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**Datasheet for the decision
of 13 June 2023**

Case Number: T 1598/19 - 3.3.02

Application Number: 12008549.3

Publication Number: 2573155

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Language of the proceedings: EN

Title of invention:
LUBRICATING OIL COMPOSITION

Patent Proprietor:
JX Nippon Oil & Energy Corporation

Opponent:
Infineum International Limited

Headword:

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Amendments

Amendment to case - amendment admitted (no)

Decisions cited:

G 0003/89, G 0011/91, G 0002/10, T 1511/07, T 1451/10,
T 1217/13, T 0119/15

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1598/19 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 13 June 2023

Appellant: Infineum International Limited
(Opponent) P.O. Box 1
Milton Hill
Abingdon Oxfordshire OX13 6BB (GB)

Representative: Uexküll & Stolberg
Partnerschaft von
Patent- und Rechtsanwälten mbB
Beselerstraße 4
22607 Hamburg (DE)

Respondent: JX Nippon Oil & Energy Corporation
(Patent Proprietor) 6-3, Otemachi 2-chome
Chiyoda-ku
Tokyo 100-8162 (JP)

Representative: Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
5 April 2019 concerning maintenance of the
European Patent No. 2573155 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
B. Müller

Summary of Facts and Submissions

- I. The appeal of the opponent (hereinafter appellant) lies from the decision of the opposition division according to which European patent 2 573 155 in amended form and the invention to which it relates were found to meet the requirements of the EPC.
- II. The contested decision was based on the patent as granted as main request and sets of claims of first to fifth auxiliary requests, of which the set of claims of the second auxiliary request (submitted as the third auxiliary request with the letter dated 09 August 2018) was found allowable.
- III. The appellant filed an appeal against this decision. With the statement of grounds of appeal it argued *inter alia* that the claims of the second auxiliary request found allowable by the opposition division failed to meet the requirements of Article 123(2) EPC.
- IV. With its reply to the statement of grounds of appeal the patent proprietor (hereinafter respondent) submitted the set of claims found allowable by the opposition division as main request, as well as sets of claims of first to fourth auxiliary requests.
- V. In a communication pursuant to Article 15(1) RPBA sent in preparation for oral proceedings, the board *inter alia* expressed the preliminary view that the respective claim 1 of all requests failed to meet the requirements of Article 123(2) EPC.

VI. Oral proceedings by videoconference took place as scheduled on 13 June 2023 in the presence of both parties.

VII. Requests relevant to the present decision

The appellant requested that the contested decision be set aside and that the patent be revoked in its entirety.

It also requested that auxiliary requests 4 to 6 not be admitted into the proceedings pursuant to Article 13(2) RPBA 2020.

The respondent requested that the appeal be dismissed, implying maintenance of the patent in the form found allowable by the opposition division.

Alternatively, it requested maintenance of the patent on the basis of one of the first to third auxiliary requests submitted with the reply to the statement of grounds of appeal, or on the basis of one of auxiliary requests 4 to 6 submitted with the letter dated 25 May 2023, or on the basis of the set of claims of the seventh auxiliary request, submitted as the fourth auxiliary request with the reply to the statement of grounds of appeal and renumbered with the respondent's letter dated 25 May 2023.

VIII. For the text of independent claim 1 of the main request, reference is made to the reasons for the decision, below.

IX. For the relevant party submissions in relation to Article 123(2) EPC and the admittance of auxiliary

requests 4 to 6, reference is made to the reasons for the decision, below.

