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**Datasheet for the decision
of 27 October 2022**

Case Number: T 2416/19 - 3.3.02

Application Number: 14713797.0

Publication Number: 2981595

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C07C9/00, C10L1/06, C11B3/00

Language of the proceedings: EN

Title of invention:
RENEWABLE HYDROCARBON COMPOSITION

Patent Proprietor:
UPM-Kymmene Corporation

Opponents:
Polski Koncern Naftowy ORLEN S.A.
Neste Oyj

Headword:

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 13(2)

Keyword:

Inventive step
Amendment after summons

Decisions cited:

Catchword:



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Case Number: T 2416/19 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 27 October 2022

Appellant: UPM-Kymmene Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 12 July 2019
revoking European patent No. 2981595 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: S. Bertrand
 K. Kerber-Zubrzycka

Summary of Facts and Submissions

I. The appeal by the patent proprietor ("appellant") lies from the opposition division's decision to revoke European patent No. 2 981 595.

II. The following documents are referred to in the present decision:

D3a US 2012/143613 A1

D15 WO 2012/069706 A2

D29 E.E. McSweeny *et al.*, "Tall Oil and Its Uses-II", Pulp Chemical Association, Inc., 1987, 12-9

D33 Abstract of J. Kirkinen *et al.*, Energy Policy, 38(1), 2010, 301-11

III. In the impugned decision, the opposition division's conclusion was that claim 1 of each of the main request and auxiliary requests 1 to 8 then on file did not involve an inventive step in view of D15 as the closest prior art.

IV. After the statement of grounds of appeal and the replies had been filed, the parties were summoned to attend oral proceedings.

V. The board issued a communication pursuant to Article 15(1) RPBA 2020 in preparation for the oral proceedings scheduled in accordance with the parties' requests.

VI. Oral proceedings before the board were held in person on 27 October 2022 in the presence of the appellant and respondents (opponents 1 and 2).

VII. The parties' relevant requests are as follows.

The appellant requested that:

- the decision under appeal be set aside and that the patent be maintained on the basis of the main request or
- alternatively, on the basis of one of auxiliary requests 1 to 10, all claim requests filed with the statement of grounds of appeal

The main request in appeal is identical to the main request before the opposition division. Auxiliary requests 1 to 5 and 7 to 9 correspond to auxiliary requests 1 to 8 considered by the opposition division in its decision. Auxiliary requests 6 and 10 constituted new requests not relied upon before the opposition division.

The respondents requested that:

- the appeal be dismissed
- auxiliary requests 6 and 10 not be admitted into the appeal proceedings
- documents D3a and D33 be admitted into the appeal proceedings

VIII. The appellant's case relevant to the present decision may be summarised as follows.

Main request - inventive step

- Considering D15 as the closest prior art, the distinguishing feature of claim 1 of the main request was the presence and the amounts of the hydrocarbon components identified in claim 1 of the main request.
- The objective technical problem was the provision of an alternative renewable naphtha fuel.
- The solution proposed by claim 1 was not obvious. For details, reference is made to the Reasons.

Auxiliary request 9

- The feedstock inserted in claim 1 of auxiliary request 9 was representative of the example of the patent.
- The feedstock was not obvious in view of either D15 or common general knowledge represented by D29.

IX. The respondents' case relevant to the present decision may be summarised as follows.

Main request - inventive step

- D15 was the closest prior art.
- The distinguishing feature of claim 1 of the main request was the presence and the amounts of the hydrocarbon components identified in claim 1 of the main request.
- The appellant's submissions on compatibility; on the importance of the neutral components of tall oil and the type of wood from which tall oil was

produced to solve the objective technical problem; and on the theory that the heaviest part of the tall oil, constituted by neutral components, resulted in branched alkanes by splitting off the linear part of the neutral components were allegations of fact. These allegations of fact constituted a new line of defence for the appellant that amended the appellant's case. The allegations of fact should not be admitted into the appeal proceedings.

