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**Datasheet for the decision
of 12 December 2022**

Case Number: T 2219/19 - 3.3.02

Application Number: 08738775.9

Publication Number: 2141220

IPC: C10M163/00, C10M139/00,
C10M159/20, C10N30/04,
C10N40/25

Language of the proceedings: EN

Title of invention:
LUBRICANT COMPOSITION

Patent Proprietor:
Idemitsu Kosan Co., Ltd.

Opponent:
Afton Chemical Corporation

Headword:

Relevant legal provisions:
EPC Art. 100(c), 56
RPBA Art. 12(4)

Keyword:

Grounds for opposition - added subject-matter (yes)

Inventive step - (no)

Late-filed evidence - admitted (no)

Late-filed requests - admitted (no)

Decisions cited:

T 0026/85, T 0871/07

Catchword:



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Case Number: T 2219/19 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 12 December 2022

Appellant: Idemitsu Kosan Co., Ltd.
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Respondent: Afton Chemical Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 29 May 2019
revoking European patent No. 2141220 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: M. Maremonti
K. Kerber-Zubrzycka

Summary of Facts and Submissions

- I. The appeal lodged by the patent proprietor ("appellant") lies from the decision of the opposition division to revoke European patent No. 2 141 220 ("the patent").
- II. The patent as granted contains five claims, independent claim 1 reading as follows:
- "1. Use of a lubricating oil composition in an internal combustion engine,*
- wherein the internal combustion engine uses a fuel that contains at least one fat and oil selected from a group consisting of natural fat and oil, hydrotreated natural fat and oil, transesterified natural fat and oil and hydrotreated transesterified natural fat and oil, the lubricating oil composition comprising:*
- a base oil;*
- a component (A), which is a boron derivative of a succinimide compound substituted by an alkyl or alkenyl group having a number average molecular weight of 200 to 5000, wherein a mass ratio (B/N) of boron (B) and nitrogen (N) contained in the component (A) is 0.6 or more, wherein the component (A) is contained by 0.01 to 0.2 mass% in terms of boron of a total amount of the composition; and*
- a component (B), which is an alkaline earth metal-based detergent, which is contained by 0.01 mass% to 0.35 mass% in terms of alkaline earth metal of the total amount of the composition."*
- III. The opposition had been filed on the grounds under Article 100(a) to (c) EPC. The following documents D1/

D1a and D15 were referred to, *inter alia*, during the opposition proceedings:

D1: JP 2004 2697 07

D1a: English translation of D1

D15: Directive 2003/30/EC of the European Parliament and of the Council, 8 May 2003

IV. The opposition division came, *inter alia*, to the following conclusion on the then-pending main request (patent as granted) and auxiliary requests 1 and 2:

- the ground for opposition under Article 100(c) EPC did not prejudice the maintenance of the patent as granted;
- the subject-matter of claim 1 as granted and of claim 1 of auxiliary requests 1 and 2 did not involve an inventive step in view of D1 taken as the closest prior art.

V. In its statement of grounds of appeal, the appellant contested the opposition division's reasoning, and argued, *inter alia*, that the claimed subject-matter involved an inventive step. It corroborated its submissions by relying on the following new items of evidence:

A031: Agarwal, Bijwe, Das, "*Wear Assessment in a Biodiesel Fueled Compression Ignition Engine*", *Journal of Engineering for Gas Turbines and Power*, 125 (2003), pages 820 to 826.

A032: Bijwe, Sharma and Agarway, "*Assessment of Lubricity of Biodiesel Blends in Reciprocating Wear Mode*", *SAE Transactions*, Vol. 113, Section 4: JOURNAL OF FUELS AND LUBRICANTS (2004), abstract.

In section 1.5.2 on page 12 of the statement of grounds of appeal, the appellant further referred to new experimental data carried out according to Attachment A annexed to the statement of grounds of appeal. Additionally, it submitted sets of claims according to auxiliary requests 1, 2, 2a and 3 to 28.