Reasons for the Decision

Main request

1. Amendments - Article 123(2) EPC

1.1 Claim 1 of the main request reads as follows:

"A lubricating oil composition comprising:

a lubricating base oil with a kinematic viscosity at 100°C of 1-6 mm²/s, a %C_P of 80-70 or greater and a %C_A of no greater than 2, the %C_P and the %C_A being determined according to ASTM D 3238-85 (n-d-M ring analysis),

a hydrocarbon-based styrene-diene hydrogenated copolymer viscosity index improver with a PSSI of no greater than 20, the PSSI value being obtained by calculation according to ASTM D6022-01 based on data measured according to ASTM D6278-02, and a weight-average molecular weight of 10,000 to 100,000, and

a poly(meth)acrylate-based viscosity index improver with a weight-average molecular weight of 5,000 to 700,000,
wherein
the proportion of said lubricating base oil is at least 50% by mass based on the total amount of base oil,

the content of said styrene-diene hydrogenated copolymer viscosity index improver is 0.1-15.0 % by mass based on the total amount of the lubricating oil composition, and the content of said poly(meth)acrylate-based viscosity index improver is 0.5-9.0 % by mass based on the total amount of the lubricating oil composition.

(struck through and underlined text denoting deletion and addition compared to claim 1 of the application as filed).

1.2 The appellant submitted that claim 1 was constructed from multiple lists of numerical ranges taken from the application as filed and disclosed in various levels of preference, which in combination were not directly and unambiguously disclosed in the application as filed.

1.3 Compared to claim 1 of the application as filed, claim 1 of the main request includes the following amendments. The relevant basis in the application as filed is also indicated:

(a) The amendment to specify that the base oil has a %C_P of 80 or greater. This amendment finds basis in paragraph [0032] of the application as filed, which discloses that the "%C_P ... must be 70 or greater, and it is **preferably 80 or greater**, more preferably 85 or greater, even more preferably 87 or greater and most preferably 90 or greater".

(b) The selection of a styrene-diene hydrogenated copolymer from a list of hydrocarbon-based viscosity index improvers disclosed in paragraph [0042] of the application as filed, which is either not particularly restricted so long as it satisfies

the conditions of having a weight-average molecular weight of 100,000 or greater and a weight-average molecular weight and PSSI ratio of 1.0×10^{-4} or greater (page 16, line 25 - page 17, line 3), or is chosen from specific compounds including common non-dispersant or dispersant poly(meth)acrylates, **styrene-diene hydrogenation copolymers**, non-dispersant or dispersant ethylene- α -olefin copolymers or their hydrogenated forms, polyisobutylene or its hydrogenated forms, styrene-maleic anhydride ester copolymers, polyalkylstyrenes and (meth)acrylate-olefin copolymers.

- (c) The selection of a molecular weight range of 10,000 to 100,000 for the styrene-diene hydrogenated copolymer from paragraph [0086] whereby the lower end of the selected range is the **"more preferable"** value and the higher end the **"preferable"** value from multiple values listed ("preferably 5,000 or greater, more preferably 10,000 or greater and even more preferably 15,000 or greater. It is also preferably no greater than 100,000, more preferably no greater than 80,000 and even more preferably no greater than 70,000").

- (d) The selection of a molecular weight range of 5,000 to 700,000 for the poly(meth)acrylate-based viscosity index improver from paragraph [0091] whereby the lower and higher end of the range corresponds to the **"preferable"** range from multiple values listed ("preferably 5,000 or greater, more preferably 10,000 or greater and most preferably 50,000 or greater. It is also preferably no greater than 700,000, more preferably no greater than 500,000, even more preferably no greater than

200,000 and most preferably no greater than 100,000").

- (e) The selection of the proportion of said lubricating base of 50% from "**preferably at least 50%** ... even more preferably at least 70% by mass" in paragraph [0083].
- (f) The selection of the content of said styrene-diene hydrogenated copolymer viscosity index improver of 0.1-15.0% as the **broadest range** disclosed in paragraph [0095] from among multiple ranges listed (0.1-15.0% by mass, preferably 0.5-13.0% by mass, more preferably 1.0-12.0 % by mass and even more preferably 1.5-11.0 % by mass...").
- (g) The selection of the amount of poly(meth)acrylate-based viscosity index improver of 0.5-9.0 % as the **more preferred** range from paragraph [0096] from among multiple ranges listed (0.1-10.0 % by mass, preferably 0.5-9.0 % by mass, more preferably 1.0-8.0 % by mass and even more preferably 1.5-7.0 % by mass...").