- The appellant's submission that not all tall oils could solve the objective technical problem should not be admitted into the appeal proceedings.
- The objective technical problem was the provision of an alternative renewable naphtha fuel.
- The solution proposed by claim 1 was obvious. The feedstock, the catalyst system, the hydroprocessing conditions, the ratio of hydrogen to feed, the fractionation conditions and the cracking conditions used in the example of the patent did not lead to any effect. The selections of the feedstock, the catalyst system, the hydroprocessing conditions, the ratio of hydrogen to feed, the fractionation conditions and the cracking conditions used in the example of the patent were not purposive. These were thus arbitrary selections. Arbitrary selections could not contribute to inventive step.

Auxiliary requests 1 to 8, 10

- Auxiliary requests 6 and 10 should not be admitted into the proceedings.

- The objection of lack of inventive step raised for the main request applied to the claims of each of auxiliary requests 1 to 8 and 10.

Auxiliary request 9

- The specification of the feedstock in claim 1 of auxiliary request 9 could not overcome the objection of lack of inventive step.
- The skilled person, in exercising their routine abilities, would have started from any crude tall oil, including that defined in claim 1 of auxiliary request 9. Furthermore, the composition defined in claim 1 of auxiliary request 9 was obvious in view of D29, table 1.

Reasons for the Decision

Main request - inventive step

1. Respondents 1 and 2 objected to inventive step in view of (*inter alia*) D15 as the closest prior art.
2. Claim 1 of the main request reads as follows:

"1. A composition produced from a renewable biological feedstock, the composition comprising 8-30 mass% of C₄₋₁₂ linear alkanes, 20-40 mass% of C₄₋₁₂ branched alkanes, 25-60 mass% of C₅₋₁₂ cycloalkanes, 1-25 mass% of C₆₋₁₂ aromatic hydrocarbons, no more than 1 mass% of alkenes, and no more than 0.5 mass% in total of oxygen-containing compounds;

wherein the total amount of C₄₋₁₂ alkanes is 40-70 mass%, and the total amount of C₄₋₁₂ alkanes, C₅₋₁₂ cycloalkanes and C₆₋₁₂ aromatic hydrocarbons is at least 95 mass%; and wherein the amounts are based on the mass of the composition."

3. D15 as the closest prior art

The patent is concerned with the provision of a composition which contains a variety of hydrocarbons and is obtainable from a renewable biological feedstock (paragraph [0001]). The composition is suitable for use as a petroleum naphtha substitute (paragraph [0007] of the patent).

3.1 D15 relates to a process for producing fuel components from a material of biological origin, i.e. from a renewable biological feedstock. The preferred fuel components of D15 are gasoline and/or naphtha and middle distillate compounds (page 21, lines 21-23 of D15). In other words, the fuel components of D15 are substitutes for petroleum gasoline and/or naphtha and middle distillate.

D15 is thus concerned with the provision of, *inter alia*, a renewable naphtha fuel. This represents the same aim as in the patent. Thus, D15 is a suitable starting point for the assessment of inventive step.

3.2 The respondents relied on examples 2 and 3 of D15. Examples 2 and 3 of D15 disclose the hydroprocessing of crude tall oil. The hydroprocessed products are fractionated to produce a light cut and a mid cut. The properties of the mid cut are summarised in table 3. The mid cut has an initial boiling point of 160.0 °C, meaning that the light cut would have a final boiling point around this value of 160.0 °C and is considered a

naphtha fraction. There is, however, at least no explicit disclosure in examples 2 and 3 of D15 of the presence of:

- (i) C₄₋₁₂ linear alkanes
- (ii) C₄₋₁₂ branched alkanes
- (iii) C₅₋₁₂ cycloalkanes
- (iv) C₆₋₁₂ aromatic hydrocarbons

Furthermore, there is no explicit disclosure in examples 2 and 3 of D15 of the amounts required by claim 1 of the main request for these components.

Moreover, there is no evidence or reason to assume that the process disclosed in examples 2 and 3 of D15 would inevitably lead to these components and amounts as defined in claim 1 of the main request.