- VI. In its reply to the appeal, the opponent ("respondent") argued, *inter alia*, that the subject-matter of claim 1 as granted extended beyond the content of the application as filed. Moreover, it lacked inventive step in view of D1 taken as the closest prior art. The respondent also objected to the admittance of all the auxiliary requests except auxiliary request 17, and to the admittance of A031, A032 and the new experimental data of the appellant. It also raised objections to patentability of the auxiliary requests.
- VII. In a subsequent letter dated 19 August 2021, the appellant rebutted the respondent's arguments. Moreover, it filed new sets of claims in accordance with auxiliary requests 5 and 17 to 28 to replace the corresponding auxiliary requests filed previously.
- VIII. The parties were summoned to oral proceedings as per their requests. In preparation for the oral proceedings, the board issued a communication under Article 15(1) RPBA 2020 in which it expressed, *inter alia*, the preliminary opinion that the grounds for opposition under Article 100(a) and (c) EPC prejudiced the maintenance of the patent as granted. In particular, the subject-matter of claim 1 as granted appeared to lack inventive step in view of D1 taken as the closest prior art. Moreover, the board provisionally held that none of the auxiliary requests except auxiliary request 17 should be admitted into the proceedings. Additionally, claim 1 of auxiliary request

17 appeared to lack inventive step for the same reasons as claim 1 as granted.

- IX. By a subsequent letter, the respondent objected, *inter alia*, to the admittance of the new auxiliary requests 5 and 18 to 28.
- X. By letter dated 16 November 2022, the appellant announced that it would not be attending the oral proceedings. No arguments in reply to the preliminary opinion of the board were submitted.
- XI. By a subsequent communication, the board cancelled the oral proceedings.
- XII. Final requests relevant to the decision

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request). Alternatively, it requested that the patent be maintained on the basis of the claims according to one of auxiliary requests 1, 2, 2a and 3 to 28, wherein auxiliary requests 1, 2, 2a, 3, 4 and 6 to 16 have been filed with the statement of grounds of appeal, and auxiliary requests 5 and 17 to 28 have been filed by the letter dated 19 August 2021. The appellant further requested that documents A031 and A032 as well as the new experimental data mentioned in section 1.5.2 on page 12 of its grounds of appeal, which were carried out in accordance with Attachment A to the grounds of appeal, be admitted into the proceedings.

The respondent requested that the appeal be dismissed, meaning that revocation of the patent be confirmed. It further requested that none of the auxiliary requests except auxiliary request 17 be admitted into the proceedings. The respondent also requested that documents A031, A032 and the experimental data discussed in section 1.5.2 on page 12 of the statement

of grounds of appeal not be admitted into the proceedings.

XIII. The appellant's submissions relevant to the present decision are summarised as follows. See the reasons for the decision below for further details.

Article 100(c) EPC

- The term "Yushi" used in the PCT application written in Japanese had been incorrectly translated using the term "fat and oil". Instead, this term should have been corrected to be "fat/oil".

A031, A032 and the experimental data discussed in section 1.5.2 on page 12 of the statement of grounds of appeal - admittance

- A031, A032 and new experimental data representing a reworking of example 4 of D1 had been filed as a direct reaction to the opposition division's position in the appealed decision that D1 could be regarded as the closest prior art.
- Therefore these items of evidence should be admitted into the proceedings.

Inventive step

- Document D1 did not represent a suitable starting point for assessing inventive step.
- Even when starting from D1, the skilled person would not have been prompted to add biodiesel to the fuel of the internal combustion engine in which the compositions of D1 were used.
- It had to be concluded that the claimed subject-matter involved an inventive step.

Auxiliary requests - admittance

- The auxiliary requests represented a direct reaction to objections raised by the opposition division and by the respondent.
- Only a few amendments had been introduced into the auxiliary requests. Therefore the auxiliary requests should be admitted into the proceedings.