1.4 In summary, in terms of the levels of preference expressed in the application as filed, the above selections include:

- the preferable value in selection (a),
- the more preferable lower value and the preferable higher value in selection (c),
- the preferable range in selection (d),
- the preferable value in selection (e),
- the broadest range for selection (f), and
- the most preferred range for selection (g).

- 1.5 The board's view is as follows. In the contested decision it was recognised that the gold standard set out in G 2/10 was to be applied in determining whether the requirements of Article 123(2) EPC were fulfilled.
- 1.6 The board can only agree. According to the gold standard, in order to fulfill the requirements of Article 123(2) EPC, an amendment to a claim can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application documents as filed (G 3/89, OJ 1993, 117; G 11/91, OJ 1993, 125; G 2/10, OJ 2012, 376).
- 1.7 The above selections required to arrive at the subject-matter of claim 1 result from, as indicated by the text in bold, the choice of end values expressed at various levels of preference for the respective ranges in the application as filed. These vary from the broadest range of values for selection (f), to the preferred range of values in selections (d) and (e), and the most preferred range of values in selection (g).
- 1.8 Furthermore, in selection (c), a new sub-range is defined which results from a combination of the more preferred lower end value and the preferred upper end value.
- 1.9 In addition to these selections, claim 1 also results from a selection of a styrene-diene hydrogenated copolymer from a list of hydrocarbon-based viscosity index improvers (selection (b)) and the amendment that the base oil has a %C_P of 80 or greater (amendment (a)).

- 1.10 However, the application as filed is absent any indication or pointer toward the selections (c), (d), (e), (f) and (g), above in combination. Hence, there is no direct and unambiguous disclosure of the claimed combination in the application as filed.
- 1.11 This conclusion applies *a fortiori* since, as set out above, claim 1 does not only result from a combination of sub-ranges, but also requires the specific selection of styrene-diene hydrogenated copolymers selected from a list as set out above for selection b).
- 1.12 Furthermore, as noted by the appellant, selection (a), the requirement that the base oil has a %C_P of 80 or greater only finds basis in paragraph [0032] of the application as filed. This paragraph however relates to a "first embodiment" (paragraph [0012]), comprising a single viscosity index improver, while the further amendments in claim 1 find basis in the application as filed in relation to the "second embodiment" (paragraph [0080], which requires a hydrocarbon-based viscosity improver (which includes styrene-diene hydrogenated copolymers) and a poly(meth)acrylate-based viscosity index improver. Since contested claim 1 however only covers the second embodiment, the selection of a %C_P of 80 or greater from the first embodiment amounts to an intermediate generalisation of this feature which itself infringes Article 123(2) EPC.
- 1.13 The respondent's arguments to the contrary failed to convince the board.
- 1.13.1 The respondent argued during oral proceedings that claim 1 met the requirements of Article 123(2) EPC, essentially because decision T 1511/07 did not apply to

the present case. This decision was addressed in the decision under appeal (point 2.3.1.2, second and third paragraphs) as well as in the communication of the board pursuant to Article 15(1) RPBA, in which the board agreed with the conclusions of the deciding board in T 1511/07 and held that the same reasoning and conclusion applied to the facts of the present case.

- 1.13.2 In T 1511/07, it was essentially concluded that the selection of explicitly disclosed borderline values defining several ranges in order to form a new (narrower) sub-range was not objectionable under Article 123(2) EPC when the ranges belong to the same list. However, the combination of an individual range from this list with another individual range emerging from a second list of ranges and relating to a different feature was not considered to be disclosed in the application as filed unless there was a clear pointer to such a combination (reasons for the decision, 2.1).
- 1.13.3 Even though the opposition division concluded that the requirements of Article 123(2) EPC were met, it essentially stated in relation to T 1511/07 that it was the principles of the gold standard rather than the rationale of a single decision which were to be applied. As stated in its communication pursuant to Article 15(1) RPBA (point 1.5), the board endorses this view.
- 1.13.4 Hence, independently of whether the rationale of T 1511/07 is directly applicable to the present case, the amendments set out in claim 1 do not meet the gold standard as set out above, and hence fail to meet the requirements of Article 123(2) EPC.