3.3 Distinguishing feature

The subject-matter of claim 1 of the main request thus differs from the disclosure of D15 in the presence and in the amounts of the hydrocarbon components identified above.

3.4 Objective technical problem

The patent comprises no comparative data in view of D15, and none were submitted by the appellant showing that any effect is obtained by the above distinguishing features. Thus, as stated in the board's communication under Article 15(1) RPBA, the objective technical problem is the provision of an alternative renewable naphtha fuel.

3.5 Admittance of new allegations of fact

- 3.5.1 During the oral proceedings, the appellant stated that the claimed compositions had a high compatibility with petroleum fuels and non-hydrocarbon fuels such as ethanol. The objective technical problem had thus to be changed to the provision of an alternative renewable naphtha fuel having high compatibility with petroleum fuel and non-hydrocarbon fuels such as ethanol.

The appellant further submitted during the oral proceedings that not all tall oils solved the objective technical problem formulated by the board of providing an alternative renewable naphtha fuel. To explain this, the appellant relied on the importance of the neutral components of the tall oil and the type of wood from which it was produced and on the theory that the heaviest part of the tall oil, constituted by neutral components, resulted in branched alkanes by splitting off the linear part of the neutral components.

- 3.5.2 During the oral proceedings, respondents 1 and 2 requested that the above submissions not be admitted into the proceedings.
- 3.5.3 The appellant's statement that the claimed compositions have a high compatibility with petroleum fuels and non-hydrocarbon fuels and that hence the objective technical problem has to be reformulated as the provision of an alternative renewable naphtha fuel having this high compatibility constitutes a new allegation of fact. As stated in the board's communication under Article 15(1) RPBA 2020 (point 16.2), it had been common ground between the parties that the objective technical problem was merely the provision of an alternative renewable naphtha fuel. Hence, up until the oral proceedings, the appellant had

not relied on any high compatibility to be achieved by the claimed composition.

The explanations given on why not all tall oils led to the provision of an alternative renewable naphtha fuel (importance of the neutral components of the tall oil and the type of wood from which it was produced and the theory that the heaviest part of the tall oil, constituted by neutral components, resulted in branched alkanes by splitting off the linear part of the neutral components) are equally new allegations of facts not present earlier in the appeal proceedings.

3.5.4 The appellant argued that its submissions were not new allegations of facts since they were present in the patent and the prior art. The board does not agree. The mere fact that something is disclosed in a patent or prior-art document does not mean that it is part of the appeal proceedings. On the contrary, under Article 12(3) RPBA 2020 (Article 12(2) RPBA 2007), an appellant must in its statement of grounds of appeal set out clearly and concisely the reasons why the decision under appeal should be reversed and should specify expressly all the facts and arguments relied on. Hence, only by relying on certain disclosures in a patent or prior-art document does any such disclosure become part of the appeal proceedings. Presenting any such disclosure only during the oral proceedings before the board therefore represents an amendment of the appellant's case.

3.5.5 Since this amendment of the appellant's case was made after summons to oral proceedings, its admittance is governed by Article 13(2) RPBA 2020, which applies to the case at hand in accordance with the transitional provisions set out in Article 25(3) RPBA 2020 (the

summons to oral proceedings was notified after 1 January 2020).

In accordance with Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings must, as a rule, not be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned.

The appellant argued that its submission was a reaction to the board's preliminary opinion that it was doubtful whether the variation of the tall oil mattered for solving the objective technical problem. The board acknowledges that it observed in its preliminary opinion that it had not been shown in the patent that the difference of the renewable feedstock led to different naphtha components and that in this context it mentioned that varying the composition of the crude tall oil would be routine for the skilled person (last paragraph of point 16.3.1 of the board's preliminary opinion). However, respondent 1 had already stated in its reply to the grounds of appeal that the patent did not mention a specific composition of the crude tall oil and that therefore the appellant had no basis to argue that this feature had any meaning when assessing inventive step (page 12, second paragraph under heading "ad a)"). Therefore, the board's observation in its preliminary opinion did not introduce any new issue constituting an exceptional circumstance under Article 13(2) RPBA 2020 and justifying the appellant's late submissions.