Auxiliary request 17 - inventive step

- The subject-matter of claim 1 of auxiliary request 17 involved an inventive step for the same reasons as claim 1 as granted.

XIV. The respondent's submissions relevant to the present decision are summarised as follows:

Article 100(c) EPC

- The term "*fat and oil*" included in claim 1 as granted did not have any basis in the application as filed in Japanese. At least for this reason, the claimed subject-matter extended beyond the content of the application as filed.

A031, A032 and the experimental data discussed in section 1.5.2 on page 12 of the statement of grounds of appeal - admittance

- The argument that A031, A032 and the new experimental data discussed in the grounds of appeal constituted a reaction to the selection of D1 as the closest prior art by the opposition division could not be accepted.
- D1 had been used as the closest prior art by the appellant itself in its reply to the notice of opposition.

- Therefore these items of evidence could and should have been filed before the opposition division. Hence they should not be admitted into the appeal proceedings.

Inventive step

- Document D1 might be regarded as the closest prior art since it also concerned engine oils providing high-temperature detergency and suitable for being used in diesel engines.
- The only possible distinguishing feature was represented by the "*fat and oil*" component of the fuel used in the internal combustion engine as defined in claim 1.
- The objective technical problem deriving from this distinguishing feature could be formulated as being how to select a fuel to be used when the lubricant composition of D1 was employed in a diesel engine, regardless of the actual suitability of the fuel for diesel engines.
- At the effective date of the patent there was a global trend to blend some biodiesel into diesel fuels. This was evidenced e.g. by D15. Therefore it would have been obvious to include some biodiesel in the fuel of the diesel engines in which the composition of D1 was used. It was known that biodiesel included transesterified natural oils.
- It had to be concluded that the subject-matter of claim 1 as granted lacked inventive step.

Auxiliary requests - admittance

- All the auxiliary requests 1, 2, 2a, 3 to 16 and 18 to 28 had been filed for the first time in the appeal proceedings.

- All these auxiliary requests should be held inadmissible because they could and should have been filed before the opposition division.
- Especially the argument that these requests constituted a reaction to new objections contained in the appealed decision might not be accepted, as the objections referred to by the appellant had already been raised by the respondent in the notice of opposition.
- Auxiliary requests 6 to 8 and 19 had been filed before the opposition division and then withdrawn. For this reason too, they should not be admitted.

Auxiliary request 17 - inventive step

- The feature introduced in claim 1 of auxiliary request 17 expressing that the B/N mass ratio contained in component (A) was "*0.8 or more*" was known from D1.
- It followed that the same objection of lack of inventive step of claim 1 as granted applied to claim 1 of auxiliary request 17.

Reasons for the Decision

Need to hold oral proceedings

1. As set out above, the appellant informed the board that it would not be attending the oral proceedings. This implies a withdrawal of the appellant's request for oral proceedings originally made in its statement of grounds of appeal (see e.g. T 871/07, point 2 of the reasons). A decision can thus be taken against the appellant without any need for oral proceedings.

Main request - patent as granted - claim 1 - ground for opposition under Article 100(c) EPC - added subject-matter

2. The patent is based on an application originally filed under the PCT in Japanese.
- 2.1 The appellant (letter dated 19 August 2021, page 6, point 3.2) submitted that the term "Yushi" used in the PCT application written in Japanese, especially in claim 1 of this application, had been incorrectly translated using the term "*fat and oil*", see, *inter alia*, claim 1 as granted (point II above). Instead, this term should have been corrected to be "*fat/oil*".
- 2.2 The respondent argued that the above amendment led to an extension of the claimed subject-matter beyond the content of the application as filed.
- 2.3 The board notes that, on the basis of the appellant's above submission, the appellant acknowledges that the term "*fat and oil*" in claim 1 as granted does not have any basis in the application originally filed in Japanese. No claim request containing the amendment of this term to "*fat/oil*", corresponding to the correct translation according to the appellant, has been filed. This opinion of the board was already mentioned in the communication issued by the board under Article 15(1) RPBA 2020. No reply contesting this provisional finding has been filed by the appellant.
- 2.4 Therefore the board concludes that the inclusion of the term "*fat and oil*" in claim 1 as granted leads to an extension of the subject-matter of claim 1 beyond the content of the application as filed in Japanese. For this reason, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted. For this reason alone, the appellant's main request is not allowable.