- 1.14 For the sake of completeness however, the respondent's arguments as regards decision T 1511/07 are briefly addressed in the following.
- 1.14.1 The respondent argued at oral proceedings that the rationale of T 1511/07, which concerned a claim directed to a specific chemical compound, could not be extended to claims concerning compositions such as in the present case. In support of its position, the respondent referred in passing to decisions T 119/15, T 1451/10 and T 1217/13. Since the respondent neither provided specific arguments nor cited specific passages in relation to these decisions, the board will address them only briefly.
- 1.14.2 In T 119/15 the claim under consideration was directed to a polymer laminate. Although the board stated that T 1511/07 did not apply to the case under consideration (reasons for the decision, point 2, final paragraph, page 13), it nevertheless concluded that the relevant claim infringed Article 123(2) EPC because the separate features of the claim defining certain molar range ratios were not disclosed in combination as constituting a preferred feature of the application as filed. Therefore the selection of said molar ratios in combination was not permissible (reasons for the decision, point 2, first paragraph). Hence, despite not applying T 1511/07, this decision appears to apply the gold standard to arrive at the conclusion that Article 123(2) EPC is infringed. Hence, it does not appear to contradict the board's view set out above.
- 1.14.3 In decision T 1451/11, the claim in question was amended compared to the originally disclosed claim in the limitation of two specific values. This situation is not comparable to that underlying present claim 1

which comprises seven separate amended features (a) to (g) as set out above.

1.14.4 In decision T 1217/13, the claim in question concerned a coated article comprising several layers. The amendments in question concerned the addition of two features in claim 1 related to ranges. In relation to compliance with Article 123(2) EPC, that case was distinguished from T 1511/07 in that ranges introduced into the claim were disclosed as such in the application as filed and both were said to be "more preferred", i.e. originating from the same level of preference. Hence, it was concluded that there was a clear pointer towards the claimed combination (reasons for the decision, point 6.4, third paragraph). This is not the situation underlying present claim 1, and therefore this decision also does not support the respondent's position.

1.15 Hence, claim 1 of the main request fails to meet the requirements of Article 123(2) EPC.

First auxiliary request

2. Article 123(2) EPC

2.1 Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the amount range of styrene-diene viscosity improver is amended from 0.1-15.0 % by mass to 0.5-13.0 % by mass.

2.2 As set out above for the main request under selection (f), 0.1-15 % by mass is the broadest range disclosed in paragraph [0095] of the application as filed, while the amended range 0.5-13.0 % corresponds to the "preferable" range.

2.3 This amendment does not alter the board's view set out in relation to claim 1 of the main request. It remains the case that claim 1 comprises a combination of ranges for different features, selected from different levels of preference in the application as filed, and hence for this reason alone does not meet the gold standard. Furthermore, the same applies as set out above as regards the main request for amendments (a) and (b). Indeed, the respondent failed to submit any further arguments in support of Article 123(2) EPC compared to claim 1 of the main request.

2.4 Consequently, claim 1 of the first auxiliary request fails to meet the requirements of Article 123(2) EPC for the same reasons as provided for the main request.

Second auxiliary request

3. Article 123(2) EPC

3.1 Claim 1 of the second auxiliary request differs from claim 1 of the main request in that a lower limit of 1 was introduced for the PSSI value of the styrene-diene viscosity index improver.

3.2 This addition does not affect the selections required from the application as filed to arrive at claim 1 of this request as set out for claim 1 of the main request.

3.3 Furthermore, the respondent failed to submit any further arguments in support of Article 123(2) EPC compared to claim 1 of the main request.