For these reasons, the board has decided not to admit (i) the change of the objective technical problem to

the issue related to compatibility, (ii) the reliance on the importance of the neutral components of the tall oil to solve the objective technical problem, (iii) the type of wood from which the tall oil is produced to solve the objective technical problem and (iv) the theory that the heaviest part of the tall oil results in branched alkanes by splitting off the linear part of the neutral components into the appeal proceedings in accordance with Article 13(2) RPBA 2020.

- 3.6 During the oral proceedings, the board admitted the appellant's general statement that not all tall oils solved the objective technical problem of providing an alternative renewable naphtha fuel. This general statement is contained on page 7, first paragraph of the statement of grounds of appeal. It thus does not constitute a new allegation of fact.
- 3.7 Obviousness
- 3.7.1 The appellant stated that D15 was silent about the nature of the tall oil, catalysts and hydroprocessing conditions and that specific tall oils, catalysts and hydroprocessing conditions needed to be selected in D15 to obtain alternative renewable naphtha such as the composition of claim 1.
- 3.7.2 It was common ground between the parties that there is a variety of tall oils, catalysts and hydroprocessing conditions available in the art.
- 3.7.3 As submitted by the respondents, it is arbitrary to select any tall oil available in the art to obtain an alternative renewable naphtha fuel.

The board acknowledges that the appellant's allegation has been admitted into the proceedings that not all tall oils available in the art solve the problem of providing an alternative renewable naphtha fuel. However, even though admitted, this allegation is not convincing.

The patent description itself gives a broad disclosure on tall oils. Paragraphs [0026] to [0028] give examples of biological feedstock, among which tall oil is listed, for preparing the composition of claim 1 of the main request. Paragraph [0027] mentions that "*In one embodiment, the feedstock comprises or consists of one or more of tall oil, tall oil components (e.g. tall oil fatty acids) and tall oil derivatives (e.g. tall oil resin acid and tall oil pitch)*". Thus, the description does not limit the feedstock by the nature of tall oil at all.

In view of this, and in the absence of any evidence or explanations admitted into the proceedings, this allegation is nothing but an unsubstantiated assertion that is not credible.

The board thus remains of the view that all that is needed to solve the objective technical problem is an arbitrary choice of a tall oil available in the art.

3.7.4 There is, furthermore, no evidence or explanation on file making it credible that specific catalysts need to be selected to solve the objective technical problem of providing a further renewable naphtha fuel.

This is again supported by the patent itself. Paragraphs [0029] to [0035] of the description refer to the catalysts used to prepare the composition of

claim 1 of the main request. Paragraph [0029] gives a long list of potential catalysts: "*Effective catalysts comprise one or more metals selected from Group VIA and Group VIII metals,...*". These paragraphs do not teach that only specific catalysts can be used in a process for preparing the claimed composition.

- 3.7.5 Lastly, there is no evidence or explanation on file making it credible that specific hydroprocessing conditions need to be selected to solve the objective technical problem of providing a further renewable naphtha fuel.

This is again supported by the patent itself. Paragraphs [0036] to [0053] of the description disclose the hydroprocessing conditions for obtaining the composition of claim 1 of the main request. The reactor (paragraph [0037]), the catalyst bed (paragraph [0038]), the relative amount of the catalysts (when it applies, paragraph [0045]), hydroprocessing temperature and pressure (paragraph [0051]), the feed rate (paragraph [0052]), and the amount of hydrogen (paragraph [0053]) are not limited to specific embodiments and/or specific values.

- 3.8 Hence, all that is needed to solve the objective technical problem of providing a further renewable naphtha fuel is an arbitrary selection of the tall oil, catalyst and hydroprocessing conditions. Such an arbitrary selection is within the routine abilities of the skilled person, and for this reason alone it cannot contribute to inventive step.