Documents A031 and A032 and experimental data discussed in section 1.5.2 on page 12 of the statement of grounds of appeal carried out as described in Attachment A annexed thereto - admittance into the proceedings

3. To corroborate its case on inventive step in view of D1 taken as the closest prior art, the appellant filed new items of evidence represented by documents A031 and A032 and experimental data contained in section 1.5.2 on page 12 of the statement of grounds of appeal having been carried out as described in Attachment A annexed thereto. The experimental data were based on a reworking of example 4 of D1.

The respondent requested that these items of evidence not be admitted into the proceedings.

4. Under Article 12(4) RPBA 2007, applicable in the current case in accordance with Articles 24 and 25(1) and (2) RPBA 2020, the board has the discretion to hold inadmissible *inter alia* items of evidence which could have been presented before the opposition division.
 - 4.1 The appellant argued that documents A031 and A032 and the new experimental data had been filed as a first reaction to the opposition division's position that D1 could be regarded as the closest prior art.
 - 4.2 However, D1 had been used as the closest prior art by the respondent already in its notice of opposition (section 14, starting at page 16). Moreover, the appellant too in its reply to the notice of opposition (page 8, 4th paragraph, to page 10) argued inventive step *inter alia* when starting from D1.
 - 4.3 Therefore the fact that the opposition division accepted the respondent's argument that D1 could represent the closest prior art cannot be surprising to the appellant, who could and should have filed

documents A031 and A032 and the new experimental data carried out as described in Attachment A already before the opposition division.

4.4 This opinion of the board was already mentioned in the communication issued by the board under Article 15(1) RPBA 2020. No reply contesting this provisional finding has been filed by the appellant.

4.5 The board notes that the admittance of documents A031 and A032 and the new experimental data carried out as described in Attachment A would have led to an entirely *fresh case* on inventive step to be discussed in appeal proceedings for the first time. This would have gone against the primary object of the appeal proceedings, to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020) and not to represent a second round of the opposition proceedings before the opposition division.

4.6 For these reasons, the board decides not to admit into the proceedings documents A031 and A032 and the new experimental data discussed in section 1.5.2 on page 12 of the statement of grounds of appeal carried out as described in Attachment A annexed thereto, pursuant to Article 12(4) RPBA 2007.

Main request - patent as granted - claim 1 - ground for opposition under Article 100(a) EPC - inventive step under Article 56 EPC

5. Closest prior art

5.1 In line with the appealed decision (point 7.3, pages 12 and 13), the respondent objected to inventive step of the subject-matter of claim 1 as granted in view of, *inter alia*, D1 taken as the closest prior art.

5.2 The appellant contested the selection of D1 as the closest state of the art. It argued that D1 concerned the use of lubricating compositions for motorbikes. The purpose of the compositions of D1 was to increase the coefficient of static friction between the clutch disc and clutch plate. This was different from the purpose described in the patent, which addressed the problem of biodiesel accumulating in the oil of diesel engines, thus affecting engine-part detergency at high temperature. The appellant acknowledged that D1 also mentioned diesel engines. However, such a reference was purely speculative and thus not to be considered. The appellant referred in this respect to decision T 0026/85, point 7 of the reasons.

5.3 The board finds these arguments unconvincing. It is first noted that claim 1 as granted (point II above) is not restricted to a use in diesel engines, but generally refers to the use of the defined composition in an internal combustion engine.