- 3.4 Consequently, claim 1 of the second auxiliary request fails to meet the requirements of Article 123(2) EPC for the same reasons as provided for the main request.

Third auxiliary request

4. Article 123(2) EPC
- 4.1 Claim 1 of the third auxiliary request differs from claim 1 of the main request in it includes the amendments carried out to the respective claim 1 of the first and second auxiliary requests.
- 4.2 As set out for claim 1 of the first and second auxiliary requests, this amendment does not alter the board's view set out in relation to claim 1 of the main request. Indeed, the respondent failed to submit any further arguments in support of Article 123(2) EPC compared to claim 1 of the main request.
- 4.3 Consequently, claim 1 of the third auxiliary request fails to meet the requirements of Article 123(2) EPC for the same reasons as provided for the main request.

Auxiliary request 4 to 6

5. Admittance - Article 13(2) RPBA
- 5.1 The set of claims of auxiliary requests 4 to 6 were submitted by the respondent with the letter dated 25 May 2023, approximately three weeks before oral proceedings before the board.
- 5.2 The appellant requested that auxiliary requests 4 to 6 not be admitted into the proceedings pursuant to Article 13(2) RPBA 2020.

- 5.3 According to this provision, any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
- 5.4 The respondent submitted that the new requests were a direct reply to the board's opinion set out in its communication pursuant to Article 15(1) RPBA that claim 1 of the main request and the first to third auxiliary requests failed to meet the requirements of Article 123(2) EPC.
- 5.5 However, as stated by the appellant at oral proceeding, the issues addressed by the board in its communication in relation to Article 123(2) EPC were not new and had been raised by the appellant in point 5 of its statement of grounds of appeal, submitted in July 2019, almost four years before oral proceedings before the board. Furthermore, when requested by the board, the respondent was unable to identify the alleged specific issues raised for the first time with the board's communication, justifying the subsequent filing of auxiliary requests 4 to 6.
- 5.6 Consequently, there are no exceptional circumstances in the meaning of Article 13(2) RPBA justifying the admittance of auxiliary requests 4 to 6. Indeed, there is no reason why these requests could not have been submitted at the latest in the respondent's reply to the statement of grounds of appeal with which the relevant issues were first raised in appeal proceedings.

- 5.7 The respondent also argued that the amendments in auxiliary requests 4 to 6 were easy to comprehend and did not shift the discussion, in particular in relation to inventive step.
- 5.8 However, while these considerations are relevant to the issue of admittance under Article 13(1) RPBA, they are not taken into consideration in exercising the discretion of the board according to Article 13(2) RPBA.
- 5.9 For these reasons, the board decided not to admit auxiliary requests 4 to 6 into the proceedings pursuant to Article 13(2) RPBA.

Auxiliary request 7

6. Article 123(2) EPC
- 6.1 Claim 1 of auxiliary request 7 differs from claim 1 of the main request in that the range of the weight-average molecular weight of the poly(meth)acrylate-based viscosity index improver is amended from 5,000 - 700,000 to 5,000 - 100,000.
- 6.2 As set out above for the main request under selection (d), 5,000 - 700,000 represented the "preferable" upper and lower values provided in paragraph [0091] of the application as filed. The amended range of 5,000-100,000 in claim 1 of auxiliary request 7 however combines the "preferred" lower value of 5,000 with the "most preferred" upper value of 100,000.
- 6.3 This amendment does not alter the board's view set out in relation to claim 1 of the main request. It remains the case that claim 1 comprises a combination of

features, selected from different levels of preference in the application as filed, and hence does not meet the gold standard. Indeed, the respondent failed to submit any further arguments in support of Article 123(2) EPC compared to claim 1 of the main request.

6.4 Consequently, claim 1 of auxiliary request 7 fails to meet the requirements of Article 123(2) EPC for the same reasons as provided for the main request.

7. Conclusion

Since the respondent's requests which are part of these proceedings are not allowable, the patent is to be revoked.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



M. Schalow

M. O. Müller

Decision electronically authenticated