- 3.9 D15 (page 11, lines 15-18) teaches arrangements including the catalyst system used in the example of the patent comprising four beds. Furthermore, the

teaching on page 11, lines 15-18 of D15 corresponds to the teaching of the patent (paragraphs [0030] and [0032]) referring to NiMo and NiW as preferred catalysts.

Moreover, a hydrogen feed rate of the example of the patent (1 480 Nl/l) is covered by the range disclosed on page 12, lines 32-36 of D15 (500 to 2 500 Nl/l). Furthermore, since D15 refers to naphtha components, i.e. to compounds boiling in the range referred to in the patent, this implies the same fractionation conditions as in the patent.

Lastly, cracking, which according to the appellant was needed to obtain a further renewable naphtha fuel, is referred to in D15 on page 10, lines 34-36 (*"The cracking/isomerizing are controlled by process variables, such as pressure and/or temperature and by the properties of the catalyst, for example by controlling its acidity"*). Thus, D15 teaches hydroprocessing conditions involving cracking.

Therefore, even though the arbitrary nature of the selections needed alone implies that they do not contribute to inventive step, it follows that these selections are additionally rendered obvious by D15. Also for this reason, they do not render the claimed subject-matter inventive.

- 3.10 In view of the above, the board concludes that the subject-matter of claim 1 of the main request does not involve an inventive step.
- 3.11 The main request is not allowable.

Auxiliary requests 1 to 10

4. Auxiliary requests 1 and 2

Claim 1 of auxiliary requests 1 and 2 corresponds to claim 1 of the main request.

Thus, the conclusion given for inventive step of claim 1 of the main request applies to claim 1 of each of auxiliary requests 1 and 2.

Auxiliary requests 1 and 2 are therefore not allowable.

5. Auxiliary requests 3 to 5

Claim 1 of each of auxiliary requests 3 to 5 differs from claim 1 of the main request in that the composition is defined as a "fuel composition".

Since the composition disclosed in D15 is a fuel composition, this amendment does not lead to any additional distinguishing feature over D15. Therefore, the conclusion given for inventive step of claim 1 of the main request also applies to claim 1 of each of auxiliary requests 3 to 5.

Auxiliary requests 3 to 5 are not allowable.

6. Auxiliary request 6

The composition of claim 1 of auxiliary request 6 further comprises, with respect to claim 1 of each of auxiliary request 3 to 5, 35-45 mass% of C₆₋₉ cycloalkanes.

In the same way as for the main request, and in the absence of any evidence or other submission to the contrary, it must be assumed that to obtain an

alternative renewable naphtha fuel composition with 35-45 mass% of C₆₋₉ cycloalkanes, all that is needed is an arbitrary selection of tall oil, catalyst and hydroprocessing conditions. Therefore, in an analogous way as set out above for the main request, inventive step of the subject-matter of claim 1 of auxiliary request 6 has to be denied.

During the oral proceedings, the board informed the appellant that the additional distinguishing feature in claim 1 of auxiliary request 6 did not change the conclusion of the board regarding the inventive step of claim 1 of the main request. This was not disputed by the appellant.

Thus, the subject-matter of claim 1 of auxiliary request 6 does not involve an inventive step, and auxiliary request 6 is not allowable.

7. Auxiliary request 7

Claim 1 of auxiliary request 7 refers to a method for producing a certain composition. This process is defined by i) hydroprocessing a biological feedstock and ii) fractionating the hydroprocessed product. These two process steps are disclosed in D15 (see 3.2 above). Hence they do not represent distinguishing features in view of D15. These two process features thus cannot contribute to inventive step. Furthermore, the composition obtained by the process of and defined in claim 1 of auxiliary request 7 is identical to that defined in claim 1 of the main request. Hence, the same reasoning for lack of inventive step as made above for the main request applies.

The subject-matter of claim 1 of auxiliary request 7 hence lacks an inventive step, and the request is thus not allowable.

8. Auxiliary request 8

Claim 1 of auxiliary requests 8 differs from claim 1 of auxiliary request 7 in that the composition prepared by the method is defined as a "fuel composition".

As set out above for claim 1 of each of auxiliary requests 3 to 5, this amendment does not lead to any additional distinguishing feature over D15, and the subject-matter of claim 1 of auxiliary request 8 does not involve an inventive step.

Auxiliary request 8 is not allowable.

9. Auxiliary request 9

Claim 1 of auxiliary request 9 differs from claim 1 of auxiliary request 8 in that it characterises the biological feedstock as comprising at least 45 mass% of C₁₂₋₁₈ fatty acids, at least 25 mass% of resin acids and at least 20 mass% of neutral compounds based on the mass of the feedstock.

The appellant submitted that the biological feedstock was representative of the example and that there was no guidance in D15 to select this biological feedstock. The biological feedstock was not obvious in view of common general knowledge as represented by D29 since D29 did not disclose the amounts of at least 25 mass% of resin acids and at least 20 mass% of neutral compounds required by claim 1 of auxiliary request 9.

The board does not agree.

As submitted by the respondents and in the same way as set out above for the main request, the selection of a particular feedstock, including the one specified now in claim 1 of auxiliary request 9, is an arbitrary selection. This selection is part of the skilled

person's routine abilities and for this reason alone cannot contribute to inventive step.

Furthermore, a crude tall oil very close to the one now defined in claim 1 of auxiliary request 9 is disclosed in D29. Table 1 of D29 shows that Scandinavia crude tall oil comprises 23% resin acids and 20% unsaponifiable compounds ("Unsaps" in table 1). The last sentence of the first paragraph on page 13 of D29 mentions that "*Thus the neutrals are always slightly higher than the so called 'unsaps'*", meaning that the amount of neutral compounds in the Scandinavia crude tall oil is at least 20 mass% as required by claim 1 of auxiliary request 9. With regard to the remaining feature of claim 1 of auxiliary request 9, i.e. the resin acid content, the amount disclosed in D29 (23%) is very close to the amount required by claim 1 of auxiliary request 9 (25 mass.%) and is within the minor variation that a skilled person would consider, as submitted by the respondents. This last point was not disputed by the appellant.

Thus, also in view of D29 as a secondary document, the selection of the particular feedstock defined in claim 1 of auxiliary request 9 is obvious.

10. Auxiliary request 10

Claim 1 of auxiliary request 10 differs from claim 1 of auxiliary request 9 in that the composition to be prepared further comprises 35-45 mass% of C₆₋₉ cycloalkanes.

This additional feature was also present in claim 1 of auxiliary request 6. As set out for auxiliary request 6, this additional distinguishing feature represents an

arbitrary selection that does not contribute to inventive step.

Hence, the addition of this feature does not change the conclusion of the board on inventive step of claim 1 of auxiliary request 9. This was not disputed by the appellant.

Thus, the subject-matter of claim 1 of auxiliary request 10 does not involve an inventive step, and auxiliary request 10 is not allowable.

11. Admittance of auxiliary requests 6 and 10

Auxiliary requests 6 and 10 were submitted by the appellant with its statement of grounds of appeal.

The respondents requested that these auxiliary requests not be admitted into the proceedings.

During the oral proceedings, the board decided to admit these auxiliary requests into the proceedings. As set out above, the subject-matter of claim 1 of auxiliary requests 6 and 10 was found not to involve an inventive step in view of D15 as the closest prior art. The decision on inventive step is thus in the respondents' favour, and therefore there is no need to provide reasons for the admittance of auxiliary requests 6 and 10.

12. Admittance of documents D3a and D33

The respondents requested that documents D3a and D33 be admitted into the proceedings.

Both documents were filed before the opposition division. Both documents were not admitted into the proceedings by the opposition division (see 2.1 and 2.3

of the Reasons) since they were not *prima facie* relevant.

However, D3a and D33 were not relied on by the respondents in their written or oral submissions. Thus, there was no need for the board to decide on the admittance of D3a and D33.

13. None of the claim requests on file is 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