Moreover, document D1 (reference is made to D1a) discloses a lubricating composition for use in an internal combustion engine, *inter alia* gasoline and diesel engines, as both lubricating oil and transmission lubricating oil (paragraphs [0001] and [0006]). Exemplary lubricating compositions are disclosed in table 1 in paragraph [0018] of D1. Examples 1, 3 and 4 refer to compositions comprising, *inter alia*, a boron-modified succinimide A with a polybutenyl group of molecular weight 1000, a boron content of 1.9 mass% and having a B/N mass ratio of 0.83 (footnote 4): this compound corresponds to component (A) of claim 1 as granted. The compositions of examples 1, 3 and 4 further comprise a calcium-based detergent with a calcium content of 5 mass% (footnote 3): this compound corresponds to component (B) of

claim 1 as granted. It is undisputed that said boron-modified succinimide A and calcium-based detergent are included in the compositions of examples 1, 3 and 4 of D1, in an amount falling within the ranges required by claim 1. The compositions of examples 1, 3 and 4 further include a paraffinic mineral oil as base lubricating oil (footnote 1): this compound corresponds to the base oil of claim 1 as granted.

Additionally, the examples of D1 (see paragraph [0020]) are concerned not only with an increase in the coefficient of static friction but also with the improvement of the high-temperature detergency, an aim shared with the patent (see paragraphs [0009], [0051] and [0069] of the patent).

5.4 The appellant referred to decision T 0026/85, point 7 of the reasons, stating that *"When drafting a patent specification and claims, applicants not unreasonably tend to define the limits of the protection they are seeking as broadly as possible. Thereby quite often some parts of a broadly claimed range of values of a certain parameter, although formally included, appear at least at first sight to be speculative and of a less practical relevance than other parts"*. However, in view of the above-mentioned disclosure in D1, the reference in D1 to a use of the lubricating composition disclosed therein in diesel engines as well cannot be regarded as speculative. Thus the above statement made in T 0026/85 is not relevant to the case at hand.

5.5 For these reasons, the board considers document D1 a suitable starting point for assessing inventive step.

6. Distinguishing feature

The respondent identified, as the only possible feature distinguishing the subject-matter of claim 1 as granted from D1, the use in the internal combustion engine of a

fuel containing "*at least one fat and oil selected from a group consisting of natural fat and oil, hydrotreated natural fat and oil, transesterified natural fat and oil and hydrotreated transesterified natural fat and oil*" (point II above). This has not been disputed by the appellant.

7. Objective technical problem

In view of the above distinguishing feature, the respondent formulated the objective technical problem as being how to select a fuel to be used when the lubricant composition of D1 was employed in a diesel engine, regardless of the actual suitability of the fuel for diesel engines. No formulation of a technical problem when starting from D1 has been proposed by the appellant. In view of this, and since the board does not see any reason to depart from the formulation of the technical problem suggested by the respondent, this formulation is accepted by the board. The objective technical problem is thus how to select a fuel to be used when the lubricant composition of D1 is employed in a diesel engine, regardless of the actual suitability of the fuel for diesel engines.

8. Obviousness of the claimed solution

8.1 The appellant argued that the skilled person would not have selected a "*fat and oil*" within the meaning of claim 1 as granted, e.g. a biodiesel fuel, as the fuel of the engine to be run with the compositions of D1. It was common general knowledge that diesel fuels were not used in motorbikes. Moreover, the addition of biodiesel fuel to conventional fuels led to a decrease in the coefficient of static friction as demonstrated by A031, A032 and the new experimental results reported in section 1.5.2 on page 12 of the statement of grounds of appeal. This decrease would have been contrary to the

aim of D1. Thus the claimed subject-matter was not obvious.

8.2 The board disagrees. As already stated above, the disclosure in D1 (*loc. cit.*) is not limited to the use of the described compositions in motorbikes. The use in diesel engines to improve high-temperature detergency is explicitly envisaged. As regards A031, A032 and the new experimental results reported in section 1.5.2 on page 12 of the statement of grounds of appeal, these items of evidence were not admitted into the proceedings for the reasons given above. Therefore they must remain unconsidered.

