 to 13,*
(2) to find that auxiliary requests 4 to 13 should have been admitted into the proceedings by the Opposition division,
(3) to consider admissibility of auxiliary requests 1 to 8 as filed with the grounds for appeal without regard to the decision of the Opposition Division not to admit auxiliary requests 4 to 13 as filed on July 11, 2018 into the proceedings, and

(4) to admit auxiliary requests 1 to 8 as filed with the grounds for appeal into the proceedings."

The respondent requested that the appeal be rejected as inadmissible. In the alternative, it requested that the appeal be dismissed.

The respondent also requested that:

- E16 to E18, E18a, E19 to E27, E36 and E36a be admitted
- E34 and E35 be admitted if E28 to E33 were admitted
- E32 be excluded from file inspection
- E13, E14 and E28 to E33 not be admitted
- the case not be remitted to the opposition division
- auxiliary requests 2 to 8 and auxiliary requests 1A to 8A not be admitted

Reasons for the Decision

Admissibility of the appeal

1. The respondent requested that the appeal be rejected as inadmissible pursuant to Rule 101(2) EPC.

It argued that the appellant had not provided an address in the notice of appeal. After having been invited by the board to remedy this deficiency, the appellant submitted the missing address. This rectification became effective as of the date of the notice of appeal. However, about two weeks after filing the notice of appeal, the appellant also requested a change of the patent proprietor's address in the European Patent Register to the same address as that indicated to the board. This change of address only became effective after the date of the notice of

appeal. Therefore, the address of the patent proprietor recorded in the European Patent Register on the day of the notice of appeal could not be the same as the address the appellant communicated to the board as the relevant address. It was therefore not clear whether the appellant was the same as the patent proprietor.

2. Pursuant to Article 108, first sentence, EPC in conjunction with Rule 99(1)(a) EPC, the notice of appeal must, *inter alia*, contain the address of the appellant as provided in Rule 41(2)(c) EPC. It is clear that the reference in Rule 99(1)(a) EPC to Rule 41(2)(c) EPC relates to the formal requirements for the address of an appellant which aim at further identifying the appellant. Rule 99(1)(a) EPC does not refer to the address recorded in the European Patent Register pursuant to Rule 143(1)(f) EPC. Indeed, such indications would be missing when the opponent was the appellant. Therefore, Rule 99(1)(a) EPC cannot be interpreted to require that an address indicated in the notice of appeal be identical to the address in the European Patent Register. For this reason, it is irrelevant for admissibility that the appellant requested a change of its address in the European Patent Register and when this change became effective. What matters is whether the appellant can be properly identified. However, the respondent did not argue that the address given in the appellant's reply to the board's communication raised doubts about the appellant's identity. Therefore, at the oral proceedings, the board decided that the appeal is admissible.

Admittance of E12 and E15

3. E12 and E15 were filed by the appellant with the statement of grounds of appeal. In line with the appellant's request, the board decided to admit these two documents at the oral proceedings. Since there was no opposing request from the respondent, there is no need to give reasons for this decision.

Background of the invention

4. The invention of the patent relates to, *inter alia*, a process for the production of an all-loss cylinder oil for use in crosshead diesel engines. In such engines, the cylinder oil is often separated from the oil in the rest of the engine, the so-called system oil.

Crosshead diesel engines are used on ships, for example, and usually combust heavy fuel oil with widely varying sulfur contents. For example, the legal requirements for the sulfur content of fuel oil are often less strict offshore. Therefore, ships usually combust cheaper fuel oil with a higher sulfur content offshore. Inshore, it is the other way around, more expensive fuel oils with a lower sulfur content have to be used.

During combustion, acidic products (sulfuric acid and other acids) are formed from sulfur. To neutralise these and thus reduce their corrosive effect on the cylinder materials, cylinder oil contains alkaline additives. Their quantity is typically specified in terms of the total base number (TBN).

When operating marine engines, the requirements for the cylinder oil therefore depend heavily on the fuel oil

used. It would therefore be desirable to be able to change the composition of the cylinder oil depending on the fuel oil used. As set out in the patent (paragraph [0011]) with respect to D2, a solution to this problem is to mix used system oil with e.g. alkaline additives to produce an oil which can be used as a cylinder oil. For the same type of engine as in the patent, this approach is referred to in E10 as the blending-on-board (BOB) concept because it can be easily implemented on a ship. The patent suggests to have found a further solution to this problem.

Main request (granted patent) - inventive step (Article 56 EPC)

5. Claim 1 reads as follows:

"*Process for the production of a cylinder oil comprising the steps:*

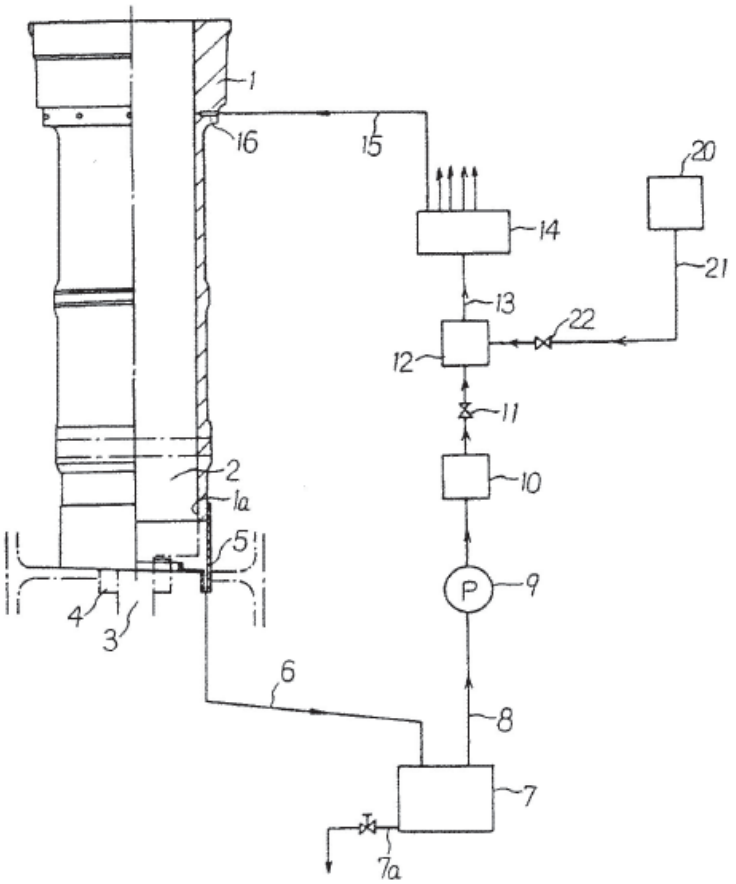
- *providing a used oil,*
- *providing a fresh cylinder oil, and*
- *blending the used oil with the fresh cylinder oil,*

wherein the used oil has a lower TBN value than the fresh cylinder oil, wherein the cylinder oil and the fresh cylinder oil are all-loss cylinder oils for the use in crosshead diesel engines and comprise alkaline additives."

6. The parties agreed that E1 can be considered the closest prior art. The board saw no reason to deviate from this unanimous view.

6.1 The distinguishing feature(s)

E1 discloses a process for recycling and reusing cylinder oil in an internal combustion engine, such as a large diesel engine, as schematically shown in the following figure 1 of this document.



Excess cylinder oil drains from the cylinder (shown on the left side above) into the drain catcher (5). Via various lines (6, 8, 13, 15), this used cylinder oil is first fed into a sedimentation tank (7) and then filtered (10). After mixing with new cylinder oil, which is supplied from the head tank (20), in the mixing tank (12), the resulting mixture of used and new cylinder oil is fed back to the cylinder via the oiling hole (16) (see E1a, page 3, paragraph 3 to page 4, paragraph 3).

Thus, the process of E1 provides a used oil (the used cylinder oil in the drain catcher (5)), provides a fresh cylinder oil (the new cylinder oil in the head tank (20)) and blends both oils together. Because the resulting blend is fed back to the cylinder at the oiling hole (16), it is a cylinder oil. Hence, E1 discloses a:

> "*[p]rocess for the production of a cylinder oil comprising the steps:*
>
> - *providing a used oil,*
> - *providing a fresh cylinder oil, and*
> - *blending the used oil with the fresh cylinder oil*"

as required by granted claim 1. This was common ground between the parties.

On the disclosure of E1, the parties also agreed on the following points.

(a) The process of E1 anticipates the feature of claim 1 according to which "*the cylinder oil and the fresh cylinder oil are all-loss cylinder oils for the use in crosshead diesel engines and comprise alkaline additives*".
(b) It is implicit in the process described in E1 that the new cylinder oil contains alkaline additives or, in other words, that the TBN value of the new cylinder oil is >0.
(c) As acidic combustion products are formed in the cylinder, the TBN value of the used cylinder oil when it leaves the drain catcher (5) is lower than that of the new cylinder oil.

While agreeing with (c) above, the appellant still argued that E1 did not directly and unambiguously disclose that "*the used oil has a lower TBN value than the fresh cylinder oil*" as stated in claim 1 of the main request. In the appellant's view, claim 1 had to be construed as requiring the used oil to have a lower TBN value than the fresh cylinder oil **at the time of blending**. The process of E1 was a closed-loop system. This meant that - since the TBN value of the used cylinder oil when leaving the drain catcher (5) was lower than that of the new cylinder oil - the addition of alkaline additive to the used cylinder oil before blending with the new cylinder oil was mandatory for the process of E1. The translation of E1, E1a, which described the addition of alkaline additive only as optional, was not correct. The addition of alkaline additive increased the TBN. Therefore, E1 did not directly and unambiguously disclose that the TBN of the used cylinder oil was lower than that of the new cylinder oil at the time of blending, which was after the addition of the alkaline additive. The fact that the used cylinder oil went through a sedimentation and filtration step before being blended with the new cylinder oil did not change this conclusion.

It is assumed below, in line with the appellant's argument, that the process according to claim 1 differs from that of E1 in that "*the used oil has a lower TBN value than the fresh cylinder oil*" or, put differently, that the TBN value of the fresh cylinder oil is at least as high as that of the used cylinder oil.

6.2 The effect and objective technical problem

6.2.1 The appellant argued that system oils had a lower TBN value than cylinder oils. In light of this, it followed

from the distinguishing feature mentioned above that other used oils such as used system oils could be applied as the used oil. Used system oils allowed a different set-up to be applied to that of E1. Therefore, the objective technical problem was to extend the scope to applications, this not requiring the closed-loop set-up of E1.

6.2.2 This argument cannot be accepted. Even if it is accepted that all system oils have a lower TBN value than all cylinder oils, as implied by the appellant's argument, oils of both classes, i.e. in particular two cylinder oils, can still differ from each other by their TBN value. The relative wording of the distinguishing feature ("*lower ... than*") therefore does not exclude that the used oil of claim 1 can also be a used cylinder oil. Consequently, this embodiment (using a used cylinder oil with a lower TBN than the fresh cylinder oil) cannot solve the objective technical problem formulated by the appellant, which was based precisely on the distinction from the used cylinder oil of E1, over the entire breadth of claim 1. Therefore, the objective technical problem must be formulated less ambitiously, namely as providing an alternative process to that of E1.

6.3 Obviousness

Given that alkaline additives in cylinder oils serve to protect the cylinder and its parts from corrosion caused by acidic combustion products, it would have been clear to the skilled person that the TBN value of the oil entering the cylinder is decisive in this respect, i.e. with regard to E1, the mixture of used cylinder oil and new cylinder oil. When aiming at a certain TBN value of this mixture of used and new oil,

they would therefore have realised without any inventive skill that, as pointed out by the respondent, changes in the TBN value of the used cylinder oil can easily be compensated for by changes in the new cylinder oil and *vice versa*. Instead of using a used cylinder oil with a TBN value at least as high as that of the new cylinder oil (as is allegedly the case in E1 according to the appellant), they would have realised that also a used cylinder oil with a lower TBN value can be used if only the TBN value of the new cylinder oil is raised high enough. This way, the skilled person would have arrived at a process falling within the subject-matter of claim 1 of the main request without any inventive skills.

7. In the written proceedings (statement of grounds of appeal, point 3.3.1), the appellant argued that a range of cylinder oils with different TBN values could be obtained from a used oil with, as required by claim 1, a lower TBN value and a fresh cylinder oil with a higher TBN value. In the written proceedings, the appellant had therefore formulated the objective technical problem as providing a process allowing the production of cylinder oils with a range of different TBN values from used oil. However, at the oral proceedings before the board, the appellant did not argue based on this objective technical problem. For the sake of completeness, the board notes that it does not agree with the objective technical problem put forward in writing by the appellant. According to this problem, the appellant considers that the technical effect of the distinguishing feature is that a cylinder oil can be obtained upon the blending of used and fresh oil which can have any TBN value ("*range of different TBN values*"). However, this is not the case. If an oil is obtained by blending two oils, the TBN value of the

blend must necessarily lie between the TBN values of the oils from which it is obtained. Therefore, the technical effect could at most be that a cylinder oil can be obtained with a TBN value that lies between those of the used oil and the fresh cylinder oil. This technical effect, however, is nothing more than the statement that the used oil must have a lower TBN value than the fresh cylinder oil, i.e. the distinguishing feature itself. Therefore, the appellant's submission amounts to a mere reformulation of the distinguishing feature without identifying a technical effect on the basis of which an objective technical problem could be formulated. The appellant's written submission, even if taken into account despite the different line of argument developed by the appellant during the oral proceedings, cannot therefore change the board's conclusion above.

8. Thus, the subject-matter of claim 1 of the main request does not involve an inventive step. The main request is not allowable.

Auxiliary request 1 - inventive step (Article 56 EPC)

9. Claim 1 reads as follows (amendment vis-à-vis claim 1 of the main request in bold):

"*Process for the production of a cylinder oil comprising the steps:*

- *providing a used oil,*
- *providing a fresh cylinder oil, and*
- *blending the used oil with the fresh cylinder oil,*

wherein the used oil has a lower TBN value than the fresh cylinder oil, wherein the cylinder oil and the fresh cylinder oil are all-loss cylinder oils for the use in crosshead diesel engines and comprise alkaline additives and

wherein the used oil comprises one or more oils selected from the group consisting of used hydraulic fluids, used gear oils, used system oils, used trunk piston engine oils, used turbine oils, used heavy duty diesel oils, used compressor oils and mixtures thereof."

Thus, the used oil now comprises one or more oils selected from a group of used oils. The oils from this group of used oils are only characterised by their previous use. This group includes used system oils but not used cylinder oils.

10. There was disagreement between the parties as to whether the additional feature (in bold above) constituted a further distinguishing feature over E1.

11. As set out above, in BOB, cylinder oil is produced by mixing used system oil with suitable additives such as alkaline additives. By analogy with BOB, the used cylinder oil of E1 can be considered to comprise used system oil, as required by the additional feature, and suitable additives, which are not excluded by the additional feature due to its open "comprising" wording. Thus, the additional feature does not result in any additional distinguishing feature over E1.

12. According to the appellant, the operating conditions for cylinder and system oils were different. Therefore, even if cylinder oil were considered to be system oil

plus additives, used cylinder oils and used system oils had to contain different by-products resulting from their respective previous uses. Therefore, the used cylinder oil of E1 could not be equated with used system oil plus additives as covered by claim 1.

Assuming that the used cylinder oil of E1 necessarily contains by-products not present in a used system oil does not contradict the above conclusion because the presence of these by-products is not excluded by the additional feature of claim 1 due to its open "comprising" wording. As far as the appellant's argument implies that any used system oil as referred to in claim 1 of auxiliary request 1 must necessarily contain by-products not present in the used cylinder oil of E1, it has not provided any evidence for this, as rightly pointed out by the respondent. Given that the operating conditions for cylinder oils are harsher than those for system oils, the board finds the respondent's argument convincing, namely that the used cylinder oil of E1 at least also contains each of the by-products contained in a system oil.

13. Therefore, the above conclusion that the additional feature in claim 1 of auxiliary request 1 is not an additional distinguishing feature over E1 remains valid. The reasoning above on a lack of an inventive step of claim 1 of the main request thus also applies to claim 1 of auxiliary request 1. Consequently, auxiliary request 1 is not allowable either.

Auxiliary request 1A - admittance (Article 13(1) RPBA 2020)

14. Claim 1 of auxiliary request 1A differs from claim 1 of auxiliary request 1 only in that it contains the following additional feature:

"***wherein the cylinder oil produced comprises at least 10 % by weight used oil, based on the total amount of cylinder oil produced***"

Thus, claim 1 of auxiliary request 1A now requires that the cylinder oil produced by blending the fresh cylinder oil and the used oil comprises at least 10 wt% of the latter.

15. Auxiliary request 1A was filed by the appellant with the letter dated 7 December 2021. This was later than its statement of grounds of appeal. The respondent requested that auxiliary request 1A not be admitted. As conceded by the appellant itself, the filing of auxiliary request 1A constitutes an amendment of its appeal case. Pursuant to Article 25(1) RPBA 2020, Article 13(1) RPBA 2020 is applicable to the admittance of this request.

16. The appellant essentially argued that the amendment (in bold above) was prompted by an argument raised by the respondent only in its immediately preceding letter dated 29 July 2021. This argument was that small amounts of used oil had no effect on the cylinder oil produced.

However, the respondent did in fact not raise the argument alleged by the appellant but merely repeated a point made by the opposition division in the decision under appeal, which was essentially that the wording "*wherein the used oil comprises one or more oils selected from the group consisting of [group of used oils]*" in claim 1 does not define a minimum amount of one of the members of the group in the used oil (respondent's letter dated 29 July 2021, point 4;

decision under appeal, page 17, point 7.3). Therefore, the amendment made in auxiliary request 1A which relates to the amount of the used oil in the produced cylinder oil rather than the amount of one of the members of the group of used oils in the used oil is not a reaction to an argument made previously by the respondent. If anything, it was prompted by a misunderstanding of the respondent's argument by the appellant.

Hence, contrary to Article 13(1) RPBA 2020, the filing of auxiliary request 1A was not suitable for resolving issues allegedly raised by the respondent. If anything, it gave rise to new issues as the feature in bold above had not been included in claim 1 in any of the claim requests filed up to that point. At the oral proceedings, therefore, the board decided not to admit auxiliary request 1A (Article 13(1) RPBA 2020).

Auxiliary requests 2 to 8 - admittance (Article 12(4) RPBA 2007)

17. Auxiliary requests 2 to 8 were filed with the statement of grounds of appeal. The respondent requested that these requests not be admitted. Pursuant to Article 25(2) RPBA 2020, Article 12(4) RPBA 2007 is applicable to the admittance of these requests.

18. In their respective claim 1, auxiliary requests 2 to 8 contain the following feature, which defines the viscosities of the used oil and the cylinder oil relative to each other as follows:

> "*wherein the used oil has a lower kinematic viscosity than the cylinder oil*"

This feature (relative viscosity feature) was not included in any of the auxiliary requests filed by the appellant before the opposition division. Therefore, auxiliary requests 2 to 8 are new requests filed for the first time on appeal.

19. The appellant submitted that the relative viscosity feature had been taken from claim 4 as filed/granted. This amendment amounted to a continuation of a line of argument according to which the viscosity of the used oil was a distinguishing feature over E1. This line of argument had started with auxiliary request 2-O before the opposition division, claim 1 of which included the feature "*wherein the used oil has a kinematic viscosity of up to 25 mm^2/s at 100 °C*" and which the opposition division considered not to contribute to an inventive step (note: here and below, auxiliary requests with hyphenated O (e.g. auxiliary request 2-O) refer to requests filed before the opposition division). The appellant had to be given the opportunity to include the relative viscosity feature in the claims and to continue the discussion of inventive step on this basis. Thus, auxiliary requests 2 to 8 were to be admitted.

20. The board does not agree for the following reasons. If the appellant saw a substantial difference between the process according to the invention and that of E1 in the viscosities of the oils and in particular in the viscosity of the used oil, as it argued, it is simply not understandable why, to create a distinction over E1, it had not resorted to the feature of claim 4 as filed/granted before the opposition division, which, moreover, is the only claim as filed relating to the kinematic viscosity of the oils of the process according to the invention. After all, the novelty

objection based on E1 had already been raised in the notice of opposition, i.e. at the earliest possible stage. The board therefore concludes that a request with an independent process claim 1 including the relative viscosity feature of claim 4 as filed/granted not only could have been filed before the opposition division, it should have been filed in light of the appellant's own submissions.

As set out above for claim 1 of auxiliary request 2-O, claim 1 of some of the auxiliary requests filed before the opposition division also contained a feature relating to viscosity. However, in claim 1 of those requests, the viscosities of the oils had always been defined in absolute terms in the form of numerical ranges, thus setting an upper and/or lower numerical limit for the viscosity. Contrary to this absolute viscosity feature present in the auxiliary requests filed before the opposition division, the relative viscosity feature chosen in auxiliary requests 2 to 8 no longer means or implies any numerical upper or lower limit of the respective oil in terms of viscosity. The relative viscosity feature of auxiliary requests 2 to 8 therefore requires different considerations on the cited state of the art and, for this reason alone, cannot be understood as a mere continuation of the argument that the viscosity of the used oil was a distinguishing feature over E1.

For these reasons, the board decided not to admit auxiliary requests 2 to 8 (Article 12(4) RPBA 2007).

The course of the opposition proceedings

21. As regards the admittance of auxiliary requests 2 to 8, the appellant to a large extent referred to and

criticised the course of the proceedings before the opposition division. However, as stated above, auxiliary requests 2 to 8 had been filed for the first time on appeal. The question of their admittance must therefore be assessed independently from events before the opposition division.

Notwithstanding this, the board considers the appellant's criticism of the conduct of the proceedings before the opposition division in the current case to be unjustified. This is explained below. To this end, the proceedings before the opposition division and the appellant's criticism are first summarised, followed by the board's considerations.

22. The proceedings before the opposition division may be summarised as follows.

(a) In the notice of opposition, the respondent raised novelty objections based on, *inter alia*, E1 and D1. Following the appellant's reply, the respondent elaborated on these two objections in a further submission.

(b) In its written preliminary opinion, the opposition division agreed with the appellant that these objections were not convincing. It considered that E1 did not directly and unambiguously disclose the feature "*wherein the used oil has a lower TBN value than the fresh cylinder oil*" of granted claim 1. The compositional limitations of claim 1 also applied to claim 12. Therefore, the subject-matter of claim 12 was also novel over E1. The opposition division also took the view that the examples of D1 were not prejudicial to novelty. This was because they contained numerous inconsistencies, did not indicate viscosity values for the oils used and

left open whether the system oil was a used system oil or not.

(c) A third-party observation was filed raising inventive-step objections against the granted claims.

(d) In a further submission, the respondent repeated the novelty objections based on E1 and D1, taking into account the opposition division's written preliminary opinion.

(e) On the last day for making written submissions or amendments set in the summons, the appellant filed auxiliary requests 1-O to 13-O.

(f) In yet another submission, the respondent addressed a contentious issue in relation to the translation of E1.

(g) At the oral proceedings, the opposition division changed its opinion on E1 and in part on D1. E1 was considered to be novelty-destroying for claim 1 as granted. Since claims 12 and 15 as granted did not contain an explicit reference to the used oil of claim 1, the compositional limitations of claim 1 did not apply to them, and they also lacked novelty over E1. Furthermore, the opposition division now considered the examples of D1 to be conclusive. Nevertheless, it maintained its view that D1 did not disclose whether the system oil of the examples was a used system oil or not and that, consequently, granted claim 1 was novel over D1. In the further course of the oral proceedings, the appellant filed auxiliary requests 1A-O, 1B-O, 2A-O, 3A-O and 3B-O, replacing previously filed auxiliary requests 1-O, 2-O and 3-O (see (e) above).

(h) The amendments made in the auxiliary requests, the opposition division's assessments and the conduct of the oral proceedings was as follows.

- After the main request had turned out not to be allowable for lack of novelty over E1, the appellant was given approximately 30 minutes to consider its requests. The appellant filed auxiliary request 1A-O. Compared to the granted set of claims, the used oil of claim 1 was defined as comprising one or more oils selected from a group of used oils (claim 1 of auxiliary request 1A-O is in fact identical to claim 1 of auxiliary request 1, see above). Claim 12 contains a reference to the used oil of claim 1, and claim 15 as granted was deleted. The opposition division held that the subject-matter of claims 1 and 12 was still not novel over E1. The reason for this was that the definition of the used oil in claim 1 did not exclude the used cylinder oil of E1.
- In claim 1 of auxiliary request 1B-O, the used oil was defined as consisting of used system oil. The opposition division decided that the claimed subject-matter of auxiliary request 1B-O lacked an inventive step over D1 as the closest prior art.
- Compared to claim 1 of auxiliary request 1B-O, claim 1 of auxiliary request 2A-O contained the additional feature that the used oil has a kinematic viscosity at 100 °C of up to 25 mm^2/s. According to the opposition division, auxiliary request 2A-O lacked an inventive step for the same reasons as auxiliary request 1B-O.
- The opposition division pointed out that the admittance of auxiliary requests 3-O to 13-O (see (e) above) might have to be discussed because these requests reinserted deficiencies which had

been overcome by the appellant with auxiliary requests 1A-O, 1B-O and 2A-O.

- After a break of 30 minutes to consider the situation, the appellant requested that the oral proceedings be adjourned. This request was refused.
- The appellant filed auxiliary request 3A-O. Compared to claim 1 of auxiliary request 2A-O, the range for the kinematic viscosity at 100 °C of the used oil was more limited in claim 1 of auxiliary request 3A-O ("*from 7 to 15 mm^2/s*"). Additionally, the kinematic viscosity at 100 °C of the fresh cylinder oil was stated to be in the range of 16 to 24 mm^2/s. The opposition division held that auxiliary request 3A-O did not meet the requirements of Article 123(2) EPC.
- The opposition division gave the appellant one more opportunity to file a set of claims meeting the requirements of the EPC.
- The appellant filed auxiliary request 3B-O. This request was deemed not to be clearly allowable and was therefore not admitted.
- Subsequently, the opposition division decided not to admit auxiliary requests 4-O to 13-O. According to the opposition division, these requests reinserted deficiencies that had already been overcome by some of the higher ranking auxiliary requests newly filed at the oral proceedings. It was not at all clear whether these deficiencies could also be remedied in a simple manner in auxiliary requests 4-O to 13-O. Auxiliary requests 4-O to 13-O were not *prima facie* allowable. These auxiliary requests were neither convergent among themselves nor with the auxiliary requests newly filed at the oral proceedings. Lastly, it was not even clear where

the appellant saw a possible contribution to inventive step of the features added in these requests.

23. Against this background, the appellant essentially submitted the following.

23.1 In its written preliminary opinion, the opposition division had agreed with the appellant on all important issues raised by the parties up to that point. However, at the oral proceedings, the opposition division changed its opinion on E1 and D1. E1 was now considered novelty-destroying for granted claim 1. Furthermore, the opposition division raised objections to granted claims 12 and 15 and to auxiliary requests 1A-O, 1B-O and 3A-O on its own initiative only at the oral proceedings. Since at least some of these objections applied to auxiliary requests 4-O to 13-O, it was clear that these auxiliary requests would not have been considered allowable in unamended form. The opposition division should have given the appellant the opportunity to amend auxiliary requests 4-O to 13-O to overcome the objections put forward only at the oral proceedings. These points had been insufficiently taken into account by the opposition division when deciding not to admit auxiliary requests 4-O to 13-O.

The appellant continued to argue that by not admitting auxiliary requests 4-O to 13-O, the opposition division had exercised its discretion incorrectly and violated the appellant's right to be heard. This was for the following reasons.

- The adjournment request was refused.
- After the filing of auxiliary request 3A-O, the appellant was only given one more chance to file a

new request, and the opposition division had clearly indicated that any further request beyond that would not be admitted.

- Auxiliary requests 4-O to 13-O had been filed not only on the last day for making written submissions or amendments set in the summons but also in reply to a third-party observation filed only very late in the opposition proceedings. Hence, auxiliary requests 4-O to 13-O were not late filed and could therefore not be held inadmissible.

23.2 The appellant formulated the following request (letter dated 3 March 2023, page 3):

> "*(1) to find that the Opposition Division has not exercised its discretion correctly, when it did not admit auxiliary requests 4 to 13,*
> *(2) to find that auxiliary requests 4 to 13 should have been admitted into the proceedings by the Opposition division,*
> *(3) to consider admissibility of auxiliary requests 1 to 8 as filed with the grounds for appeal without regard to the decision of the Opposition Division not to admit auxiliary requests 4 to 13 as filed on July 11, 2018 into the proceedings ...*"

Since auxiliary request 1 has been found not to be allowable (see above), part (3) of the above request is only relevant to auxiliary requests 2 to 8.

As regards this part (3), the appellant explained that its request was essentially directed against the potential argument according to which auxiliary requests 2 to 8 were tantamount to maintaining requests which had not been admitted by the opposition division

because auxiliary requests 2 to 8 and the auxiliary requests not admitted by the opposition division had partly identical claims and/or features. At the oral proceedings before the board, the appellant specified this such that the exercise of discretion of the opposition division on the non-admittance of auxiliary requests 4-O to 14-O was erroneous and that this decision should therefore be disregarded when deciding on the admittance of auxiliary requests 2 to 8.

As is apparent from the board's reasoning on its decision not to admit those requests (see points 17 to 20 above), this reasoning is totally independent from the way the opposition division dealt with the auxiliary requests before it. Therefore, the appellant's request (3) above has been complied with.

24. As regards parts (1) and (2) of the appellant's request, the board's considerations are as follows.

24.1 These two parts of the request are irrelevant to the appeal proceedings since none of the auxiliary requests before the opposition division, to which the two parts of the request refer, is part of the appeal proceedings.

24.2 Irrespective of this, it is true that the opposition division changed its opinion on the relevance of E1 for the novelty of granted claim 1 at the oral proceedings compared to the written preliminary opinion. However, a written preliminary opinion is, as its name suggests, not unalterable. A party must not rely on a preliminary written opinion favourable to it and be aware that a departure from this opinion at the oral proceedings cannot be excluded. This applies all the more to the current case because between this written opinion and

the oral proceedings, a further submission was made by the respondent elaborating on the objections on which the opposition division had given a preliminary opinion favourable to the appellant and which even addressed this preliminary opinion.

24.3 If the appellant only files auxiliary requests very late in the proceedings, namely, in this case, on the last day for filing amendments specified in the summons, it must accept the resulting consequences, such as objections filed even later. This late submission of the auxiliary requests cannot be excused in the current case by the third-party observation submitted shortly before since the auxiliary requests, as can be derived from the appellant's submission dated 11 July 2018, do not - at least not exclusively - take into account the objections raised in the third-party observation but primarily address the objections based on E1 and D1.

24.4 The granted patent already failed due to the non-allowability of granted claim 1. In view of this, the board considers the objections to granted claims 12 and 15, which the opposition division allegedly raised on its own initiative during the discussion of the granted patent, to be conducive to procedural economy. According to the appellant's own submission, these objections would have been relevant to the pending auxiliary requests anyway. In the board's view, these objections to granted claims 12 and 15 were not of such a nature that the appellant could not be expected to address them at the oral proceedings. Finally, the fact that these objections did not cause any problem for the appellant is also clear from auxiliary request 1A-O, which renders these objections moot in a straightforward manner.

24.5 Claim 1 of auxiliary requests 1B-O and 3A-O contains the feature "*wherein the used oil* ***consists of*** *used system oil*" (emphasis added). This feature was not included in any of the requests filed up to the oral proceedings. The fact that objections relating to this feature - such as those pointed out by the appellant - were only raised at the oral proceedings could hardly have come as a surprise to the appellant.

24.6 The opposition division's new objection to claim 1 of auxiliary request 1A-O relates to a feature which originates from granted dependent claim 5 and was already included in auxiliary request 1-O. The fact that this objection was not raised until the oral proceedings is also not objectionable as auxiliary request 1-O was only filed on the last day for filing amendments specified in the summons and, in the current case, this was only two months before the oral proceedings. The remaining time until the oral proceedings is generally too short for an opposition division to provide further comments on the merits of the case. The board also sees no reason why the opposition division should have had to deal with granted dependent claim 5 in its written preliminary opinion because it is usually the independent claims which are the focus of the parties, and it would not be appropriate to require an opposition division to comment on each and every dependent claim at such an early stage of the proceedings.

24.7 At the oral proceedings before the opposition division, the appellant was given the opportunity to substantiate its request for an adjournment of the oral proceedings. In the board's view, the rejection of this request in the decision under appeal is justified by the fact that

the appellant had been given sufficient opportunities to overcome the objections raised in the oral proceedings before the opposition division. The appellant was also given sufficient time to formulate a new request each time. Therefore, the board cannot see any violation of the appellant's right to be heard in the refusal of the request for an adjournment.

24.8 If the opposition division did indeed indicate to the appellant that it did not intend to admit any further requests after auxiliary request 3B-O, as argued by the appellant and possibly implied by the sentence "*The proprietor was given one more opportunity to file patentable claims*" in point 9.3 of the minutes, such a statement would indeed be inappropriate. However, in view of the fact that, as stated above, the appellant was given sufficient opportunities to overcome the existing objections, the board cannot see this as a violation of the appellant's right to be heard. If the appellant's argument were to be accepted, this would ultimately mean that the patent proprietor could prevent the opposition division from taking a decision by filing a series of new requests. Not only is there no legal basis for this in the EPC, it would also clearly run counter to procedural economy.

24.9 The appellant was also heard at the oral proceedings on the admittance of auxiliary requests 4-O to 13-O. For this reason alone, the board cannot see any violation of the appellant's right to be heard in this respect.

24.10 Thus, contrary to the appellant's submission, the board is convinced that the opposition division exercised its discretion correctly when it did not admit auxiliary requests 4-O to 13-O, implying that the board does not agree with the appellant that auxiliary requests 4-O to

13-O should have been admitted into the proceedings by the opposition division.

Auxiliary requests 2A to 8A - admittance

25. Auxiliary request 2A and 3A to 8A were filed by the appellant with the letters dated 27 July 2022 and 3 March 2023, respectively. The respondent requested that these requests not be admitted. Pursuant to Article 25(1) and (3) RPBA 2020, Article 13(1) RPBA 2020 is applicable to the admittance of these requests.

26. Auxiliary requests 2A to 8A differ from their corresponding auxiliary requests 2 to 8 only in that they additionally state how the kinematic viscosity is to be measured ("*wherein the kinematic viscosity is measured according to DIN 51562/2 at a temperature of 100 °C*"). However, they still contain in their respective claim 1 the same feature objected to above for auxiliary requests 2 to 8, namely the definition of the viscosities of the used oil and the cylinder oil in relative terms. For the reasons given above for auxiliary requests 2 to 8, the board decided at the oral proceedings not to admit auxiliary requests 2A to 8A either (Article 13(1) RPBA 2020).

27. The appellant argued that the amendments in auxiliary requests 2A to 8A, relative to auxiliary requests 2 to 8, were made to overcome objections raised by the opponent or the board to the previously filed auxiliary requests 2 to 8.

However, this argument can only speak in favour of admitting auxiliary requests 2A to 8A if auxiliary requests 2 to 8, from which auxiliary requests 2A to 8A

derive, were admitted. However, this is not the case (see above).

Auxiliary requests 2 to 8 and 2A and 8A - remittal

28. The appellant requested that the case be remitted to the opposition division for further prosecution based on one of the sets of claims of auxiliary requests 2 to 8 or 2A to 8A. Since remittal can only be ordered based on a request which is in the proceedings and since the board decided not to admit auxiliary requests 2 to 8 and 2A to 8A, the requests for remittal were moot.

Exclusion of E32 from file inspection

29. E32 was filed by the appellant in relation to the respondent's objections based on D1. During the written proceedings, at the respondent's request, the board decided to temporarily exclude E32 from the public file. At the oral proceedings, the board decided that E32 remain excluded from the public file.

As the objections based on D1 are not relevant for the present decision, no reasons need to be given. The appellant also refrained from making further comments in this respect at the oral proceedings.

Further points

30. At the end of the oral proceedings, requests for the admittance of various documents and objections, two third-party observations, and a fresh ground for opposition were still open. As none of these points turned out to be relevant for this decision, there was no need to decide on these requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

N. Maslin M. O. Müller

Decision electronically authenticated