8.3 The board concurs with the respondent that at the effective date of the patent there was a global trend to blend some biodiesel into diesel fuels, see for example D15 (pages L 123/44 and L 123/45). Therefore, faced with the above-mentioned technical problem, the skilled person would have been prompted to select a diesel fuel containing a certain amount of biodiesel when the lubricating compositions of D1 were used in diesel engines. It is undisputed that biodiesel includes transesterified natural oils within the meaning of claim 1 as granted. Therefore the skilled person would have arrived at the subject-matter of claim 1 as granted without exercising any inventive skill.

8.4 This opinion of the board was already mentioned in the communication issued by the board under Article 15(1) RPBA 2020. No reply contesting this provisional finding has been filed by the appellant.

8.5 For these reasons, the board concludes that the subject-matter of claim 1 as granted does not involve an inventive step in view of D1 taken as the closest prior art (Article 56 EPC). Therefore the ground for

opposition under Article 100(a) EPC prejudices the maintenance of the patent as granted. For this reason too, the appellant's main request is not allowable.

Auxiliary requests 1, 2, 2a, 3 to 16, 18 to 28 - admittance into the proceedings

9. All the appellant's auxiliary requests have been filed for the first time in appeal proceedings. The respondent requested that none of the auxiliary requests except auxiliary request 17 be admitted into the proceedings.
- 9.1 Under Article 12(4) RPBA 2007, the board has the discretion to hold inadmissible *inter alia* requests which could have been presented in the proceedings before the opposition division even though they were presented with the statement of grounds of appeal, relate to the case under appeal and meet the requirements of Article 12(2) RPBA 2007.
- 9.2 The appellant argued that auxiliary requests 1, 2, 2a, 9 to 16 and 21 to 28 defined the claimed use in more detail as relating to the reduction of fouling. These requests represented the first reaction to the opposition division's objection in point 7.2.2 of the appealed decision that "*a very general use in an internal combustion engine is claimed*". In other auxiliary requests (auxiliary requests 6, 11 to 16, 18 to 20, 23 to 28), the term "*of lubricating oil*" had been reinserted after the feature "*a base oil*". This amendment was filed as a precautionary measure in case the board accepted the corresponding objection under Article 123(2) EPC of the respondent. In other auxiliary requests (auxiliary requests 4, 7, 8 and 13 to 28), the "*fat and oil*" component had been restricted or further specified. This amendment was filed as a precautionary measure in case the board accepted

corresponding novelty objections of the respondent. No reasons for filing auxiliary requests 3 and 5 only in appeal have been provided. In summary, the appellant argued that only a few amendments had been introduced, and thus the auxiliary requests should have been admitted into the proceedings.

9.3 The board disagrees for the following reasons.

9.3.1 As pointed out by the respondent, the argument that claim 1 did not define a specific use had been raised by the respondent in its notice of opposition, page 4, points 4.3 and 4.4. In point 7.2.2 of the appealed decision referred to by the appellant, the opposition division merely accepted this argument after assessing the scope of protection of claim 1 as granted. Therefore no new objection was raised by the opposition division which would have justified the filing of auxiliary requests 1, 2, 2a, 9 to 16 and 21 to 28. Requests aiming to overcome the respondent's argument not only could but also should have been filed before the opposition division.

9.3.2 As regards the reinsertion of the term "*of lubricating oil*" and the restriction or further specification of the "*fat and oil*" component of claim 1, corresponding objections of added subject-matter and novelty had also been raised by the respondent in its notice of opposition (points 18.1, 18.2 and 4.7, 4.8, respectively). Therefore auxiliary requests aiming to overcome these respondent's objections not only could but also should have been filed before the opposition division.

9.3.3 Furthermore, it has not been disputed by the appellant that auxiliary requests 6 to 8 and 19 correspond to auxiliary requests that have previously been withdrawn. The appellant argued that it had withdrawn these

requests in view of the statement made by the opposition division that the findings concerning the main request would also have applied to these auxiliary requests. However, there is no doubt that these requests could have been filed before the opposition division since they were actually filed and thereafter withdrawn. By withdrawing these requests, the appellant has avoided a decision of the opposition division on these requests.

9.3.4 The board further notes that in claim 1 of auxiliary requests 2, 2a, 3, 7 to 16 and 19 to 28, the following features were added, either alone or in combination:

- *"wherein the fouling is generated by degradation and decomposition of the at least one fat and oil",*
- *"wherein the fouling is generated by degradation and decomposition of biofuel",*
- *"internal combustion engine provided with a diesel particulate filter",*
- *"wherein the at least one fat and oil is biofuel",*
- *"at least one fat and oil selected from a group consisting of animal-derived or plant-derived fat and oil, hydrotreated animal-derived or plant-derived fat and oil, transesterified animal-derived or plant-derived fat and oil and hydrotreated and transesterified animal-derived or plant-derived fat and oil".*

These features are taken from the description of the patent (see e.g. paragraphs [0006], [0009], [0010], [0068] and [0069]). Therefore, by admitting these auxiliary requests, entirely new issues (*fresh case*) would have had to be considered for the first time in appeal proceedings. More specifically, objections to added subject-matter under Article 123(2) and (3) EPC

and clarity under Article 84 EPC have, *inter alia*, been raised by the respondent. Thus the admittance of these auxiliary requests would have gone against the primary object of the appeal proceedings, to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020). The appellant should not be provided with the possibility of using the appeal proceedings as if they were a second round of proceedings before the opposition division.

9.4 For the reasons set out above, the board decides not to admit auxiliary requests 1, 2, 2a, 3 to 16 and 18 to 28 into the proceedings, pursuant to Article 12(4) RPBA 2007.

9.5 This opinion of the board was already mentioned in the communication issued by the board under Article 15(1) RPBA 2020. No reply contesting this provisional finding has been filed by the appellant.

10. It is incidentally noted that claim 1 according to all the auxiliary requests 1, 2, 2a, 3 to 16 and 18 to 28 suffers from the same deficiency as claim 1 as granted, derived from the inclusion of the term "*fat and oil*" (points 2.3 and 2.4 above). In view of this inclusion, if admitted, the subject-matter of claim 1 of these auxiliary requests would have been found to extend beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

Auxiliary request 17 - claim 1 - inventive step under Article 56 EPC

11. Claim 1 of auxiliary request 17 differs from claim 1 as granted in that the at least one fat and oil is selected from a group consisting of "*transesterified natural fat and oil and hydrotreated transesterified*

natural fat and oil" and in that the B/N mass ratio contained in component (A) is stated to be 0.8 or more.

11.1 As mentioned above under the issue of inventive step of claim 1 as granted, examples 1, 3 and 4 of D1 disclose compositions comprising, *inter alia*, a boron-modified succinimide A with a polybutenyl group of molecular weight 1000, a boron content of 1.9 mass% and having a B/N mass ratio of 0.83. This B/N mass ratio thus falls under the definition of component (A) included in claim 1 of auxiliary request 17. Moreover, it is undisputed that biodiesel includes transesterified natural oils.

11.2 It follows that the same observations by the board as regards lack of inventive step of claim 1 as granted apply *mutatis mutandis* to claim 1 of auxiliary request 17. This opinion of the board was already mentioned in the communication issued by the board under Article 15(1) RPBA 2020. No reply contesting this provisional finding has been filed by the appellant.

11.3 Therefore the board concludes that the subject-matter of claim 1 of auxiliary request 17 does not involve an inventive step for the same reasons as claim 1 as granted (Article 56 EPC). Hence auxiliary request 17 is not allowable.

Conclusion

12. None of the appellant's claim requests is admissible and allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated